

Examination Guidelines for Patent and Utility Model in Japan (Provisional Translation)

Japan Patent Office

Part I

Outline of Examination

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Part I Outline of Examination

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Note: When any ambiguity of interpretation is found in this provisional translation, the Japanese text shall prevail.

Part I Chapter 1 Principles of Examination and Flow of Examination

Chapter 1 Principles of Examination and Flow of Examination

1. Principles of Examination

An examiner should conduct a substantive examination for a patent application, i.e., examination concerning whether or not a patent should be granted for the application, or whether or not a patent application has any reasons for refusal. The examiner is required to make fair determinations based on high-level expertise.

The examiner should take note in particular of the following aspects:

- (1) To conduct examination as uniformly as possible in line with guidelines relevant to the examination, such as the Examination Guidelines, etc., paying due consideration to the promptness, accuracy, fairness and transparency;
- (2) On the premise that it is primarily the burden of the applicant (including the attorney; in this part, hereinafter simply referred to as "an applicant") to proceed with the prescribed procedures to obtain the patent right taking his/her own initiatives, the examiner conducting the examination should also take into account the purport of establishment of high-quality patent right.
- (3) To make an effort to ensure and further improve the quality of examination with respect to prior art search and determination on the requirements for patentability. The prior art search and the determination on patentability should be made taking into consideration complex nature and advancement of the technology by fully utilizing accumulated expertise of each examiner.
- (4) To perform efficient examination, ensuring sufficient communication with an applicant.

2. Flow of Examination

With regard to a patent application for which a request for examination is filed, the examiner conducts the examination in accordance with the following procedures.

For details of the examination procedures, see "Chapter 2 Procedures of Examination." Also, see Figure 1 for the flow of the examination procedures.

2.1 First round of examination

(1) Understanding and Specifying claimed invention (see "Chapter 2 Section 1 Specifying Claimed Invention.")

The examiner starts by carefully reading the description, claims, and drawings of the application to be subjected to the examination (in this part, hereinafter referred to as "the application concerned") so as to obtain sufficient understanding of the technical content of the invention. When a written amendment, etc. have been filed prior to the first round of the examination (the term "etc." refers to documents, etc. other than the written opinion and the written amendment (for example, a certificate of experiment results and a written statement). The same applies to usage of the term "etc." in this Part as in "written amendment, etc." and "written opinion, etc."), the examiner should sufficiently understand the content of these documents.

Also, the examiner specifies the claimed invention of the application concerned on the basis of the recitations of the claims of the application concerned.

(2) Prior art search and determination of existence of reasons for refusal (see "Chapter 2 Section 2 Prior Art Search and Determination of Requirements of Novelty, Inventive Step, etc.")

The examiner then examines the requirements associated with exclusion from the search such as the requirement of unity of invention (Article 37) and requirements of description and claims (Article 36) and determines the invention to be subjected to the prior art search from among the claimed inventions of the application concerned.

Thus, the examiner conducts prior art search with regard to the claimed invention(s) determined as the subject of search concerning novelty (Article 29(1)), inventive step (Article 29(2)), secret prior art (Article 29bis), and prior application (Article 39) (in this part, hereinafter referred to as "novelty, inventive step, etc.").

The examiner, after completion of the prior art search, examines the novelty, inventive step, etc. of the claimed invention of the application concerned, which has been determined as the subject of search, on the basis of the search results. Also, the examiner examines the existence of other reasons for refusal.

(3) Notice of decision and notice of reasons for refusal (see "Chapter 2 Section 3 Notice

of Reasons for Refusal" and "Chapter 2 Section 5 Decision.")

When the examiner does not find a reason for refusal as a result of the examination of the requirement of unity of invention, requirements of description and claims, novelty, inventive step, etc. as well as ascertainment of any other reasons for refusal, the examiner renders a decision to grant a patent (Article 51).

When a reason for refusal has been found, the examiner notifies the reasons for refusal (Article 50). There are two types of notice of reasons for refusal, i.e., "non-final notice of reasons for refusal" and "final notice of reasons for refusal." The first notice of reasons for refusal is always rendered as the non-final notice of reasons for refusal."

2.2 Examination following response to first notice of reasons for refusal

(1) Consideration of written opinion and written amendment, etc. (see "Chapter 2, Section 4 Handling of Written Opinion, Written Amendment, etc.")

When a written opinion, written amendment, etc. have been submitted, the examiner sufficiently considers the content of the submitted written opinion, written amendment, etc. and continues the examination.

Thus, the examiner confirms whether or not the reasons for refusal set forth in the notice of reasons for refusal is appropriate in light of the content of the written opinion, written amendment, etc. and, on the basis of the confirmation, determines whether or not the notified reason for refusal has been overcome, and whether or not there is any other reason for refusal.

(2) Notice of decision to grant patent and notice of reasons for refusal (see "Chapter 2 Section 3 Notice of Reasons for Refusal" and "Chapter 2 Section 5 Decision")

When it is determined that the notified reasons for refusal has been overcome as after reviewing the content of the written opinion, written amendment, etc. and any other reasons for refusal is not found, the examiner renders a decision to grant a patent (Article 51).

When it is determined that the notified reasons for refusal has not been overcome even when the content of the written opinion, written amendment, etc. is taken into account, the examiner renders a decision of refusal (Article 49).

When it is determined that the notified reasons for refusal has been overcome but any other reasons for refusal has been found, the examiner again notifies the reasons for refusal (Article 50). If the notice of the reasons for refusal at this stage only contains a reason or reasons for refusal notification of which has been necessitated as a result of

the amendments entered by a response to the prior notice of reasons for refusal, the notice of reasons for refusal is made final (i.e., rendered as the "final notice of reasons for refusal").

2.3 Examination following response to final notice of reasons for refusal

(1) Assessment of written opinion, written amendment, etc. and review of dismissal of amendment (see "Chapter 2 Section 4 Handling of Written Opinion, Written Amendment, etc." and "Chapter 2 Section 6 Decision of Dismissal of Amendment".)

When a written opinion, written amendment, etc. have been submitted, the examiner sufficiently considers the content of the submitted written opinion, written amendment, etc. and first determines whether or not the notice of reasons for refusal was appropriately made final to be rendered as the "final notice of reasons for refusal."

When it is determined that the notice was improperly made final as the "final notice of reasons for refusal," the examiner conducts the examination on the basis of the description, claims and drawings amended by the written amendment.

When it is determined that the notice was properly made final as the "final notice of reasons for refusal," the examiner determines whether or not the amendments by the written amendment comply with the requirements for amendments.

When it is determined that the amendment complies with the requirements for amendments, the examiner conducts the examination on the basis of the description, claims and drawings amended by the written amendment.

The examiner, where it is determined that the amendment fails to comply with the requirements for amendment, determines that the amendment is to be dismissed and continues the examination on the basis of the description, claims, drawings, etc. prior to submission of the written amendment.

(See Figure 2 for the flow of the examination where a written amendment is filed in response to a "final notice of reasons for refusal.")

When a written opinion has been filed but a written amendment has not been filed, the examiner considers sufficiently the content of the submitted written opinion and continues the examination.

(2) Notice of decision and notice of reasons for refusal (see "Chapter 2 Section 3 Notice of Reasons for Refusal" and "Chapter 2 Section 5 Decision.")

When it is determined that the notified reasons for refusal has been overcome

and no other reasons for refusal are found, the examiner renders a decision to grant a patent (Article 51).

When it is determined that the notified reasons for refusal is not overcome, the examiner renders a decision of refusal (Article 49).

When it is determined that the notified reasons for refusal has been overcome but any other reasons for refusal has been found, the examiner notifies the reasons for refusal upon consideration of whether the notice of reason for refusal should be rendered as a "first notice of reasons for refusal" or made final (i.e., rendered as a final notice of reasons for refusal) (Article 50).

Also, where a written amendment was filed and it is determined that the amendment to be entered by this written amendment should be dismissed, the examiner renders a decision to dismiss the amendment (Article 53(1)) and renders a decision to grant a patent or renders a notice of reasons for refusal.

2.4 Reconsideration by examiners before proceedings

When a demand for appeal against examiner's decision of refusal has been filed for the application for which a decision of refusal was rendered (in this part, hereinafter referred to as "demand for appeal") and an amendment has been made at the time of filing of the demand for appeal, the examiner should conduct examination for the application before the appeal (Article 162). This examination is called "reconsideration by examiner before appeal proceedings."

The overview of the reconsideration by examiner before appeal proceedings is as follows (for the flow of procedures of the reconsideration by examiner before appeal proceedings, see "Chapter 2 Section 7 Reconsideration by Examiners before Appeal Proceedings" and Figure 3).

In the reconsideration by the examiners before the appeal proceedings, the examiner first considers whether or not the amendment at the time of filing of the demand for appeal complies with the requirements for amendments,

When it is determined that the amendment in question complies with the requirements for amendments, the examiner conducts the reconsideration before appeal on the basis of the description, claims, and drawings as amended. If the amendment in question fails to comply with the requirements for amendment, the examiner conducts the reconsideration before appeal on the basis of the description, claims, and drawings at the time of the decision of refusal.

The examiner renders a decision to grant a patent, a notice of reasons for refusal, or a report to the Commissioner of the Patent Office (Article 164(3)) (in this part, hereinafter referred to as a "reconsideration report") in accordance with the results of the reconsideration before appeal.

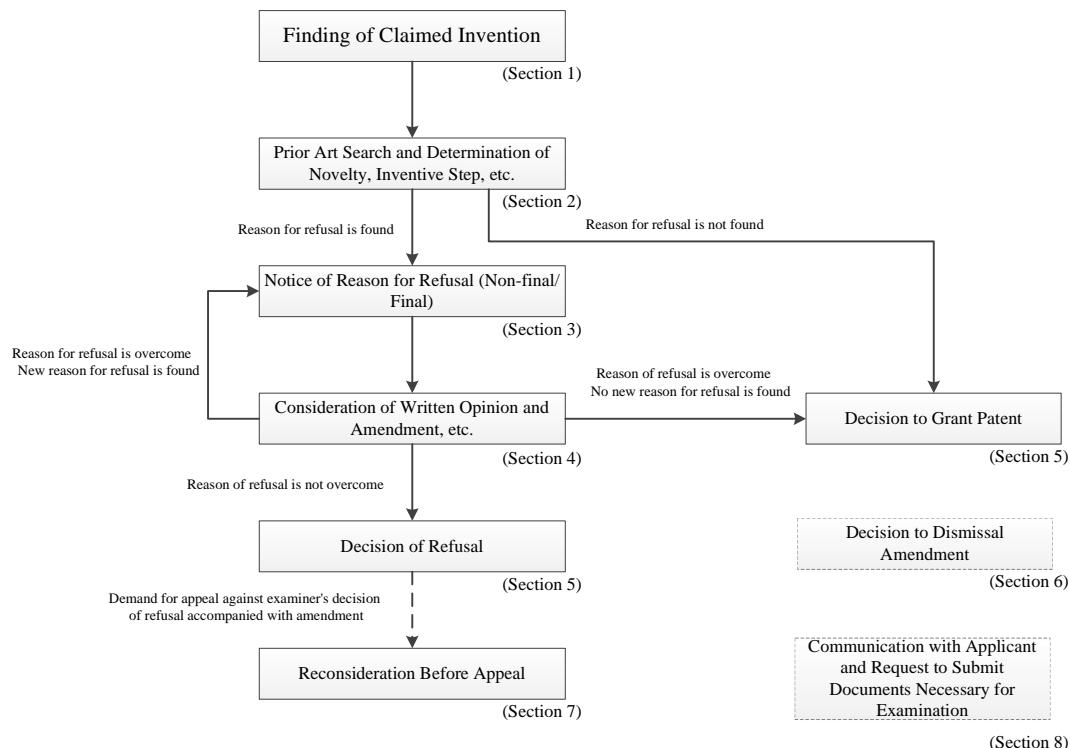
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Part I Chapter 2 Procedures of Examination

Chapter 2 Procedures of Examination

Sections 1 to 6 of this chapter explain the general aspects of the examination. The reconsideration by examiner before appeal proceedings is explained in Section 7. With regard to handling of Notice of Reason for Refusal accompanied by the notice under Article 50bis, see 3. and 4. in "Part VI Chapter 1 Section 2 Notice under Article 50bis".

The following flowchart summarizes the correspondence between the flow of examination procedures and the explanations of this chapter.



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Part I Chapter 2 Section 1 Specifying Claimed Invention

Section 1 Specifying Claimed Invention

1. Overview

The examiner must first identify and recognize the technical content of the invention. This work is referred to as specifying an invention, which serves as the basis or presupposition for determination of the requirements of patentability of the invention (See "Part III Patentability").

2. Specifying Claimed Invention

The examiner specifies the claimed inventions based on the claims. The examiner takes the description, drawings and the common general knowledge at the time of filing into consideration in interpreting the meanings of words in the claims.

Also, the examiner should carefully read the description, claims, and drawings of the application concerned and sufficiently understand the technical content of the claimed invention in this finding.

When any amendment is made to the description, claims, or drawings (in this part, hereinafter referred to as "the description, etc." throughout this Part), the examiner should sufficiently understand the content of the amendment.

Note: When any ambiguity of interpretation is found in this provisional translation, the Japanese text shall prevail.

Part I Chapter 2 Section 2 Prior Art Search and Determination of Novelty, Inventive Step, etc.

Section 2 Prior Art Search and Determination of Novelty, Inventive Step, etc.

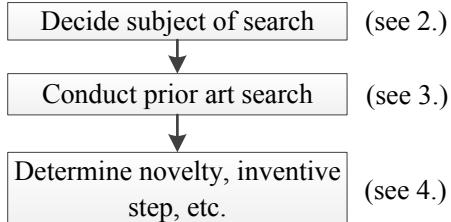
1. Overview

The examiner conducts the prior art search in relation to determining novelty, inventive step, etc. of the claimed invention.

When the prior art search is to be conducted, the examiner first decides the invention regarded as the subject of the prior art search (in this part, hereinafter referred to as "subject of search" through this Part) from among the claimed inventions of the application concerned.

Also, in cases where information on relevant prior art documents is disclosed in the detailed description of the invention or search results and examination results of any foreign patent office, or search results of any registered search organization or prior art information provided by third parties is available, the examiner considers the content of such information and conducts the prior art search.

The examiner renders determination of novelty, inventive step, etc. on the basis of the results of the prior art search.



2. Subject of Search

2.1 Decision regarding subject of search

In the first round of examination, the matters of the claimed invention (Note) falling within the range to be subjected to the examination in light of the aspects set forth in 4. in "Part II Chapter 3 Unity of Invention" (Article 37) are defined as the subject of search by the examiner. In the second round of examination as well as in any other round of examination that follows, the range to be subjected to the examination in light of the aspects set forth in the above mentioned "Part II Chapter 3 Unity of Invention" and 3. in "Part IV Chapter 3 Amendment Changing Special Technical

"Feature of Invention" (Article 17bis(4)) is defined as the subject of search by the examiner.

(Note) With regard to the claimed invention whose matters for specifying the invention (in this part, hereinafter referred to as "matters specifying the invention" throughout this Part) are expressed in the form of alternatives, the term "claimed invention" refers to the invention that is recognized from the alternatives. The same applies to the subsections 2 and 3 of this section.

2.2 Matters to be considered in deciding subject of search

- (1) The examiner takes into consideration the embodiments of the claimed invention as the subject of search.
- (2) The examiner takes into consideration the matters reasonably expected to be added to claims by an amendment as the subject of search in view of the efficiency of the procedures until a decision to grant a patent is rendered.

2.3 Invention that may be excluded from the subject of search

Inventions that fall under any one of the following cases (i) to (vi) (in this part, hereinafter referred to as the "subject of exclusion" throughout this Part) may be excluded from the subject of prior art search.

However, with regard to the inventions for which the examination of requirements other than Article 37 and Article 17bis(4) is to be conducted, the examiner should give due consideration such that the least number of inventions are excluded from the subject of the prior art search.

- (i) Invention to which new matters have been clearly added (non-compliance with the requirements of Article 17bis(3))
- (ii) Invention clearly directed to a category of unpatentable invention (violation of the provisions of Article 32)
- (iii) Invention clearly not falling under the "invention" defined in Article 2 or invention clearly not industrially applicable (violation of the provisions of the main paragraph of Article 29(1))
- (iv) Claimed invention whose statement is so unclear that the invention cannot be recognized even by taking into consideration the detailed description of the invention, drawings and common general technical knowledge as of the filing (non-compliance

with the requirements of Article 36 (6)(ii))

(v) In a case where it is obvious that the statement in the detailed description of the invention is unclear or insufficient for a person skilled in the art to carry out the claimed invention, the invention directed to the part that cannot be carried out by the person skilled in the art due to unclear or insufficient statement in the detailed description of the invention (non-compliance with the requirements of Article 36 (4)(i))

(vi) In a case where it is obvious that the claimed invention exceeds the extent of disclosure in the description to which a person skilled in the art would recognize that a problem to be solved by the invention, the invention directed to the part that “exceeds the extent of disclosure in the detailed description of invention” (non-compliance with Article 36(6)(i))

2.3.1 Points to note

(1) Even when the invention falls under the subject of exclusion from the prior art search due to clerical errors or minor deficiencies in the recitations of the claims, the examiner conducts the prior art search on the basis of the recognized invention as long as the invention that is not the subject of the exclusion can be recognized in light of the detailed description of the invention, drawings, or common general technical knowledge as of the filing.

(2) Even when the invention falling under the subject of exclusion from the prior art search, the examiner conducts the prior art search on the basis of the reasonably expected invention when it is reasonably expected that the invention will be excluded from the subject of exclusion as a result of any amendment changing the categories of invention or minor amendment to the statement in the claim.

(3) The examiner must not apply the above type (iv) to a case where the invention can be clearly recognized in light of the detailed description of the invention, drawings or common general technical knowledge as of the filing.

(i) Examples of inappropriate exclusion from the subject of search)

(i-1) A case where the claimed invention is not described in the detailed description of the invention due to a clerical error but the invention(s) not to be excluded from the subject of the prior art search can be correctly recognized in light of the description, drawings or common general technical knowledge as of the filing.

Example 1:

[Claim]

"An automatic brake system characterized by the fact that automatic braking control is performed in response to a distance d between a traveling own vehicle and a preceding traveling vehicle satisfying the following condition:

$d \geq th(v)$ wherein $th(v)$ is a threshold determined in accordance with a speed of the own vehicle."

[Detailed description of the invention)

It is described that control of automatic braking is performed when $d \leq th(v)$ is satisfied.

(Explanation)

Since the direction of the inequality symbol of the claimed invention is different from that described in the detailed description of the invention, the recitation of the claimed invention is in appearance not described in the detailed description of the invention. However, it is found that the inequality symbol in the claim is a clerical error taking into account the statements of the detailed description of the invention as well as the common general technical knowledge as of the filing that the automatic braking control is carried out in response to the distance between the own vehicle and the preceding vehicle becoming equal to or less than a predetermined distance, so that the symbol should correctly be read as $d \leq th(v)$. Accordingly, the claimed invention is so recognized as such and the prior art search is conducted on the basis of the above.

(i-2) A case where the claimed invention is not an industrially applicable invention but the examiner can reasonably expect that the claimed invention be modified into an invention that is not to be excluded from the subject of prior art search.

Example 2:

[Claim]

"A method of treatment of disease A of humans using a pharmaceutical containing ... as an active ingredient."

(Explanation)

Since the claimed invention is a method of treating humans, it is not an "industrially applicable invention." However, it is reasonably expected that the claimed invention will be modified into an invention that is not the subject of exclusion from the prior art search by virtue of an amendment changing the categories of invention, such as "A pharmaceutical for treatment of disease A containing ... as an active ingredient." Therefore the examiner recognizes the claimed invention as such and conducts the prior art search based on the above finding.

(i-3) A case where the claimed invention is not clear but can be recognized in light of the detailed description, drawings or common general technical knowledge as of the filing.

Example 3:

[Claim]

"A hybrid car whose energy efficiency during electric traveling is from a% to b% wherein the energy efficiency is measured by an X test method."

(Detailed description of the invention)

The detailed description of the invention only describes a hybrid car including a controller that performs Y-control for a belt type continuously variable transmission, and it is stated therein that the energy efficiency of the hybrid car during electrical traveling falls within the range from a% to b% when the energy efficiency is measured using the X test method. Also, the belt type continuously variable transmission is a more specific concept of the continuously variable transmission, and it is described in the description that the controller performing the Y-control may be adopted in any continuously variable transmissions other than the belt type. The definition of the X test method is also provided in the description.

(Explanation)

Even when the invention cannot be clearly recognized though the terms described in the claims are interpreted taking into account the description, drawings as well as common general technical knowledge as of the filing, it can be recognized, in light of the description, that the claimed invention is at least directed to a hybrid car comprising a controller performing Y-control for the continuously variable transmission, wherein the energy efficiency of the hybrid car falling within the range of a% to b% during electrical traveling wherein the energy efficiency is measured using the X test method. Accordingly, the claimed invention is so recognized in the prior art search and subjected to the search.

(ii) Examples of excludable subjects from the subjects of search

(ii-1) A case where the claimed invention is unclear and cannot be recognized even in light of the detailed description, drawings as well as common general technical knowledge as of the filing.

Example 4:

[Claim]

"An invention as described in the description."

(Premise)

The examiner cannot recognize what kind of invention is specifically intended by the recitation of the claim even when the description, drawings as well as common general technical knowledge as of the filing are taken into account.

(Explanation)

Given the above recitation of the claim, the claim language is not sufficiently clear to the extent that the invention can be clearly recognized even when the statement of the description and drawings or are taken into account. Also, an amendment that would take the claimed invention out of the range of subject of exclusion cannot be reasonably expected. Accordingly, the above claim may be treated as the subject of exclusion.

Example 5:

[Claim]

"My invention which is worth one million dollars"

(Premise)

The examiner cannot recognize what kind of invention is specifically intended by the recitation of the claim even when the description, drawings as well as common general technical knowledge as of the filing are taken into account.

(Explanation)

Given the above recitation of the claim, the claim language is not sufficiently clear to the extent that the invention can be clearly recognized even when the description, drawings as well as common general technical knowledge as of the filing are taken into account. Also, an amendment that would take the claimed invention out of the range of subject of exclusion cannot be reasonably expected. Accordingly, the above claim may be treated as the subject of exclusion.

3. Prior Art Search

The examiner conducts the prior art search taking note of the examination guidelines regarding novelty (Article 29(1)), inventive step (Article 29(2)), secret prior art (Article 29bis) and prior application(Article 39) (see "Part III Chapter 2 Novelty and Inventive Step" to "Part III Chapter 4 Prior Application") and attempts to exhaustively find relevant prior art.

3.1 Procedures of prior art search

3.1.1 Points to note in conducting prior art search

(1) Where information on prior art documents related to the claimed invention is disclosed in the detailed description of the invention, the examiner should consider the content of the prior art documents before the prior art search.

With regard to the requirements for disclosure of information on the prior art documents (Article 36 (4)(ii)), see "Part II Chapter 1 Section 3 Requirements for Disclosure of Information on Prior Art Documents."

(2) Where search results and examination results of any foreign patent office, a report on search results by any registered search organization, and any information made available by the submission of information by third parties can be confirmed with regard to the application concerned, the examiner should consider and effectively utilize the content of the search report and the results of examination, etc.

3.1.2 Methodology of prior art search

(1) Among all documents falling in the relevant technical fields to which each of the claimed inventions pertains (domestic and foreign patent literatures (including those for which international publication has been effected) and domestic and foreign non-patent literatures), the examiner should, because of financial reasons of the prior art search, conduct search of a certain range of documents which the examiner, based on his knowledge and experience, expects and determines that the relevant prior art documents will probably be found in.

(2) The examiner should first search the technical fields in which it is most probable to find relevant prior art documents related to the claimed invention. In general, it is appropriate for an examiner to start the prior art search with the most closely relevant technical fields to the working examples disclosed in the detailed description of the invention, and gradually extends the search to less relevant technical fields.

(3) Whether or not the search should be extended from highly relevant technical fields to less relevant fields should be determined by the examiner with the already obtained search results taken into consideration. Where adequate prior art for reasonably denying novelty or inventive step could not be found as the result of the search of the highly relevant fields, the scope of search should be extended by the examiner to these fields if

it is most likely that the prior art documents denying novelty or inventive step are found as the result of the search of less relevant technical fields.

(4) It may be revealed in the course of the prior art search that what was considered to be the subject of search at the beginning of search does not need to be treated as the subject of search (see "Part II Chapter 3 Unity of Invention " and "Part IV Chapter 3 Amendment Changing Special Technical Feature of Invention"). Accordingly, the examiner should evaluate the results of the search as appropriate and, if necessary, redefine the subject of search.

3.1.3 Completion of prior art search

The examiner conducts the prior art search for the invention recited in the claim set taking into account the matters that are reasonably expected to be introduced by an amendment. When a highly relevant prior art documents, etc. are obtained, or when it is determined that the probability that the more significant relevant prior art documents, etc. are found in the scope of the search became extremely low, then the examiner may conclude the prior art search (Note).

In addition, when any prior art document has been found that, alone without combination with any other document, denies novelty or inventive step of the claimed invention and the embodiments thereof, the examiner may conclude the prior art search with regard to the claim in question.

However, when the prior art search can be conducted for other embodiments without undue burden of search, it is desirable that the examiner further continues the prior art search.

(Note) In the examination of a certain patent application regarding chemical substances, the claim of a chemical substance expressed by Markush form may be unduly broad and various embodiments may be included, so that prior art search for all of the subjects of search is extremely difficult without necessitating undue burden of search. In this case, the examiner may conclude the prior art search if it falls under either of the following items (i) and (ii) on the assumption that all prior art search within the scope which does not cause undue burden of search has been completed.

In this case, when a reason for refusal is to be notified, the examiner states in the notice of reason for refusal that the prior art search has been concluded without searching all of the subjects

of search and indicates the range of prior art search that has been conducted in the section "Record of the Results of Prior Art Documents Search."

- (i) At least one prior art document denying its novelty, inventive step etc. has been found regarding at least one of the chemical substance groups expressed in the form of alternatives recited in claims including the chemical substances described as embodiments (a group of chemical substances expressed by specific alternatives corresponding to the embodiments).
- (ii) Prior art search has been conducted for all chemical substance groups expressed in the form of specific alternatives corresponding to the above embodiments, and at least one prior art document denying novelty, inventive step etc. of the claimed invention has already been found by the prior art search of the chemical substance groups expressed by alternatives other than the above alternatives.

3.2 Record of search results of prior art documents

When notifying a notice of reasons for refusal after the first prior art search, the examiner should state the technical field(s) subjected to the prior art search in the section "Record of Results of Prior Art Document Search."

With regard to the technical field(s) for which the prior art search has been conducted, the examiner should indicate the code or the like of the international patent classification (IPC), etc. that indicates the range subjected to the prior art search.

In addition, where there is prior art that does not constitute the reasons for refusal but is considered to be useful, for example, as a prior art document that may serve as reference information for the applicant to file an amendment, the examiner may additionally record the information on this document.

4. Determination of Novelty, Inventive Step, etc.

The examiner, after the prior art search, renders determination concerning whether or not the prior art described in the prior art documents found in the search constitutes a reason for refusal against the claimed invention regarding novelty, inventive step, etc.

The dates of publication of prior art documents etc. are very important to constitute the reasons for refusal. The examiner must confirm the relationship between

the date of publication of each of the prior art documents, etc. and the filing date (or the priority date) of the application concerned in the examination on novelty and inventive step.

Also, when considering application of the provision of secret prior art (Article 29bis), the examiner must confirm the relationship between the filing date of the application concerned and the filing date and publication date of the prior application and confirm whether or not the inventor and the applicant of the prior application are identical with those of the application concerned. When considering application of the provision of prior application (Article 39), the examiner must confirm the relationship between the filing date of the application concerned and the filing date of the prior application.

With regard to specific methodology of determination of novelty, inventive step, etc., see "Part III Chapter 2 Novelty and Inventive Step" to "Part III Chapter 4 Prior Application."

5. Prior Art Search When the Written Opinion, Written Amendment, etc. are Submitted

When it is determined that the scope of search of the prior art search that was already conducted has become insufficient in view of an amendment made to the description, etc. or a written opinion submitted in response to a notice of reason for refusal, the examiner conducts further prior art search.

The examiner does not need to conduct further prior art search in response to submission of a written opinion, written amendment, etc. when the examination can be continued without conducting further prior art search.

6. Points to Note

(1) A case where, with regard to overseas-related applications (Note), highly relevant prior art documents are included in the search results or examination results by a foreign patent office

In this case, the examiner should take into account the prosecution history and examination results at the foreign patent office (specifying the cited invention, contents of the reason for refusal, final result of examination, recitations of the claim for which a patent was granted) and considers whether or not any content of the prior art documents constitutes a reason for refusal of the claimed invention in terms of novelty, inventive

step, etc. In this case, the examiner should take notice of the differences between the Japanese examination system and practice and those of the foreign country.

(Note) The term "overseas-related applications" refers to any application falling under either of the following items (i) and (ii).

- (i) An application seeking grant of a patent for an invention for which the applicant also filed any patent application in any patent office or intergovernmental organization other than Japan Patent Office
- (ii) An application related to an international application (domestic application serving as the basis of priority claim in an international application, international application that entered the national phase, etc.)

(2) A foreign language application, PCT application in foreign language, and official gazette thereof are subjected to the prior art search (for the foreign language application and PCT application in foreign language, see "Part VII Foreign Language Written Application" and "Part VIII International Patent Application" respectively).

It is highly probable that the description, claims, or drawings of the foreign language document of a foreign language application or a PCT application in foreign language (in this part, hereinafter referred to as "the foreign language document, etc.") coincide with the content of their translation. Accordingly, it is usually considered to be sufficient for the examiner to search only the portion translated into Japanese.

However, if any doubt arises that some differences exist between the translated portion and the statement of the foreign language document, etc., it is necessary to expand the scope of search to the foreign language document, etc.

Section 3 Notice of Reasons for Refusal

1. Overview

Where the examiner intends to render an examiner's decision to the effect that an application is to be refused, the examiner shall notify the applicant of the reasons for refusal and give the applicant an opportunity to submit a written opinion, designating an adequate time limit for such purpose (Article 50).

It is unfair for the applicant that the examiner renders the decision of refusal immediately without giving the applicant any opportunities for defense even when the examiner is convinced of the reasons for refusal. Moreover, it's not beyond the realm of possibility that the examiner makes a mistake. Under these circumstances, this provision aims at fair and appropriate operation of the procedures of a patent application, giving the applicant an opportunity for offering an opinion, as well as overcoming the reasons for refusal by amending the description etc., and also giving the examiner an opportunity for reconsidering with a written opinion, etc. (Reference) Decision by the Tokyo High Court, March 30, 1993 [Heisei 3-nen (Gyo Ke) No. 199], "COLORING METHOD"

2. Types of Notice of Reasons for Refusal

The Notice of reasons for refusal falls into the following two types in view of procedure.

- (i) Non-final notice of reasons for refusal (Article 17bis(1)(i))
- (ii) Final notice of reasons for refusal (Article 17bis(1)(iii))

2.1 Non-final notice of reasons for refusal

The "non-final notice of reasons for refusal" is a notice of reasons for refusal notifying reasons for refusal which should be notified in the first examination.

Therefore, the first notice of reasons for refusal is always the "non-final notice of reasons for refusal." A notice of reasons for refusal including reasons for refusal which should have been notified in the first examination is the "non-final notice of the reasons for refusal" in principle, even when the notice is notified after the first notice of reasons for refusal. (As for exceptions, see 3.2.1(2))

It is to be noted that amendments to a descriptions etc. should always meet the provision of Article 17bis(3), while amendments to claims made after receiving the non-final notice of reasons for refusal should meet the requirement of Article 17bis(4) in addition to the requirement of Article 17bis(3).

2.2 Final notice of reasons for refusal

The "final notice of reasons for refusal" is a notice of reasons for refusal notifying only reasons for refusal necessitated by amendments made in response to a "non-final notice of reasons for refusal" in principle.

Whether a second or later notice of reasons for refusal shall be the "non-final notice of reasons for refusal" or not should be substantively determined, not by the formal number of notifications.

As for specific determination as to whether a notice shall be the "non-final notice of reasons for refusal" or the "final notice of reasons for refusal," see 3.

Amendments to claims after receiving the "final notice of reasons for refusal" should meet the requirements of Article 17bis(5) and (6) in addition to the requirements of 17bis(3) and (4).

(Explanation)

If claims can be freely changed whenever a notice of reasons for refusal is received, the examination may have to be restarted on each occasion. This contributes to not only delays in examinations but also damages to fairness in treatment between applications with appropriate amendments and those without it. Therefore, in order to carry out a prompt examination while securing the fairness among applications, a system to issue the final notice of reasons for refusal and limit the content of amendments in response thereto is established so as to limit the amendments in response to the final notice of reasons for refusal to the scope in which the results of the examination that has been already completed can be effectively used.

Where a notice under Article 50bis is given along with a notice of reasons for refusal, amendments to claims should meet the same requirements as the amendments after receiving the "final notice of reasons for refusal" (see "Part VI Chapter 1 Section 2 Notice under Article 50bis").

3. Detailed Practices of Notice of Reasons for Refusal

In principle, the examiner should issue a notice of reasons for refusal at most two times (each of the "non-final notice of reasons for refusal" and the "final notice of reasons for refusal" once) and carry out examination, with effectiveness of the whole procedure being considered.

3.1 First notice of reasons for refusal

(1) The first notice of reasons for refusal is set to the "non-final notice of reasons for refusal."

(2) In principle, the examiner should give notice of all of the reasons for refusal which have been found in the first notice of reasons for refusal.

However, where notification of only a reason for refusal is likely to lead to amendments by which not only the notified reason for refusal but also another reason for refusal will be overcome at the same time, multiple reasons for refusal should not be always notified redundantly. For instance, where notification of only a reason for refusal in terms of lack of inventive step is likely to lead to amendments by which not only the reason for refusal in terms of lack of inventive step but also a reason for refusal in terms of non-compliance with description requirements will be overcome, the reason for refusal in terms of non-compliance with description requirements should not be always notified.

3.2 Second or later notice of reasons for refusal

For the second or later notice of reasons for refusal, the examiner should give notice of the reasons for refusal after determining whether it should be set to the "final notice of reasons for refusal" or the "non-final notice of reasons for refusal" according to the following.

In a case where it is not fallen into the following practical examples shown in 3.2.1 to 3.2.2 and whether the notice shall be the "non-final notice of reasons for refusal" or the "final notice of reasons for refusal" is not clear, the examiner returns to the purport of the system (see (Explanation) of 2.2) and makes a decision so that the applicant's opportunity for amendment may not be unreasonably limited.

3.2.1 Cases where "final notice of reasons for refusal" should be notified

A notice of reasons for refusal notifying only reasons for refusal necessitated by amendments made in response to a "non-final notice of reasons for refusal" shall be the "final notice of reasons for refusal".

(1) Types of the notice of reasons for refusal notifying only reasons for refusal necessitated by amendments

a A notice of reasons for refusal notifying only reasons for refusal necessitated by the amendments to a description, etc. made by the applicant in response to a "non-final notice of reasons for refusal"

Example 1: In a case where the statement of the detailed description of the invention becomes obscure or new matters were added to the statement of the detailed description of the invention by amendments, a notice of reasons for refusal notifying only that effect.

Example 2: In a case where new reasons for refusal in terms of lack of novelty, inventive step, etc. should be notified as to the examined claims to which new technical matters were added by amendments or of which technical matters were deleted or limited by amendments, a notice of reasons for refusal notifying only the new reasons for refusal.

Example 3: In a case where new reasons for refusal in terms of lack of novelty, inventive step, etc. should be notified due to amendments made to add claims, a notice of reasons for refusal notifying only the new reasons for refusal.

Example 4: In a case where amendments adding new matters to the claims or amendments causing deficiency in descriptions were made, a notice of reasons for refusal notifying only that effect.

Example 5: In a case where a claim is amended so that it includes any invention which is not the subject of the examination with regard to the requirements other than those described in Article 17bis(4) in accordance with "Part IV Chapter 3 Amendment Changing Special Technical Feature of Invention," a notice of reasons for refusal notifying only that effect.

Example 6: In a case where a claim is amended so that it includes any invention which is not the subject of the examination with regard to the requirements other than those described in Article 37 in accordance with "Part II Chapter 3 Unity of Invention," a notice of reasons for refusal notifying only that effect.

Example 7: In cases to which two or more of items Example 1 to Example 6 shown above are applicable, a notice of reasons for refusal notifying only these effects.

- b A notice of reasons for refusal notifying only reasons for refusal necessitated as a result of the examination of novelty, inventive step etc. required after amendments were made in response to a "non-final notice of reasons for refusal" on the claim excluded from a subject of the search.

(Explanation)

Where claims which had not been examined in terms of novelty, inventive step, etc. (limited to the case where it is clearly expressed in the notice that the claims had been excluded from a subject of the search and therefore examinations on novelty, inventive step, etc. had not been conducted with the reason thereof) were amended and the invention after the amendments is examined, a notice to be notified shall be the "final notice of reasons for refusal" because this case is substantially the same as restarting examination on claims added by amendments.

Example 8: In a case where claims which had not been examined on novelty, inventive step, etc. because the statement of the claims was too obscure to understand even if the description and the drawings were taken into account were amended and reasons for refusal in terms of lack of novelty, inventive step, etc. are found as to the unexamined claims after the amendments, a notice of reasons for refusal notifying only that effect.

Example 9: In a case where claims with which only reasons for refusal of adding new matters were notified without examining on novelty and inventive step because the claims were clearly added new matter were amended and reasons for refusal in terms of lack of novelty, inventive step, etc. are found as to the amended claims, a notice of reasons for refusal notifying only that effect.

Example 10: In cases to which both items Example 8 and Example 9 shown above are applicable, a notice of reasons for refusal notifying only these effects.

(Points to note)

When the examiner considers that the claimed invention before amendments should not have been excluded from a subject of the prior art search as a result of taking into consideration a written opinion etc., reasons for refusal in terms of lack of novelty, inventive step, etc. notified as to the claimed invention after the amendments shall be notified in the "non-final notice of reasons for refusal."

(2) Special Case where a "final notice of reasons for refusal" may be rendered

- a In addition to the reasons for refusal to the effect that there is not novelty, an inventive step, etc., there are minor improper descriptions (those recognized as "correction of errors" or the "clarification of an ambiguous statement" set forth in Article 17bis(5)(iii) to (iv)). However, only the reasons for refusal pertinent to novelty, an inventive step, etc., are notified, and reasons for refusal pertinent to description requirements are not notified. As a result there still remain minor improper descriptions. In such a case, a further notice of reasons for refusal for notifying the improper descriptions can be rendered as a "final notice of reasons for refusal."

(Explanation)

Minor improper descriptions are usually expected to be corrected when amendment is made in response to a notice of reasons for refusal pertinent to novelty, an inventive step, etc. Further, even if the improper descriptions are not corrected and pointed out in a "final notice of reasons for refusal," improper descriptions recognized as "final notice of reasons for refusal," improper descriptions recognized as "correction of errors" or the "clarification of an ambiguous statement" set forth in Article 17bis(5)(iii) to (iv)) are allowed as amendment after the "final notice of reasons for refusal." Therefore, the improper descriptions are handled as stated above.

- b As to a claim for which a search has completed in accordance with 3.1.3 (Note) in "Section 2 Prior Art Search and Determination on Novelty, Inventive Step, etc.," previous reasons for refusal are resolved by amendment, whereas reasons for refusal based on a new prior-art document, etc., are found. In such a case, a further notice of reasons for refusal to be issued at this time can be rendered as a "final notice of reasons for refusal."
- c Where, although the notified reasons for refusal are unresolved, the examiner

can show an action available for the applicant to resolve the reasons for refusal and determine that an agreement with the applicant for taking the action can be expected, a notice of reasons for refusal which will be notified when the agreement is concluded as a result of communication being established with the applicant can be taken as a "final notice of reasons for refusal" (see 3. in "Section 5 Decision" and 3.5 in "Section 7 Reconsideration by Examiners before Appeal Proceedings")

- d An invention subjected to amendments that are intended for restriction in a limited way does not fulfill requirements set forth in Article 36(6). In such a case, when the improper description is a minor one and it is expected that the invention be patentable by making a simple amendment to remedy the improper description, a further notice of reasons for refusal notified after the amendment is made can be rendered as a "final notice of reasons for refusal."

3.2.2 The case where even a second-time or subsequent notice of reasons for refusal should be rendered as a "non-final notice of reasons for refusal"

Even in a case of a second-time or subsequent notice of reasons for refusal, when reasons for refusal that should have been pointed out by the examiner in the non-final notice of reasons for refusal are to be notified, the examiner notifies a "non-final notice of reasons for refusal" because the reasons for refusal do not stem from amendment.

Therefore, in a case corresponding to (1) or (2) provided below, the examiner notifies a "non-final notice of reasons for refusal."

In addition, if reasons for refusal that should have been pointed out in the first notice of reasons for refusal and reasons for refusal required to be notified resultant of amendment responding to the notice of reasons for refusal are to be simultaneously notified, the examiner notifies a "non-final notice of reasons for refusal."

- (1) The case where reasons for refusal, which should have been pointed out by the examiner at the first notice of reasons for refusal but were not found at that point in time, are notified

Example 1: Where reasons for refusal, such as improper descriptions in a description, lack of unity of an invention, etc., were overlooked when reasons for refusal to the effect of lack of novelty and an inventive step, were notified in a first notice of reasons for refusal, and where

the reasons for refusal were found later

Example 2: Where reasons for refusal are found later in spite of the fact that no amendment was made to claims for which the first notice of reasons for refusal stipulated that no reasons for refusal was found.

Example 3: Where reasons for refusal based on lack of novelty or lack of an inventive step are found later in spite of the fact that amendment for restriction was made to a claim for which no reasons for refusal, or neither lack of novelty or lack of an inventive step, was notified by the first notice of reasons for refusal

Example 4: Where an examination was not performed in connection with novelty, an inventive step, etc. in spite of the fact that there was no rational reasons for not conducting the examination (see "Section 2 Prior Art Search and Determination on Novelty, Inventive Step, etc." 2(3)) at the first notice of reasons for refusal, and where reasons for refusal pertinent to novelty, an inventive step, etc. are to be notified in a second-time notice of reasons for refusal.

Example 5: As to claimed invention that includes matters specifying the invention that are expressed by choice A or B, both A and B were rendered as objects of examination. However, a reason for refusal was notified only for an invention grasped from the choice A in the first notice of reasons for refusal, and a reason for refusal was not notified for an invention grasped from the choice B. When reasons for refusal are notified for the invention grasped from the choice B in the second notice of reasons for refusal, the second-time notification is the case

(2) The case where appropriate reasons for refusal are notified again because the reasons for refusal presented in the first notice of reasons for refusal are inappropriate

Example 6: No amendment was made in response to a first notice of reasons for refusal, whereas only a written opinion was submitted. When reasons for refusal are notified again, it is the "non-final notice of reasons for refusal".

Example 7: Reasons for refusal, such as lack of an inventive step, were notified in a first notice of reasons for refusal by citation of a prior-art document, amendment was made in response to the notice. In such a case, it is determined that the previous reasons for refusal are unreasonable with respect to the claims that have not been amended in view of the content of written opinion. When reasons for refusal are again notified by citing a different new prior-art document, it is

the "non-final notice of reasons for refusal".

Example 8: When reasons for refusal based on lack of novelty and lack of an inventive step are notified for the invention made up of a matter A specifying the invention and a matter B specifying the invention, amendment was made to A, but no amendment was made to B. In such case, it is the "non-final notice of reasons for refusal" if reasons for refusal are again notified by changing a prior-art document because the prior-art documents cited for B, which was not amended, is inappropriate.

4. Points to Note at the Time of Notice of Reasons for Refusal

A notice of reasons for refusal must specifically state reasons for refusal so that an applicant can clearly comprehend an intended meaning of the reasons. Reasons for refusal and answers to the reasons by the applicant become important materials later in defining a technical scope of a patented invention later as well as during procedures in the Patent Office. Therefore, reasons for refusal must be clear even when viewed from third parties.

Specifically, the examiner shall notify reasons for refusal while paying attention to the following points.

(1) The examiner shall state reasons for refusal as concisely and clearly as possible so that the applicant can comprehend the reasons for refusal.

At this time, the examiner shall state reasons for refusal without being redundant to a great extent than required so that the applicant can make an amendment to acquire a patent right and so that the applicant can comprehend the essence of the reasons for refusal.

(2) Reasons for refusal are shown for each claim except reasons for refusal that cannot be determined for each claim (improper descriptions throughout the description, addition of a new matter, and the like). Further, a claimed invention for which reasons for refusal are found and a claimed invention for which reasons for refusal are not found can be distinguished from each other.

Incidentally, the examiner can make a remark on claims collectively in reasons for refusal as long as the same explanation of e.g. a comparison the claimed invention and cited invention and a determination shall apply to the claims in common.

(3) After a difference between the claimed invention and a cited invention is made clear, a rationale for negating an inventive step of the claimed invention is stated in reasons for refusal pertinent to lack of an inventive step.

(4) The examiner shall show only reasons for refusal in connection with Article 37 or Articles 17bis(4) for each of the following inventions after clearly stating that the invention was not examined in connection with requirements other than those set forth in Article 37 or Articles 17bis(4), with regard to an invention (violating Article 37) which is not an object of examination in connection with requirements other than Article 37 in light of "Part II, Chapter 3 Unity of Invention" and an amended invention (not complying with Article 17bis(4)) that is not an object of examination in connection with requirements other than Article 17bis(4) in light of "Part 4 Chapter 3 Amendment Changing Special Technical Feature of Invention."

(5) As to an invention excluded from object of prior-art search, the examiner may show only applicable reasons for refusal while clearly stating that the invention was not examined in connection with novelty, an inventive step, etc.

However, the examiner must pay attention to minimize the number of inventions to be excluded from objects of prior-art search ("Section 2 Prior Art Search and Determination on Novelty, Inventive Step, etc.")

(6) When statements, etc., of the description fail to comply with the requirements set forth in Article 36(4)(i) or items of paragraph (6), the examiner shall specifically state portions of non-compliance and their reasons.

(7) Where rendering a "final notice of reasons for refusal," the examiner shall state that the notice is "final" and reasons thereof. Where the examiner shall not have stated either that the notice is final or the reasons thereof, the examiner shall not handle the patent application, as if the "final notice of reasons for refusal" were issued, even when the notice of reasons for refusal is appropriate to be handled as a "final."

Specifically, even if amendment made to the notice of reasons for refusal does not fulfill any of the requirements set forth in Articles 17bis(3) to (6), the examiner shall not decide to dismiss the amendment.

(8) When citing prior-art documents, and others, the examiner shall pay attention to the

followings:

- a The examiner shall specify cited documents, and others, and provide statements in such a way that cited portions required to be compared with a claimed invention and make a determination become noticeable.
- b The examiner shall clearly show technical details found from cited documents, and others.
- c The Examiner shall sufficiently examine a necessity as to whether or not cited documents, and others, are only those necessary and sufficient for reasons for refusal.

(9) The examiner shall suggest the amendments, the divisional application and so on in the notice of reasons for refusal etc. willingly where it may be pointed out how the applicant can respond to overcome the reasons for refusal. (See 2.1 in "Section 8 Communication with Applicant and Request for Documents etc. Required for the Examination")

Note: When any ambiguity of interpretation is found in this provisional translation, the Japanese text shall prevail.

Part 1 Chapter 2 Section 4 Handling of Written Opinion, Written Amendment, etc.

Section 4 Handling of Written Opinion, Written Amendment, etc.

1. Overview

When finding reasons for refusal, the examiner shall notify reasons for refusal by designating a predetermined time limit. When receiving a notice of reasons for refusal from the examiner, the applicant may submit a written opinion (Article 50).

Further, the applicant may make amendment to the description, etc. within the predetermined time limit (Article 17bis).

When the applicant submits a written opinion, a written amendment, etc., the examiner conducts an examination after sufficiently reviewing details of them.

2. Handling of Written Opinion, Written Amendment, etc.

When the applicant submits a written opinion, a written amendment, etc., the examiner proceeds with the examination along the following procedures.

2.1 Handling of written opinion, written amendment, etc.

2.1.1 Handling of written opinion, certificate of experimental results, etc.

A written opinion or certificate of experimental results are no substitute for "Detailed Description of the Invention" in the description. However, these are submitted to clarify or verify that matters stated in the originally-attached description, etc., (referred to in this paragraph as "original description, etc.") are correct and reasonable. Therefore, when the written opinion or certificate of experimental results are submitted, the examiner shall sufficiently take details of them into account.

2.1.2 Handling of written amendment

When a written amendment is submitted before the first examination or in response to a non-final notice of reasons for refusal, the examiner shall conduct an examination on the basis of the description, claims or drawings amended by the written amendment.

When a written amendment is submitted in response to the final notice of reasons for refusal, the examiner shall accept the amendment if the decision to issue the "final notice of reasons for refusal" is inappropriate or if the amendment is legitimate, and shall conduct examination on the basis of the description, claims and drawings amended by the amendment. When the decision to issue the "final notice of reasons for refusal" is appropriate and when the amendment is illegitimate, the examiner shall dismiss the amendment and conduct examination on the basis of the description, claims and drawings before submission of the amendment (see 2. and 3. in "Section 6 Decision of Dismissal of Amendment".)

2.2 Review of details of written opinion, written amendment, etc.

When the written amendment is submitted before the first examination, the examiner shall conduct prior art search and review whether or not there is any reason for refusal after sufficiently going through details of the written amendment.

When the written opinion, the written amendment, etc. are submitted in response to the notice of reasons for refusal, the examiner shall sufficiently take details of them into account, confirm whether or not the reasons for refusal indicated in the notice of reasons for refusal were appropriate, and subsequently review whether or not the notified reason for refusal has been overcome, or there is any other reason for refusal.

When amendment is not submitted in response to the notice of reasons for refusal but a written opinion, etc. is submitted, the examiner shall confirm whether or not the notified reasons for refusal were appropriate after sufficiently taking details of the written opinion, etc. into account. Subsequently, the examiner shall review (i)whether or not the notified reasons for refusal have been resolved and (ii)whether or not there is any other reason for refusal.

Further, in the case where the written opinion, the written amendment, etc. is submitted in response to the final notice of reasons for refusal, when the examiner decides to decline the amendment in the written amendment, the examiner shall confirm, on the basis of the description, claims or drawings before submission of the written amendment, whether or not the notified reasons for refusal were appropriate. In addition, the examiner shall review (i)whether or not the notified reasons for refusal have been resolved and (ii)whether or not there is any other reason for refusal.

Section 5 Decision

1. Overview

If no reasons for refusal are found for a patent application, the examiner shall render a decision to the effect that a patent is to be granted. (Article 51).

Moreover, when determining that the notified reasons for refusal are not resolved through examination after notification of the reasons for refusal, the examiner shall render a decision of refusal (Article 49).

2. Decision to Grant Patent

(i)When finding no reasons for refusal in first examination of a patent application or (ii)when determining that the reasons for refusal are resolved in second and subsequent examination after notice of reasons for refusal and when no reasons for refusal are found, the examiner shall decide to grant a patent immediately.

3. Decision of Refusal

When deciding that the reasons for refusal are unresolved in examination after notice of reasons for refusal, the examiner shall render a decision of refusal regardless of whether or not the notice of reasons of refusal is "first" or "final." On this occasion, if necessary, the examiner shall render a decision of refusal after ruling that amendment is to be dismissed (see "Section 6 Decision of Dismissal of Amendment" for a decision of dismissal of amendment).

However, where, even when the notified reasons for refusal are unresolved, the examiner can show countermeasures available for the applicant to resolve the reasons for refusal and determine that it is likely to reach an agreement with the applicant for taking such countermeasures, the examiner shall communicate with the applicant and notify reasons for refusal if the agreement is concluded.

The notice of reasons for refusal shall be in principle taken as the "final notice of reasons for refusal" (see 3.2.1(2)(c) in "Section 3 Notice of Reasons for Refusal" 3.2.1(2)c).

The examiner shall pay attention to the following when rendering a decision of

refusal.

(1) The examiner shall determine (i)whether or not the notified reasons for refusal are unresolved and (ii)whether or not the notified reasons for refusal are reasonable by sufficiently reviewing allegations, such as a written opinion, and details of the written amendment.

(2) The examiner shall show all unresolved reasons for refusal in the decision of refusal. In this case, the examiner shall state concisely and clearly so that reasons for refusal pertinent to which claim are unresolved become noticeable. The examiner can make a remark on claims collectively in the decision of refusal as long as the same explanation of e.g. a comparison the claimed invention and cited invention and a determination shall apply to the claims in common.

(3) As to a matter which is rendered as a point of issue in the written opinion, the examiner's determination about the matter is clearly stated.

(4) The examiner shall make a deliberate consideration as to whether or not a decision of refusal might be a "surprise" for the applicant. The examiner shall not render an unreasonable decision of refusal while being obsessed with the notified reasons for refusal.

Section 6 Decision of Dismissal of Amendment

1. Overview

1.1 Patent Act Article 53

When amendment made as a response to the final notice of reasons for refusal (Article 17bis(1)(iii)) does not fulfill any of the requirements stipulated in Articles 17bis(3) to (6), the examiner shall decide to decline the amendment (Article 53(1)).

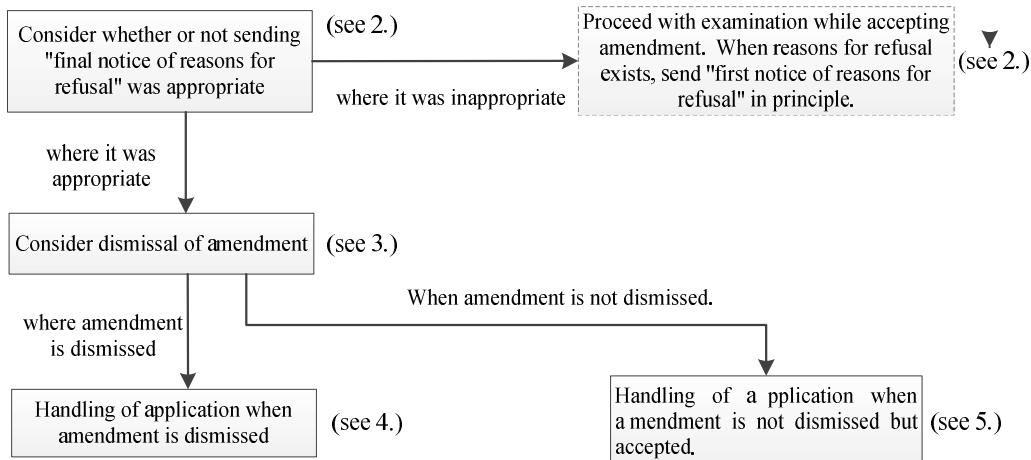
If even a case where amendment made as a response to a second and subsequent notice of reasons for refusal is illegitimate is taken as reasons for refusal of the patent application, reasons for refusal to the effect that the amendment is illegitimate are again notified. Since amendment can be made in response to the notice of reasons for refusal, the amended patent application must be examined again. To avoid such a situation, when amendment made as a response to the "final notice of reasons for refusal" notified after the second examination is illegitimate, the provisions of Article 53 are provided to dismiss the amendment.

1.2 Overview of examination procedures concerning decision of dismissal of amendment

When amendment is made as a response to the "final notice of reasons for refusal," the examiner shall examine whether or not it was appropriate to take the reasons for refusal notified immediately before as the "final notice of reasons for refusal." When determining that sending the "final notice of reasons for refusal" was appropriate, the examiner shall examine whether or not the amendment fulfills the requirements set forth in Article 17bis(3) to (6) (whether or not the amendment is made legitimately). When amendment is illegitimate, the examiner shall dismiss the amendment (see also Figure 2 as to examination procedures employed when amendment is made as a response to the final notice of reasons for refusal).

Meanwhile, from the viewpoint of inhibition of misuse of a divisional application system, where a notice under Article 50bis is issued along with a notice of reasons for refusal and when amendment made as a response to the notice does not fulfill any of the requirements set forth in Articles 17bis(3) to (6), the examiner shall dismiss the amendment (Article 53(1) parentheses. see "Part VI Chapter 1 Section 2

Notice under Article 50bis).



2. Consider Whether or not Sending the Final Notice of Reasons for Refusal was Appropriate

The examiner shall first reconsider whether or not sending the "final notice of reasons for refusal" was appropriate by taking the applicant's argument in the written opinion, etc., into account.

2.1 Where taking the notice as "final notice of reasons for refusal" was appropriate

When taking the notice as the "final notice of reasons for refusal" was appropriate, the examiner shall review whether or not amendment is made legitimately (see 3.)

2.2 Where sending "final notice of reasons for refusal" was inappropriate

When sending the "final notice of reasons for refusal" was inappropriate, Article 53 is not applicable. Therefore, in this case, the examiner shall proceed with the examination based on the description and etc. after amendment, which was made as a response to the "final notice of reasons for refusal," without deciding to decline it. Even when the previously-notified reasons for refusal are unresolved, the examiner shall again notify "non-final notice of reasons for refusal" instead of immediately deciding to reject the patent application. Further, even when only the reasons for refusal which

become necessary to be notified as a result of amendment is notified, the examiner shall again issue a "non-final notice of reasons for refusal" instead of the "final notice of reasons for refusal."

(Points to Note)

When the applicant alleges that the notice should have been the "non-final notice of reasons for refusal" and makes an amendment on the premise that the notice is the non-final notice of reasons for refusal, the examiner shall handle the notice as the "non-final notice of reasons for refusal." In other words, when the reasons for refusal are unresolved, the examiner shall make a decision of refusal. Where only reasons for refusal which become necessary to be notified by amendment are notified, the examiner may handle the notice as the "final notice of reasons for refusal."

3. Consider of Dismissal of Amendment

3.1 Amendment to be dismissed

Amendment to be dismissed is one corresponding to any of (1) to (4) provided below.

- (1) Amendment adding new matters (non-compliance with Article 17bis(3))
- (2) Amendment changing special technical feature of the invention (non-compliance with of Article 17bis(4))
- (3) Amendment for other than the prescribed purposes (violation of Article 17bis(5))
- (4) Amendment not fulfilling requirements for independent patentability (non-compliance with of Article 17bis(6))

3.1.1 Amendment adding new matters (non-compliance with Article 17bis(3))

Amendment, which is made as a response to the "final notice of reasons for refusal" and which corresponds to any either (i) or (ii), corresponds to "amendment adding a new matter" and hence becomes an amendment to be dismissed.

- (i) amendment adding a new matter, and
- (ii) amendment including a new matter pointed out in a "final notice of reasons for refusal"

(Points to Note)

Where a new matter is present at the time of "final notice of reasons for refusal" and where reasons for refusal were not notified on the basis of the new matter, the examination will be carried out based on the description, etc after amendment without dismissal of the amendment even if the amendment serving as a response to the "final notice of reasons for refusal" includes the new matter. In addition, reasons for refusal to the effect that amendment entails addition of a new matter are notified.

3.1.2 Amendment changing special technical features of the invention
(non-compliance with Article 17bis(4))

Amendment, which serves as a response to the "final notice of reasons for refusal" and which corresponds to (i) or (ii) provided below, corresponds to "amendment changing the special technical features of the invention" and hence become an amendment to be dismissed.

- (i) Amendment adding an invention whose special technical features are newly changed (an invention which does not become a target of examination in connection with requirements other than Article 17bis(4) in accordance with "Part IV Chapter 3 Amendment Changing Special Technical Feature of the Invention")
- (ii) Amendment including an invention which is pointed out in the "final notice of reasons for refusal" and whose special technical feature is changed

(Points to Note)

(1) Where amendment to the "non-final notice of reasons for refusal" includes an invention whose special technical feature is modified and where reasons for refusal were not notified for the amendment, the examination will be carried out based on the description, etc after amendment without dismissal of the amendment even when the claims amended in response to the "final notice of reasons for refusal" includes the invention whose special technical features are modified. Reasons for refusal to the effect that the amendment changes the special technical feature of the invention are notified.

(2) Even if an amendment which changes a special technical feature of an invention is made, as long as there is no substantive deficiency in the invention, there is a mere formal deficiency that

the applicant should have divided the application into two or more patent applications in order for it to be examined. Accordingly, it does not directly inflict serious damages on the interests of third parties, even if the patent application to which the amendment which changes the special technical feature of the invention is made is patented. Therefore, failure to fulfill the requirements of Article 17bis(4) constitutes a reason for refusal, but does not constitute a reason for invalidation.

Considering these circumstances, the examiner shall not make an unnecessarily strict determination on whether an amendment is an amendment which changes a special technical feature of an invention.

3.1.3 Amendment for other than the prescribed purposes (non-compliance with Article 17bis(5))

Amendment which is to be made to the claims and which is not made for any of the following purposes (i) to (iv) shall be an amendment to be dismissed.

- (i) Removal of a claim (item (i))
- (ii) Restriction of claims (limited to restriction of matters required to specify a claimed invention such that the invention becomes identical with the invention claimed before amendment in terms of the technical field and the problem to be solved) (referred to in the following as "restriction in a limited way of claims," item(ii))
- (iii) Correction of errors (item(iii))
- (iv) Clarification of an ambiguous statement (limited to the clarification of the matter shown in reasons for refusal, Paragraph 4)

(Points to Note)

Provisions of Article 17bis(5) are provided to enable the examiner to proceed with examination by effectively utilizing existing examination results from the viewpoint of realization of quick granting of right and assurance of equity among applications. Even when the requirements are later found not to have been fulfilled, the amendment is not rendered as ground for invalidation because the amendment has substantive defects, which would invalidate the patent.

Therefore, the examiner shall not apply strictly more than necessary the provision of Paragraph 5 , to the invention that is to be essentially protected when an examination can be quickly performed by effective utilization of the existing examination results.

3.1.4 Amendment not fulfilling requirements for independent patentability (non-compliance with the requirements of Article 17bis(6))

Where a claimed invention that has been amended for "restriction in a limited way of claims" cannot be patented independently, the amendment shall be dismissed because the amendment does not satisfy the requirements for independent patentability.

Examples of amended inventions which cannot be patented independently include the following case (i) and (ii).

- (i) An amended claim in which a new reason for refusal under the following provisions is found although the reasons for refusal notified with respect to the claim before the amendment were resolved.
- (ii) An amended claim for which the reasons for refusal under the following provisions indicated in the "final notice of reasons for refusal" are still unresolved.

Whether or not a claimed invention can be patented independently shall be determined based on the following provisions.

- (i) Eligibility for Patent and Industrial Applicability (The main paragraph of Article 29(1))
- (ii) Novelty (Article 29(1))
- (iii) Inventive step (Article 29(2))
- (iv) Secret prior art (Article 29bis)
- (v) Category of unpatentable invention (Article 32)
- (vi) Description requirements (Articles 36(4)(i), (6)(i) to (iii))
- (vii) Prior application (Articles 39(1) to (4))

Where a claimed invention that has been amended for "restriction in a limited way of claims" fails to involve inventive step (Article 29(2)), for example, the amendment shall be normally dismissed (for exceptions, see (2) of (Points to note) below).

Where a claimed invention that has been amended for "restriction in a limited way of claims" includes improper descriptions (Article 36), the amendment shall be normally dismissed (for exceptions, see (3) of (Points to note) below).

(Points to note)

(1) Patent Act Article 17bis(6) shall be applied only where an amendment for the purpose of restriction in a limited way of claims(Patent Act Article 17bis(5)(ii)) is made.

Therefore, an examiner shall not apply Patent Act Article 17bis(6) to an amendment of claims for deletion of a claim (Article 17bis(5)(i)), correction of errors (Article 17bis(5)(iii)) or clarification of an ambiguous description (Article 17bis(5)(iv)).

(2) Where a claimed invention that has been amended for "restriction in a limited way of claims" has a reason for refusal related to novelty, inventive step, etc., but the reason for refusal related to novelty, inventive step, etc. for the claimed invention before the amendment had not been notified in the final notice of reasons for refusal (except for the case where it is explicitly stated that the invention is deemed as the subject of exclusion from prior art document search because it may be the subject of exclusion from prior art document search), the amendment shall not be dismissed based on that reason. The examiner shall notify the applicant of the reasons for refusal based on the description, etc after amendment.

For example, where a claimed invention that has been amended for "restriction in a limited way of claims" has a reason for refusal due to novelty, inventive step, etc. but the claimed invention had not been excluded from the subject of search and the reason for refusal related to novelty, inventive step, etc. had not been notified in the final notice of reasons for refusal, the amendment shall not be dismissed based on that reason. The examiner shall notify the applicant of the reasons for refusal based on the description, etc after amendment..

However, where a claimed invention that has been amended for "restriction in a limited way of claims" fails to comply with the requirements of Articles 39(2) and (4), the claimed invention before the amendment comply with the requirements of Article 39(2) or (4), and the amendment renders the claimed invention not complying with the requirements of Article 39(2) or (4), the amendment shall be dismissed (for determination whether a claimed invention complies with the requirements of Article 39(2) or (4) are violated and the procedure of the examination, see 3. and 4. of "Part III, Chapter 4, Prior Application").

(3) Regarding a claimed invention that has been amended for "restriction in a limited way of claims," where a reason for refusal due to deficiency in the description etc. exists in the description, etc., and the reason was not notified in the final notice of reasons for refusal although the reason for refusal due to the deficiency had existed before the amendment, the amendment shall not be dismissed based on that reason. The examiner shall notify the applicant of the reasons for refusal based on the description, etc after amendment.

Even if the deficiency in the description is very minor, and is deemed worth granting a patent

by correcting the deficiency in the description by a simple amendment, the examiner shall notify the applicant of the reasons for refusal based on the description, etc after amendment without dismissal of the amendment related to the deficiency in the description in "the final notice of reasons for refusal" to give the applicant an opportunity of re-amendment.

3.2 Procedure for determining whether an amendment was made legally

When determining that an amendment made in response to "the final notice of reasons for refusal" does not satisfy any of the requirements of Article 17bis(3) to (6), an examiner shall dismiss the amendment.

However, all reasons shall be indicated in dismissal of the amendment to allow the applicant to make an appropriate amendment in the request for appeal against the examiner's decision of refusal. An examiner shall determine whether an amendment was made legally in accordance with the following procedure.

- (1) Whether a new matter has been added to the description, the claims or the drawings by the amendment in response to "the final notice of reasons for refusal" (Article 17bis(3), see 3.1.1) shall be determined. Whether the claims to which the amendment has been made for adding a new matter shall be determined on a claim-by-claim basis. With regard to the claim to which the amendment has been made for adding a new matter, the examiner shall not determine whether the amendment falls under the cases prescribed in Article 17bis(4) to (6).
- (2) Whether the amendment falls under "amendments that change a special technical feature of the invention" shall be determined based on the inventions in other claims to which no amendment has been made for adding a new matter (Article 17bis(4), see 3.1.2). With regard to an invention serving as the ground for the determination that the amendment falls under "amendments that change a special technical feature of the invention", the examiner shall not make determination for the respective paragraphs in Article 17bis(5) and Article 17bis(6).
- (3) Based on the inventions in other claims which no new matter has been added to and are not a basis for determination of "amendments that change a special technical feature of the invention", whether the amendment has been made for any of the purposes prescribed in Article 17bis(5)(i) to (iv) shall be determined (Article 17bis(5), see 3.1.3).

- (4) After the determination with respect to Article 17bis(5)(v) in the above (3), where a claim to which the amendment falling under Article 17bis(5)(ii) (restriction in a limited way of claims) has been made is included, whether the amendment of the claim satisfies the requirements of Article 17bis(6) shall be determined (Article 17bis(6). see 3.1.4).
- (5) Where an amended matter determined to fail to satisfy the amendment requirements is found as a result of the determination in accordance with the above (1) to (4), reasons for all such amendments shall be indicated in dismissal of the amendments.

For example, where all claimed inventions have been amended for "restriction in a limited way of claims" and all the amended claims are determined to be unpatentable independently, reasons for invention in all the claims shall be indicated.

3.3 Points to note in dismissal of the amendment due to non-compliance with of requirements for independent patentability

When determining that a claimed invention that has been amended for "restriction in a limited way of claims" cannot be patented due to lack of novelty or inventive step, etc., an examiner shall consider the following points.

- (1) In dismissal of the amendment, the prior art cited in "the final notice of reasons for refusal" shall be, in principle, referred. However, since the claims have been restricted by the amendment, new prior art may be cited.
- (2) Where the amendment is dismissed by referring only the prior art that was not cited in "the final notice of reasons for refusal" and indicating reasons for not granting a patent, there may be cases where the prior art cited in "the final notice of reasons for refusal" was improper. Therefore, it shall be reconsidered whether the contents of "the final notice of reasons for refusal" are proper and maintainable. If an examiner determines that the contents of "the final notice of reasons for refusal" are improper, the examiner shall dismiss the amendment and issue a notice of reasons for refusal again without making the decision of refusal.

4. Handling of the Application When the Amendment is Dismissed

Where an amendment is dismissed, the application is returned to the state before the amendment. Thus, an examiner shall confirm whether the reasons for refusal indicated in the final notice of reasons for refusal made for application before the amendment are proper.

In confirming whether the reasons for refusal indicated in the final notice of reasons for refusal are proper, the contents of the written opinion submitted by the applicant shall be considered.

- (1) Where reasons for refusal indicated in "the final notice of reasons for refusal" are determined to be proper and the reasons for refusal are unresolved, the examiner shall render a decision to dismiss the amendment and render a decision to refusal simultaneously.
- (2) Where reasons for refusal indicated in "the final notice of reasons for refusal" are determined to be improper and any other reason for refusal is not found, the examiner shall render a decision to dismiss the amendment and render a decision to grant a patent simultaneously.
- (3) Where reasons for refusal indicated in "the final notice of reasons for refusal" are improper, but a new reason for refusal is found, the examiner shall render a decision to dismiss the amendment and notify the applicant of the new reasons for refusal with respect to the application prior to the amendment again simultaneously. In such a case, the examiner shall decide whether it should be set to "the final notice of reasons for refusal" or "the non-final notice of reasons for refusal", according to 3. of "Section 3 Notice of Reasons for Refusal", including whether the new reason for refusal was necessitated to be notified by the amendment made in response to "the non-final notice of reasons for refusal".

In addition, because the reasons for refusal shall be notified along with the decision of the dismissal of the amendment, the examiner shall make it clear that it is the reason for refusal for the application before the amendment in the notice of reasons for refusal.

5. Handling of the Application When the Amendment is not Dismissed

- (1) When determining that an application after an amendment resolves a reason for refusal and finding no other reason, an examiner shall decide to grant a patent.
- (2) When determining that an application after an amendment fails to resolve a reason for refusal, an examiner shall make a decision of refusal.
- (3) When determining that an amendment resolves a reason for refusal but finding other new reason for refusal, an examiner shall notify the applicant of the new reason for refusal.
 - (i) Whether a notice should be set to "the final notice of reasons for refusal" or "the non-final notice of reasons for refusal" shall be determined, according to 3. in "Section 3 Notice of Reasons for Refusal".
 - (ii) Where an amendment made in response to "the final notice of reasons for refusal" was not dismissed and a new reason for refusal was notified based on the description, etc after amendment, even if the amendment made in response to the earlier "final notice of reasons for refusal" is found to be illegal afterward, the amendment shall not be dismissed retroactively. In addition, where a new matter are found to be added in the amendment afterward, a reason for refusal shall be notified again.

(Explanation)

Under the provisions of Patent Act Article 159(1) and Article 163(1), where the amendment made in response to "the final notice of reasons for refusal" was found to be illegal after the decision of refusal, an examiner shall not dismiss the amendment retroactively from the viewpoint of facilitation of the proceeding or reconsideration by examiners before appeal proceedings (for the reconsideration by examiners before appeal proceedings, see "Section 7 Reconsideration by Examiners before Appeal Proceedings"). In compliance with this purport, where a new reason for reason was notified based on the description, etc after amendment without dismissal of the amendment after once accepting the amendment made in response to "the final notice of reasons for refusal" and the amendment made for the earlier "final notice of reasons for refusal" is found to be illegal, it shall be handled in the same manner.

Note: When any ambiguity of interpretation is found in this provisional translation, the Japanese text shall prevail.

Part I Chapter 2 Section 7 Reconsideration by Examiners before Appeal Proceedings

Section 7 Reconsideration by Examiners before Appeal Proceedings

1. Overview

As to appeals against the examiner's decision of refusal, those in which the descriptions, etc. were amended in the request for appeal shall be reconsidered before appeal examination by a collegial body of appeal examiners (Patent Act Article 162). This is called "reconsideration by examiners before appeal proceedings".

Many cases of which an original decision of refusal was cancelled at the appeal against the decision of refusal are those of which the description etc. was amended after the decision of refusal. Considering the above fact, in case that amendments were made in a request for appeal, the system of reconsideration by examiners before appeal proceedings was introduced for the purport of reducing the number of cases to be dealt by an appeal examiner and facilitating the appeal by letting the examiner who made decision of refusal examine the relevant case again.

Where decision to grant a patent can be made by the amendment particularly, by letting an examiner who made decision of refusal examine an application again, the examiner can take advantage of his/her knowledge on the application and conduct examination more easily and promptly than a designated appeal examiner begins appeal examination from scratch.

Therefore, reconsideration by examiners before appeal proceedings shall be conducted, in principle, by the examiner who made the decision of refusal.

2. Basic Rules for Reconsideration by Examiners before Appeal Proceedings

In reconsideration by examiners before appeal proceedings, when determining that reasons for refusal in the original decision (decision of refusal) was resolved and any other reason for refusal is not found, an examiner shall cancel the original decision and make a decision to grant a patent.

Where an examiner cannot cancel the original decision and make a decision to grant a patent, the examiner, in principle, shall make a reconsideration report to the JPO Commissioner in the procedure of reconsideration by examiners before appeal proceedings.

However, an examiner shall issue a notice of reasons for refusal in the following case (1) or (2).

- (1) Where an amendment made in the request for appeal is legal and reasons for refusal are resolved by the amendment, but new reasons for refusal are found, and the found new reasons for refusal are only those necessitated to be newly notified by the amendment (Note) (See 3.2.1(2) and 3.2.2(2))
- (2) Where an examiner can indicate a response the requester can take to resolve the unresolved reasons in the original decision, and determines that such a response can make an agreement on the response with the requester, and the agreement is made by communicating with the requester.

(Note)

Reconsideration by examiners before an appeal proceedings is not conducted for reexamining an application to which refusal has been decided. Thus, where only new reasons for refusal necessitated to be newly notified by the amendment are found, an examiner shall issue a notice of reasons for refusal.

3. Flow of Reconsideration by Examiners before Appeal Proceedings

In reconsideration by examiners before appeal proceedings, an examiner shall determine whether the amendment made in the request for appeal is legal (see 3.1), and then continue the reconsideration by examiners before appeal proceedings (see 3.2 and 3.3).

According to the results of the reconsideration by examiners before appeal proceedings, the examiner shall make a decision to grant a patent(cancel the original decision), issue a notice of reasons for refusal or make a reconsideration report.

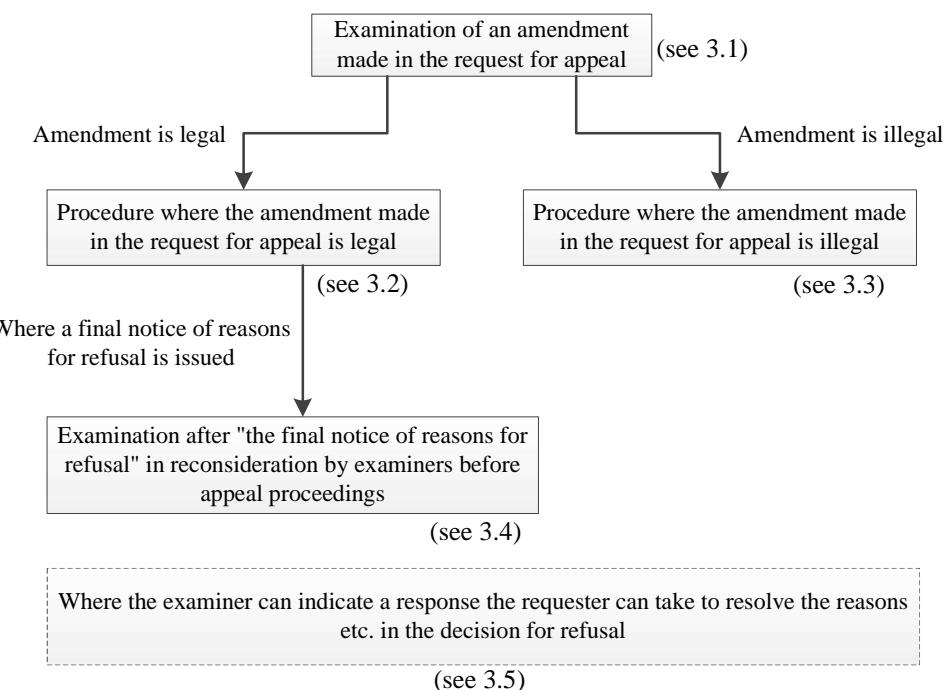
Where a notice of reasons for refusal is issued, an examiner shall continue the reconsideration by examiners before appeal proceedings in accordance with 3.4. According to the result of the reconsideration, the examiner shall make a decision to grant a patent (cancel the original decision) or make a reconsideration report.

Where it is possible to indicate a response the requester can take to resolve the reasons in the decision of refusal, an examiner shall continue the reconsideration by examiners before appeal proceedings in accordance with 3.5.

In making a reconsideration report of reconsideration, an examiner shall indicate any of (i) to (v) applied as the results of reconsideration in the reconsideration

report. For which items should be indicated, see 3.2 and 3.3.

- (i) All reasons to maintain the original decision
- (ii) Determination of dismissal of the amendment and reasons for the dismissal
- (iii) Unresolved reasons for refusal of the reasons for refusal notified in the reconsideration by examiners before appeal proceedings
- (iv) Issuable items in the written request for appeal and the examiner's determination on the items
- (v) Newly found reasons for refusal



3.1 Examination of an amendment made in the request for appeal

At first, an examiner shall determine whether the amendment made in the request for appeal is legal (whether the amendment complies with the requirements of Article 17bis(3) to (6)) (Note).

The examiner shall carry out such determination in accordance with "Section 6 Decision of Dismissal of Amendment". In this case, "amendment made in response to 'the final notice of reasons for refusal'" in this paragraph shall be replaced with "amendment made in the request for appeal".

(Note) Only where the claim has been amended for the purpose of Article 17bis(5)(ii) (restriction of the claims), an examiner shall determine whether the amendment complies with

violate the requirements of Article 17bis(6) (independent patentability).

3.2 Procedure where the amendment made in request for appeal is legal

Where an amendment made in the request for appeal is legal, specifically, the amendment satisfies the requirements of Article 17bis(3) to (6), an examiner shall continue the reconsideration by examiners before appeal proceedings in the following procedures, depending on whether the subject of the amendment is only the description or the drawings, or on which paragraph in Article 17bis(5) the purpose of the amendment falls under based on the description, the claims and the drawings after the amendment.

3.2.1 Where only the description or the drawings are amended, or where the amendment is made for the deletion of a claim or claims, the correction of errors, or the clarification of an ambiguous statement (Article 17bis(5)(i), (iii) or (iv))

After confirming that the reasons in the decision of refusal are proper, the examiner shall determine whether the legal amendment in the request for appeal resolves the reasons in the decision of refusal.

When determining that the reasons in the decision of refusal are resolved, the examiner shall further determine whether any other new reason for refusal is found.

In accordance with the results of the determination, the examiner shall make a decision to grant a patent (cancel the original decision), issue a notice of reasons for refusal or make a reconsideration report, as in the following (1) to (3).

(1) When determining that the reasons in the decision for refusal are resolved and finding no other reason for refusal in the amended description etc., the examiner shall cancel the original decision and make a decision to grant a patent.

(2) When determining that the reasons in the decision for refusal are resolved and finding another reason for refusal in the amended description etc., the examiner shall issue a notice of reasons for refusal or make a reconsideration report, as in the following a or b.

a Where the found reasons for refusal include only reasons for refusal necessitated to be newly found by the amendment (Note), a notice of reasons for refusal shall be, in principle,

issued. In this case, the examiner shall issue "the final notice of reasons for refusal".

- b Where the found reasons for refusal include a reason other than a reason for refusal necessitated to be newly notified by the amendment, the examiner shall make a reconsideration report to indicate the found reason for refusal (a matter of (v) shown in 3.) as the result of the reconsideration.

(Note) The "reasons for refusal necessitated to be newly notified by the amendment" here mean those corresponding to the following (i) or (ii).

(i) A new reason for refusal arising by the amendment made in the request for appeal (for illegal amendments, see 3.3)

(ii) A reason for refusal that had arisen before the decision for refusal but had not need to be determined before the decision for refusal, and as the result that determination of the reason is necessitated by the amendment in the request for appeal a new reason for refusal has been found (Example 1 and Example 2)

Example 1:

Addition of a claim in the amendment in response to the first notice of reasons for refusal had failed to resolve the reasons for refusal indicated in the notice of reasons for refusal. Consequently, the decision for refusal was made without examination on the added claim. This caused the necessity of examination on the added claim in reconsideration by examiners before appeal proceedings. As a result of the reconsideration, a new reason for refusal has been found.

Example 2:

A claimed invention had not been examined for novelty, inventive step, etc. before the decision of refusal because it had been the subject of exclusion from the search. The claimed invention was amended in the request for appeal, and thus, it was not the subject of exclusion from search any more. This caused the necessity of examination of the claimed invention for novelty, inventive step, etc. Consequently, a new reason for refusal based on novelty, inventive step, etc. has been found.

- (3) Where determining that the reasons in the decision for refusal are unresolved, the examiner shall make reconsideration report to indicate matters of (i), (iv) and (v) shown in 3. as the result of the reconsideration.

3.2.2 Where the amendment of the claims is made for restriction of the claims and the amendment satisfies the requirements for independent patentability (Article 17bis(5)(ii), (vi))

An examiner shall determine whether the amended claimed invention has a reason for refusal due to requirements other than the requirements for determination on whether the claimed invention can be patented independently (for example, new matter beyond the original text, (Article 49(6)) (Note)).

The examiner shall make a decision to grant a patent (cancel the original decision), issue a notice of reasons for refusal or make a reconsideration report, in accordance with the determination results, as in the following (1) or (2).

For cases where a claimed invention to which the amendment has been made for restriction of the claims is unpatentable independently, see 3.3.

(Note) Only in cases where doubt arises concerning the consistency between the foreign language document and the description, etc., the examiner shall check the foreign language document and the description, etc. to determine whether a new matter beyond the original text exists. (see "Part VIII, Chapter 2 Examination of Foreign Language Written Application", 2.2).

(1) Where no reason for refusal under requirements other than the requirements for determination on whether the claimed invention can be patented independently is found, the examiner shall cancel the original decision and make a decision to grant a patent.

(2) Where a reason for refusal non-compliance with of requirements other than the requirements for determination on whether the claimed invention can be patented independently is found, the examiner shall issue a notice of reasons for refusal or make a reconsideration report, in accordance with the following (i) or (ii).

(i) Where the found reasons for refusal include only reasons for refusal necessitated to be newly notified by the amendment (see (Note) in 3.2.1(2)), the examiner shall, in principle, issue a notice of reasons for refusal. In this case, the examiner shall issue "the final notice of reasons for refusal".

(ii) Where the found reasons for refusal include a reason other than new reasons for refusal necessitated to be newly notified by the amendment, the examiner shall make a reconsideration report to indicate the found reasons for refusal (a matter of

(v) shown in 3.) as the result of the reconsideration.

3.3 Procedure where the amendment made in the request for appeal is illegal

Where the amendment in the request for appeal is illegal, more specifically, the amendment fails to comply with any of the requirements under the provisions of Articles 17bis(3) to (6) is violated, the examiner shall determine again whether the reasons in the decision for refusal are proper and determine where the description, the claims and the drawings as of the decision of refusal has any other reason for refusal.

The examiner shall make a reconsideration report or make a decision to grant a patent in accordance with the determination results, as in the following (1) to (3).

(1) When determining that the reasons in the decision for refusal are proper, the examiner shall make a reconsideration report to indicate matters of (i), (ii), (iv) and (v) shown in 3. as the result of the reconsideration.

(2) When determining that the reasons in the decision for refusal were not proper and finding no other reason for refusal in the description, the claims and the drawings as of the decision of refusal, the examiner shall decide dismissal of the amendment, cancel the decision of refusal and make a decision to grant a patent.

(3) When determining that the reasons in the decision for refusal are not proper but finding other reason for refusal in the description, the claims and the drawings as of the original decision, the examiner shall make a reconsideration report to indicate matters of (ii), (iv) and (v) shown in 3. as the result of the reconsideration.

(Points to note)

Where the amendment in the request for appeal is illegal, the examiner shall consider the following points.

- (1) In reconsideration by examiners before appeal proceedings, even where the amendment is not made legally illegal, the examiner shall not decide dismissal of the amendment except for cases of deciding to make a decision to grant a patent (Article 164(2)).
- (2) Where the amendment in the request for appeal is illegal, a notice of reasons for refusal shall not be issued, except for cases of 3.5.

3.4 Examination in a case where after "final notice of reasons for refusal" is notified

in reconsideration by examiners before appeal proceedings

3.4.1 Examination where a response is made to the notice of reasons for refusal

(1) Where the written amendment is submitted

In this case, the examiner shall, in principle, conduct the examination in accordance with the above 3.1 to 3.3. In the examination, "in the request for appeal" and "reasons in the decision of refusal" in 3.1 to 3.3 are replaced with "in response to the final notice of reasons for refusal in reconsideration by examiners before appeal proceedings" and "reasons for refusal indicated in the final notice of reasons for refusal in reconsideration by examiners before appeal proceedings", respectively. In making a reconsideration report, the examiner shall indicate matters of (iii) shown in 3. in addition to the matters described in the above 3.2 or 3.3, in the reconsideration report.

Regarding 3.2.1(2) and 3.2.2(2), the examiner shall not issue a notice of reasons for refusal but make a reconsideration report to indicate a matter of (v) shown in 3., except for cases of 3.5.

(2) Where the written amendment is not submitted

In this case, the examiner shall determine whether the reasons for refusal indicated in the notice are resolved by considering the allegations in the written opinion etc.

When determining that the reasons for refusal indicated in the notice is resolved and finding no other reasons for refusal, the examiner shall cancel the original decision and make a decision to grant a patent.

When determining that the reasons for refusal indicated in the notice are unresolved, the examiner shall make a reconsideration report to indicate items (iii) to (v) shown in 3. as the result of the reconsideration.

3.4.2 Examination where no response is made to the notice of reasons for refusal

Where no response is made to the notice of reasons for refusal, the examiner shall make a reconsideration report to indicate items (iii) and (v) shown in 3. as the result of the reconsideration.

3.5 Where the examiner can indicate a response the requester can take to resolve the reasons in the decision for refusal

Where a reconsideration report is to be made but the examiner can indicate a response the requester can take to resolve the unresolved reasons in the decision for refusal or the newly found reasons for refusal and there is a possibility to establish the agreement on the response with the requester, the examiner shall try to communicate with the requester. Where the agreement is established, the examiner shall issue a notice of reasons for refusal.

The notice of reasons for refusal in this case shall be, in principle, "the final notice of reasons for refusal" (see "Section 3 Notice of Reasons for Refusal", 3.2.1(2)c).

3.6 Points to note

(1) Where a basis of determination on the illegality of the amendment or the found reasons for refusal are concerned with requirements that are not regarded as reasons for invalidation (for example, Article 37, Article 17bis(4) and 17bis(5)) and reconsideration by examiners before appeal proceedings can be promptly performed by effectively making use of the examination results already obtained, the examiner shall not formally apply the requirements more strictly than necessary to such an invention as is deemed worth a protection.

(2) When determining that there is no possibility to make a decision to grant a patent, the examiner shall consider to make a reconsideration report, except for cases of 3.2.1(2) and 3.2.2(2).

Note: When any ambiguity of interpretation is found in this provisional translation, the Japanese text shall prevail.

Part I Chapter 2 Section 8 Communication with Applicant and Request for Documents etc.
Required for Examination

Section 8 Communication with Applicant and Request for Documents etc. Required
for the Examination

1. Overview

The examiner shall communicate with the applicant willingly where it may be pointed out how the applicant can respond to overcome the reasons for refusal.

The examiner may suggest the amendments, the divisional application and so on in the notice of reasons for refusal etc., and communicate through the interview, telephone and facsimile (in this part, hereinafter referred to as "interview etc." in this part.) as a means for communication.

Also, the examiner may request the applicant to submit documents or other materials required for the examination (in this part, hereinafter referred to as "documents etc." in this part.) under the provision of Article 194(1) where the examiner considers them to be required for the examination.

2. Means for Communication

2.1 Suggestion of amendments, divisional application and so on in notice of reasons for refusal etc.

The examiner shall suggest the amendments, the divisional application and so on in the notice of reasons for refusal etc. willingly where it may be pointed out how the applicant can respond to overcome the reasons for refusal.

Here, this suggestion does not have any legal effects, and the amendments, the divisional application and so on should be filed by the intention and responsibility of the applicant.

Where the suggestion for the amendments is for overcoming a part of multiple reasons for refusal, the examiner shall describe so as to indicate to which reason for refusal this suggestion pertains.

2.2 Communication through interview, telephone and facsimile

The examiner shall communicate willingly through interview etc. where the

examiners determine that smooth communication with the applicant facilitates stable granting of right. The examiner shall communicate through interview based on the "Guideline for interview 'Patent examination edition'."

When communicating through the interview, the examiner shall prepare an interview record or a response record and contribute it to provide benefit for the access of the public in order to secure transparency in an interview procedure.

2.3 Points to note

The examiner shall be noted that the continuity of examination is ensured and secured even where the examiner in charge of the present application was changed. Where the new examiner intends to determine differently from the previous examiner, the new examiner shall communicate with the applicant as appropriate before the notice of reasons for refusal or the decision of refusal is issued so that the applicant will not be "blindsided."

3. Request for Submission of Documents etc. Required for Examination

The examiner may request the applicant to submit documents etc. required for the examination under the provision of Article 194(1) where the examiner considers them to be required for the examination.

Here, the examiner may also request to submit documents etc. required for the examination in a supplementary note of the notice of reasons for refusal.

(Points to note)

The examiner shall note that the submitted documents etc. are only references for the examination and may not replace the descriptions or drawings.

Note: When any ambiguity of interpretation is found in this provisional translation, the Japanese text shall prevail.

Part I Outline of Examination

Figure 1. Flow of the Examination

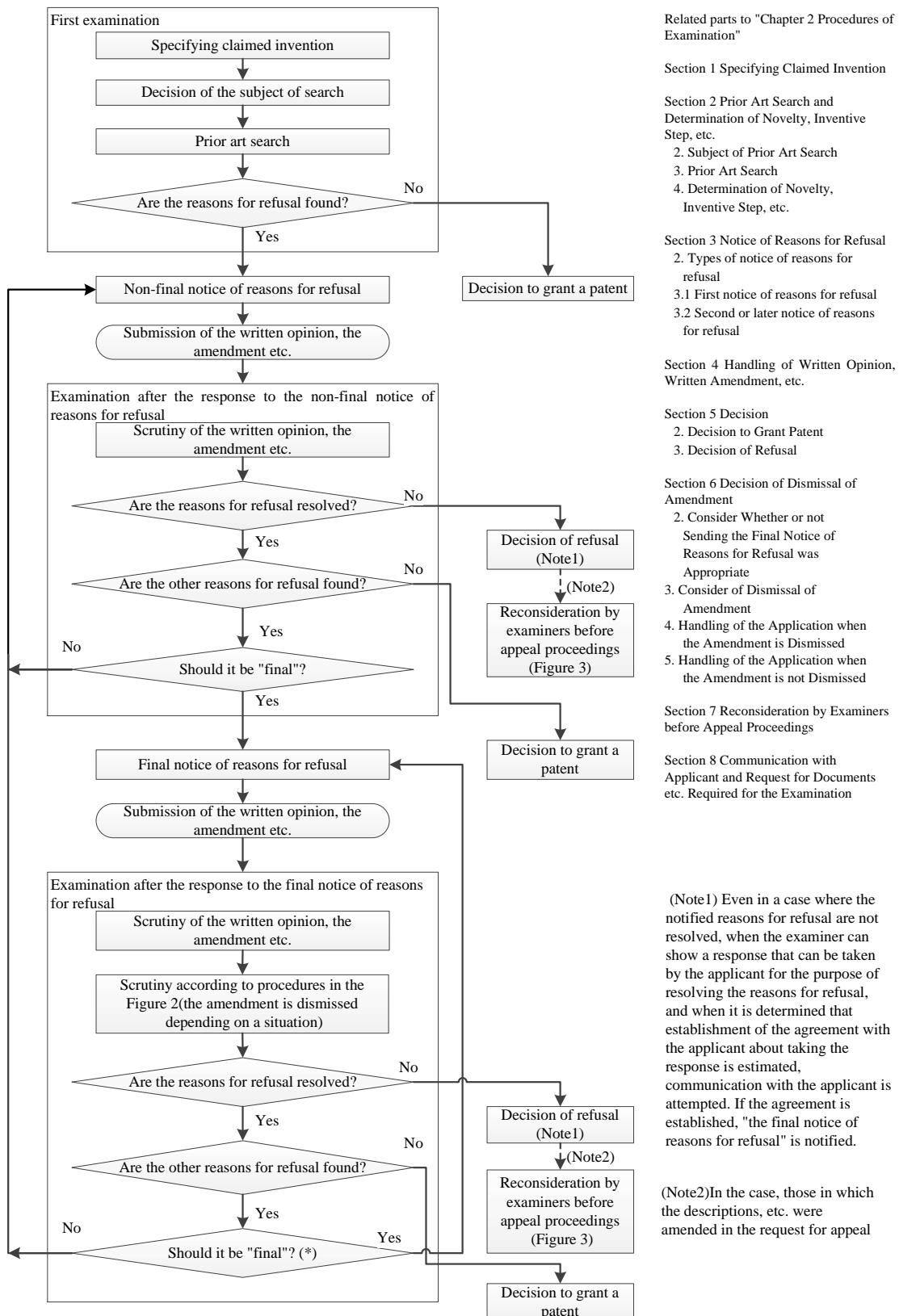
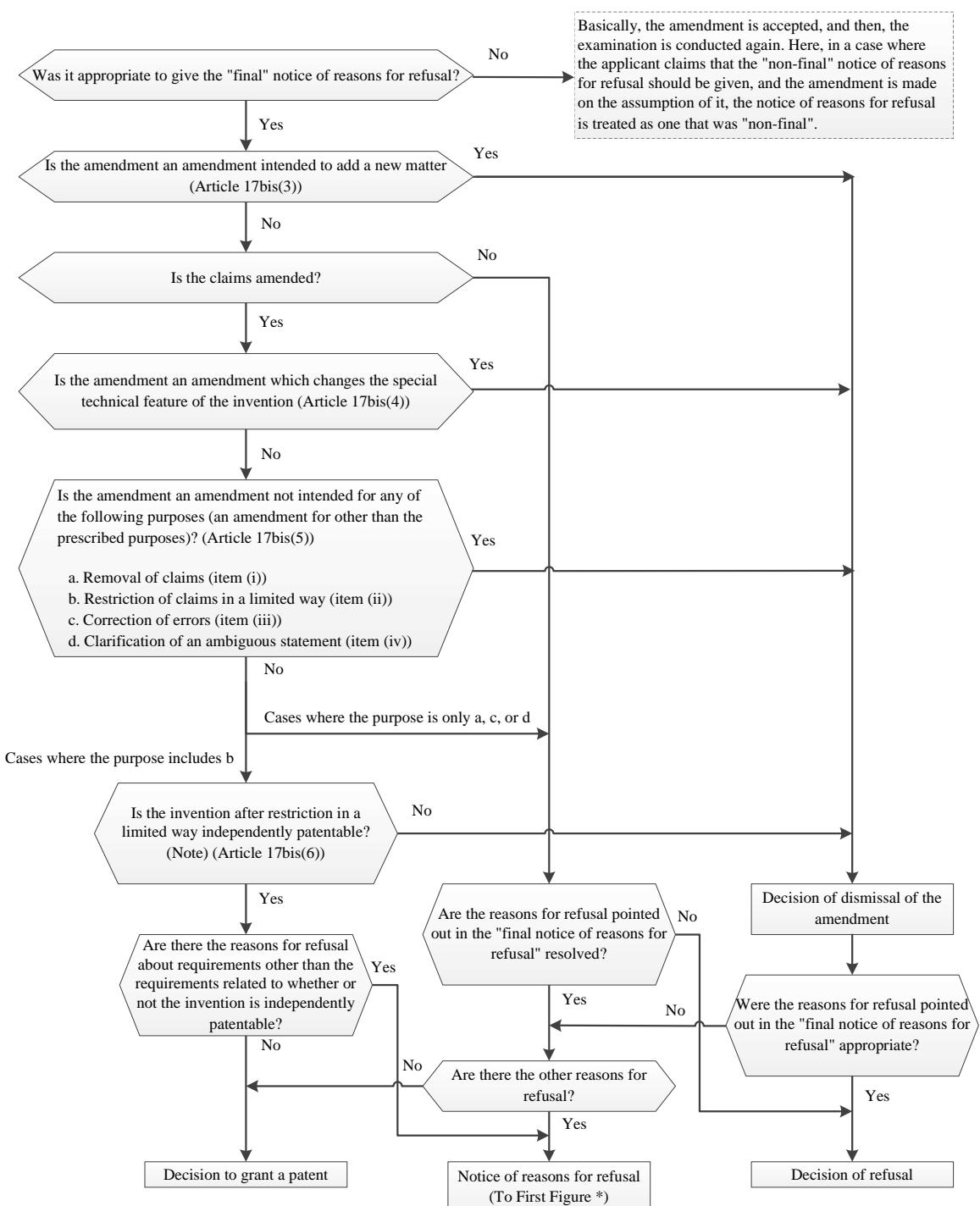
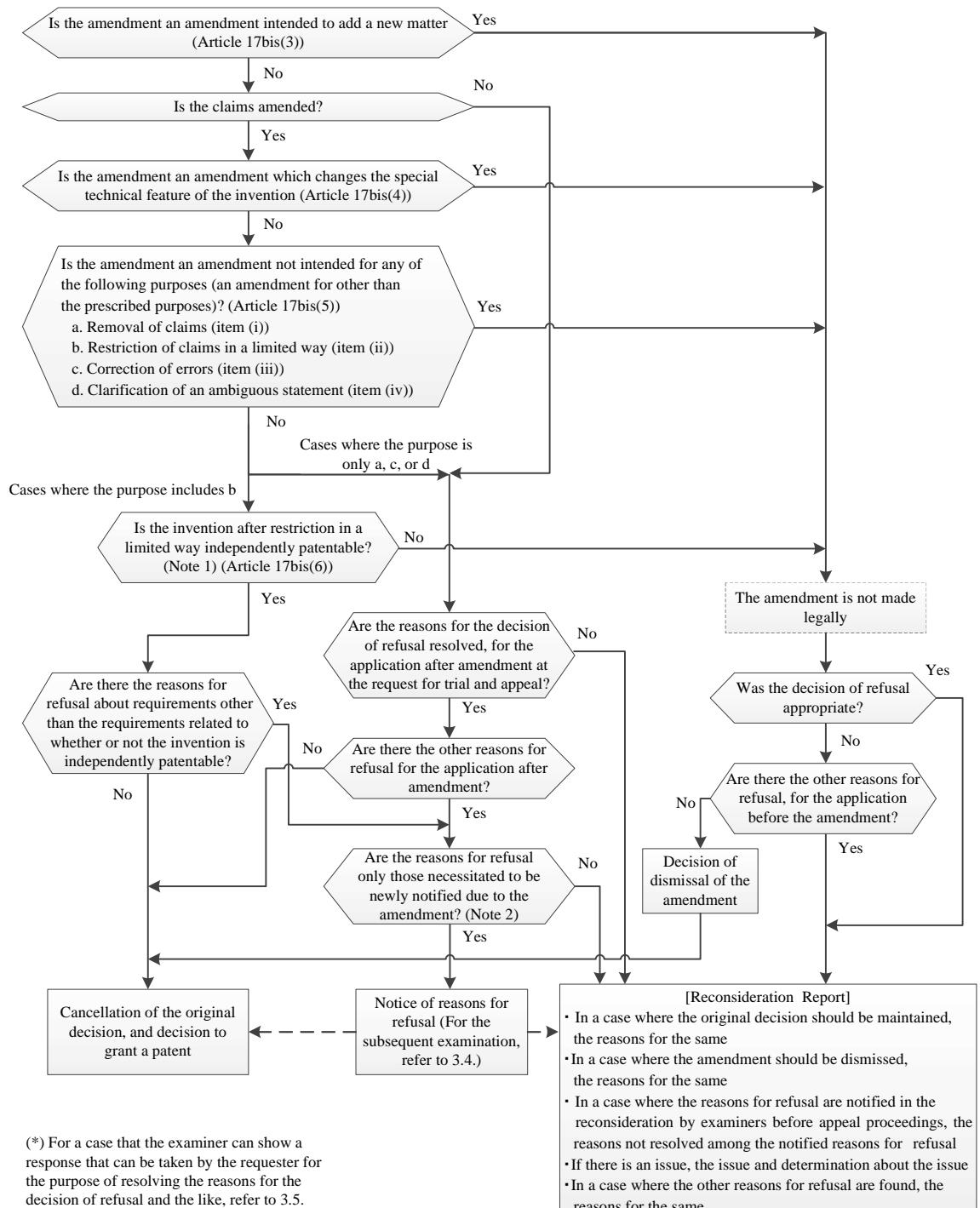


Figure 2. Flow of the Examination in a Case Where an Amendment is made as a Response to the "Final Notice of Reasons for Refusal"



(Note) Whether or not the invention after the amendment is independently patentable is determined on the basis of the following requirements: Article 29, Article 29bis, Article 32, Article 36(4)(i) and (6)(i)-(iii), and Article 39(1)-(4).

Figure 3. Flow of Reconsideration by Examiners before Appeal Proceedings



Note: When any ambiguity of interpretation is found in this provisional translation, the Japanese text shall prevail.

Part I Outline of Examination

<Relevant Provisions>

Patent Act

(Amendment of Description, Claim or Drawings attached to the application)

Article 17bis

- (1) An applicant for a patent may amend the description, scope of claims, or drawings attached to the application, before the service of the certified copy of the examiner's decision notifying that a patent is to be granted; provided, however, that following the receipt of a notice provided under Article 50, an amendment may only be made in the following cases:
- (i) where the applicant has received the first notice (hereinafter referred to in this Article as the "notice of reasons for refusal") under Article 50 (including the cases where it is applied mutatis mutandis pursuant to Article 159(2) (including the cases where it is applied mutatis mutandis pursuant to Article 174(2))and Article 163(2), hereinafter the same shall apply in this paragraph) and said amendment is made within the designated time limit under Article 50;
 - (ii) where, following the receipt of the notice of reasons for refusal, the applicant has received a notice under Article 48septies and said amendment is made within the designated time limit under said Article;
 - (iii) where, following the receipt of the notice of reasons for refusal, the applicant has received a further notice of reasons for refusal and said amendment is made within the designated time limit under Article 50 with regard to the final notice of reasons for refusal; and
 - (iv) where the applicant files a request for a trial against an examiner's decision of refusal and said amendment is made at the same time as said request for said trial.
- (2) to (6) (Omitted)

(Examiner's decision of refusal)

Article 49

The examiner shall render an examiner's decision to the effect that a patent application is to be refused where the patent application falls under any of the following:

- (i) an amendment made to the description, scope of claims or drawings attached to the application of a patent application does not comply with the requirements as provided in Article 17bis(3) or (4);
- (ii) the invention claimed in the patent application is not patentable under Article 25, 29, 29bis, 32, 38 or 39(1) to 39(4);
- (iii) the invention claimed in the patent application is not patentable under the provisions of any relevant treaty;
- (iv) the patent application does not comply with the requirements under Article

36(4)(i), 36(6), or 37;

- (v) where notice under the preceding Article has been given, following the amendment of the description or submission of the written opinion, the patent application does not comply with the requirements under Article 36(4)(ii);
- (vi) where the patent application is a foreign language written application, matters stated in the description, scope of claims or drawings attached to the application of said patent application do not remain within the scope of matters stated in foreign language documents; and :
- (vii) when the patent applicant does not hold the right to receive a patent concerning the invention.

(Notice of reasons for refusal)

Article 50

Where the examiner intends to render an examiner's decision to the effect that an application is to be refused, the examiner shall notify the application for the patent of the reasons therefor and give said applicant an opportunity to submit a written opinion, designating an adequate time limit for such purpose; provided, however, that in cases referred to in Article 17bis(1)(i) or (iii) (in the case of Article 17bis(1)(i), limited to the case where the examiner has given a notice set under the next Article along with the notice of reasons for refusal), this shall not apply where a ruling dismissing an amendment under Article 53(1) is rendered.

(Decision to grant a patent)

Article 51

Where the examiner's decision is rendered, the Commissioner of the Patent Office shall serve to the applicant of a Patent a certified copy of the examiner's decision.

(Dismissal of amendments)

Article 53

In the case of Article 17bis(1)(i) or 17bis(1)(iii) (in the case of Article 17bis(1)(i), limited to the case where the examiner has given a notice under Article 50-2 along with the notice of reasons for refusal), where, prior to the service of the certified copy of the examiner's decision notifying to the effect that a patent is to be granted, an amendment made to the description, scope of claims or drawings attached to the application is found not to comply with paragraphs (3) to (6) of Article 17bis, the examiner shall dismiss the

amendment by a ruling.

(2), (3) (omitted)

Article 162

In the case of a request for a trial against an examiner's decision of refusal, where an amendment has been made to the description, scope of claims or drawings attached to the application in the patent application pertaining to the request simultaneously with the request, the Commissioner of the Patent Office shall direct the examiner to examine the request.

Article 163

(1) Provisions of Articles 48, 53 and 54 shall apply mutatis mutandis to an examination under the provision of the preceding Article. In this case, the term "Article 17bis(1)(i) or (iii)" in Article 53(1) shall be deemed to be replaced with "Article 17bis(1)(i), (iii) or (iv)" and the term "an amendment" in Article 53(1) shall be deemed to be replaced with "an amendment (in the case of Article 17bis(1)(i) or (iii), excluding the amendment made prior to the request for a trial against an examiner's decision of refusal)."

(2) Provisions of Article 50 and Article 50bis shall apply mutatis mutandis where a reason for refusal which was not contained in the examiner's decision concerned in the request for a trial is found in the examination under the provision of the preceding Article. In this case, the term "in the case of Article 17bis(1)(i) or (iii) (in the case of Article 17bis(1)(i), limited to the case where the examiner has given a notice under the next Article along with the notice of reasons for refusal)" in the proviso to Article 50 shall be deemed to be replaced with "in the case of Article 17bis(1) (limited to the case where the examiner has given a notice under the next Article along with the notice of reasons for refusal, and excluding the case where the applicant has made an amendment prior to the filing of a request for a trial against an examiner's decision of refusal), (iii) (excluding the case where the applicant has made an amendment prior to the filing of a request for a trial against an examiner's decision of refusal) or (iv)."

(3) Provisions of Articles 51 and 52 shall apply mutatis mutandis where a request for a trial is found to have reasonable grounds in the examination under the provision of the preceding Article.

Article 164

- (1) In an examination under the provision of Article 162, where the examiner renders a decision to the effect that a patent is to be granted, the examiner shall rescind the examiner's decision of refusal that is the basis of the trial request.
- (2) Except in the case provided in the preceding paragraph, the examiner may not render a ruling dismissing an amendment under Article 53(1) as applied under Article 163(1).
- (3) Except in the case provided in paragraph (1), the examiner shall report to the Commissioner of the Patent Office the result of the examination without rendering a decision on the request for said trial.

(Submission of documents, etc.)

Article 194

- (1) The commissioner of the Patent Office or the examiner may request a party in a case to submit documents or other materials required for a procedure other than one relating to opposition, a trial, or a retrial.
- (2) (Omitted)

Part II

Description and Claims

Note: When any ambiguity of interpretation is found in this provisional translation, the Japanese text shall prevail.

Part II Description and Claims

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Chapter 1 Requirements for Description

Section 1 Enablement Requirement (Patent Act Article 36(4)(i))

1. Overview

The purpose of the patent system is to encourage inventions by promoting the protection and the utilization of inventions and thereby to contribute to the development of industry (Patent Act Article 1).

The patent system is designed to promote protection of inventions by granting an exclusive right, i.e., a patent right, under predefined conditions for a predefined period of time to a person who has developed and disclosed novel technology or techniques, and to give third parties an opportunity to gain access to the inventions by virtue of disclosure of technical details of the inventions. Such a protection and utilization of inventions are promoted through the description, claims and drawings (hereinafter referred to as "description, etc.") which serve both as a technical document that discloses technical details of inventions and as a document of title that clearly defines the technical scope of patented inventions.

Article 36(4) provides the requirements for the description. Among items of the paragraph, Article 36(4)(i) mainly stipulates the requirement for the description so as to serve as the technical document. If the statement in the description is not clear, its role of the disclosure is undermined, which in turn undermines the very purpose of the patent system. In this sense, Article 36(4) is a very important provision.

Article 36(4)(i) requires that "in accordance with Ordinance of the Ministry of Economy, Trade and Industry, the statement shall be clear and sufficient in such a manner as to enable any person ordinarily skilled in the art (Note) to which the invention pertains to work the invention." The requirement that the statement be "in accordance with Ordinance of the Ministry of Economy, Trade and Industry" as stated in Article 36(4)(i) is referred to as the Ministerial Ordinance requirement (see "Section 2 Ministerial Ordinance Requirement"), and the requirement that the statement be "clear and sufficient in such a manner as to enable any person ordinarily skilled in the art to which the invention pertains to work the invention" as stated in the same item is referred to as "the enablement requirement." This Section deals with the enablement requirement.

(Note) Throughout this Part, the term "a person ordinarily skilled in the art to which the invention

pertains to work the invention" means a person assumed to be one who has the common general knowledge in the technical field of the claimed inventions at the time of filing and satisfies the following conditions (i) and (ii) (hereinafter referred to as "a person skilled in the art" in this Part.):

- (i) being capable of using ordinary technical means for research and development (including document analytics, experimentation, analysis, and manufacture); and
- (ii) being capable of exercising ordinary creativity such as selection of materials and modification of design.

2. Basic Ideas of Determination of Enablement Requirement

(1) The statement in the description must be so clear and sufficient that a person skilled in the art can carry out the claimed invention.

Article 36(4)(i) requires that "the statement shall be clear and sufficient in such a manner as to enable any person ordinarily skilled in the art to which the invention pertains to work the invention." The term "to work the invention" in the above provision means "to carry out the claimed invention".

It should be noted that it does not constitute a failure to comply with enablement requirement that inventions other than the claimed invention are not stated sufficiently to meet the enablement requirement, or that extra matters which are unnecessary for carrying out the claimed inventions are stated in the description.

(2) If a person skilled in the art who intends to carry out the claimed invention cannot understand how to carry out the invention on the basis of teachings in the description and drawings relevant to the invention as well as the common general knowledge (Note) at the time of filing, such a description is regarded as being insufficient for the person skilled in the art to carry out the invention.

Also, if it is necessary to make trials and errors, and/or complicated and sophisticated experimentation beyond the extent to which a person skilled in the art should be reasonably expected to do so as to find out how to carry out the invention, then such a description is regarded as not being described to such an extent that the person skilled in the art can carry out the invention.

(Note) The term "common general knowledge" refers to the art generally known to a person skilled in the art (including well-known art and commonly used art) or matters obvious from empirical rules. Accordingly, the common general knowledge includes methods of experimentation,

analysis, and manufacture, and technical theories, etc., as far as they are generally known to a person skilled in the art. Whether or not a certain technical matter is generally known to a person skilled in the art should be determined based upon not only the number of documents that describe the matter but also the degree of attention given to the matter by such a person.

The term "well-known art" in this context refers to the art generally known in the technical field such as those described below:

- (i) the art, with regard to which, there exist a significant number of publications (see "Part III, Chapter 2, Section 3 Procedure of Determining Novelty and Inventive Step," 3.1.1), or Web pages, etc. (see "Part III, Chapter 2, Section 3 Procedure of Determining Novelty and Inventive Step", 3.1.2);
- (ii) the art widely known in the relevant industries; or
- (iii) the art that are known in the technical field so widely that there is no need for providing specific examples thereof.

The term "commonly used art" refers to well-known art that is widely used.

(3) The section titled "description of embodiments" usually contains statements of an invention in order to explain in such a manner that the invention can be carried out by a person skilled in the art. If necessary, specific embodiments are described in "examples" section (see Form 29 relating to Rule 24 of the Regulations under the Patent Act). Examples are specific illustrations of the modes for carrying out the invention.

The examples do not need to be provided in cases when the invention can be explained without using the examples in such a manner as to enable a person skilled in the art to carry out the invention based on the statements in the description and drawings as well as the common general knowledge at the time of filing.

3. Detail of Determination of Enablement Requirement

3.1 Determination depending on categories of invention

The examiner, based on the identification of the category of the claimed invention (Note), determines whether or not the statements in the description satisfy the enablement requirement.

(Note) There are three categories: an invention of a product, an invention of a process, and an invention of a process for producing a product (Article 2(3)).

3.1.1 Invention of a product

In regard to an invention of a product, carrying out the invention means making and using the product in question. Therefore, the description must be stated in such a manner as to enable a person skilled in the art to produce and use the product. Specifically, it must comply with the following requirements (1) to (3).

(1) Clear explanation of the invention

To satisfy this requirement, it is necessary that a person skilled in the art can identify an invention from the recitation in a claim, i.e., a claimed invention can be identified, and understand the invention from the statement in the description.

For example, in a case of an invention of a chemical compound, an invention is normally regarded as being clearly explained when the chemical compound as such is recited in the claim either by the name of the chemical compound or by its chemical structural formula.

Each of the claimed elements (Note) must be stated in the description such that the claimed invention can be understood from the elements as a whole without a contradiction among them.

(Note) The term "claimed elements" refers to "matters necessary to specify the invention for which a patent is sought" (see "Chapter 2 Section 1 Patent Act Article 36(5)").

A claim may recite an operation, function, characteristics or properties of a product (hereinafter referred to as "function, characteristics, etc." in this Part) instead of its specific features such as a shape, structure or composition, etc. (hereinafter simply referred to as "structure, etc." in this Part). Meanwhile, it should be noted that, even in this case, the description must state specific features such as a structure of the product. However, this is not the case when a person skilled in the art can understand the specific features which bring a function, characteristics, etc. based on the description and drawings as well as in light of the common general knowledge at the time of filing.

(2) Statement that enables the product to be made

The way to make the product must be concretely stated in the description. However, this is not the case when a person skilled in the art can make the product

based on the statements in the description and drawings as well as the common general knowledge at the time of filing.

In a case where a claim defines a product by its function, characteristics, etc., and such function, characteristics, etc. are neither standard nor commonly used by a person skilled in the art, the description must state the definition of such function, characteristics, etc., or the method for testing or measurement for quantitatively determining such function, characteristics, etc. in order to state sufficiently for the claimed invention to be carried out.

When the claimed invention pertains to a technical field where it is difficult to predict the structure, etc. of a product from its function, characteristics, etc., and a person skilled in the art cannot understand, even though the statements in the description and drawings as well as the common general knowledge at the time of filing are taken into account, how to make the product defined by its function, characteristic, etc., the statement in the description fails to comply with the enablement requirement, except for products, manufacturing methods of which are concretely stated in the description, or products which can be made from the products stated concretely taking into account the common general knowledge. For example, this is the case when a person skilled in the art who intends to carry out the invention would have to make trials and errors and/or complicated and sophisticated experimentation beyond the reasonably expected extent.

Example: R receptor activating compounds obtained by a specific screening method

(Explanation)

The description does not include any statements as to chemical structures or manufacturing methods of R receptor activating compounds other than the novel R receptor activating compounds X, Y, and Z disclosed as examples, and there is no other clue that infers the chemical structure, etc. Therefore, the enablement requirement is not satisfied.

Also, it is required to state a function, or a role each claimed element has (namely, its operation) when a person skilled in the art needs such information for making the product.

On the other hand, when a person skilled in the art can make the product based on the statements of the structure, etc. illustrated as an example or the common general knowledge at the time of filing, the examiner should not determine that it

constitutes failure to comply with the enablement requirement even in the absence of a statement as to the manufacturing method thereof.

(3) Statement that enables the product to be used

The way of using the product must be concretely stated in the description. However, this is not the case when a person skilled in the art can understand how to use the product without an explicit statement, on the basis of the statements in the description and drawings as well as the common general knowledge at the time of filing.

For example, in a case of an invention of a chemical compound, it is necessary to state at least one particular technically significant use of the compound in order to show that it can be used.

When an invention pertains to a technical field, such as chemical compounds, where it is relatively difficult to understand how to make and use a product on the basis of their structures or names, normally, one or more representative examples are necessary for the description to be stated such that a person skilled in the art can carry out the invention. In addition, in a case of a use invention, e.g., medicine, examples supporting the use in question are usually required.

Also, it is required to state a function, or a role each claimed element has (namely, its operation) when a person skilled in the art needs such information for using the product.

On the other hand, absence of the statement of a use of the product does not constitute failure to comply with the enablement requirement in a case when a person skilled in the art can use the product by taking into account statement of the structure of the invention disclosed as an example and the common general knowledge at the time of filing.

3.1.2 Invention of a process

Since that an invention of a process can be worked implies that it is possible to use the process in question, the description must be stated such that the use of the process is made possible. Specifically, the description must comply with the following requirements (1) to (2).

(1) Clear explanation of the invention

To satisfy this requirement, it is necessary that an invention can be identified from a claim, i.e., the claimed invention can be identified, and can be understood from the statement in the description.

(2) Statement that enables the process to be used

There are various types of inventions of a process other than those for producing a product (so-called "pure process"), such as a method for using a product, a measurement method, and a controlling method, etc. For any type of them, the description must be stated such that a person skilled in the art can use the process on the basis of the statements in the description and drawings as well as the common general knowledge at the time of filing.

3.1.3 Invention of a process for producing a product

If an invention of a process falls under "an invention of a process for producing a product," then that the process can be used implies that it is possible to produce the product by the process. Accordingly, the description must be stated such that it is possible to produce the product by the process. Specifically, the description must comply with the following requirements (1) and (2).

(1) Clear explanation of the invention

To satisfy this requirement, it is necessary that an invention can be identified from a claim, i.e., the claimed invention can be identified, and can be understood from the statement in the description.

(2) Statement that enables the product to be produced by the process

Various types of inventions of a process for producing a product exist such as a method for manufacturing a product, a method for assembling a product, and a method for processing a product, etc. Any of these methods consists of three factors of (i) a starting material, (ii) process steps therefor, and (iii) a final product. With regard to an invention of a process for producing a product, the description must be stated in such a manner as to enable a person skilled in the art to produce the product by using the process. Accordingly, these three factors must be, in principle, stated in such a manner that a person skilled in the art can produce the product based on the statements in the description and drawings as well as the common general knowledge at the time of filing.

Among these three factors, however, statements of the final product may be

omitted in a case where the final product may be understood by a person skilled in the art from the statements of the starting material and the process steps. For instance, an exemplary case of this exception will be a method for assembling a simple device, wherein structures of its components do not change during the process steps.

3.2 Types of violations of enablement requirement

3.2.1 Improper statement of embodiment

(1) Abstract and/or functional statement of technical means

The statement in the description does not satisfy the enablement requirement when:

- (i) technical means corresponding to the claimed elements is stated merely in an abstract and/or functional manner in the description, and thus a material, apparatus, and/or steps, etc. therefor are unclear; and
- (ii) a person skilled in the art cannot understand the material, apparatus, and/or steps, even in light of the common general knowledge at the time of filing, as a result of which such a person cannot carry out the claimed invention.

(2) Unclear relation between technical means

The statement in the description does not satisfy the enablement requirement when:

- (i) relationship between individual technical means corresponding to claimed elements is unclear in the statement of the embodiment; and
- (ii) the relationship between the technical means cannot be understood even in light of the common general knowledge at the time of filing, as a result of which a person skilled in the art cannot carry out the claimed invention.

(3) No statement of numerical values such as manufacturing conditions

The statement in the description does not satisfy the enablement requirement when:

- (i) numerical values such as manufacturing conditions are not stated in embodiments; and
- (ii) a person skilled in the art cannot understand the above numerical values such as manufacturing conditions even in light of the common general knowledge at the time of filing, as a result of which such a person cannot carry out the claimed

invention.

3.2.2 Violation of enablement requirement because of part of claimed invention, which cannot be carried out, other than embodiments

- (1) Cases where a claim is directed to a generic concept but embodiments only of a part of more specific concepts encompassed by the generic concept are stated in the description in a manner that only the specific concepts can be carried out

The statements in the description do not satisfy the enablement requirement when:

- (i) a claim is directed to a generic concept but embodiments only of a part of more specific concepts encompassed by the generic concept are stated in the description in a manner that only the specific concepts can be carried out; and
- (ii) there is a well-founded reason to find that other specific concepts encompassed by the same generic concept are not stated clearly and sufficiently in such a manner as to enable a person skilled in the art to carry out the invention of the other specific concepts based solely upon the embodiments directed to the specific concepts stated even in light of the common general knowledge at the time of filing. It should be noted that methods of experimentation and analysis may be included in the common general knowledge.

Example1:

A case where a claim recites "a method for manufacturing a synthetic resin molded product comprising molding synthetic resin and then performing a correction to eliminate distortion," while the description states, as an embodiment, only a process wherein thermoplastic resin is extrusion-molded and then distortion is eliminated by heating and softening the obtained molded product. When the process for the distortion correction by heat softening is found to be inappropriate for a molded product made of thermosetting resin, i.e., a rational reasoning can be established that the distortion correction of the embodiment is inappropriate for thermosetting resin in view of the technical fact that thermosetting resin cannot be softened by heating, the statement of the description fails to comply with the enablement requirement.

- (2) Cases where only a particular embodiment is stated in such a manner that a person skilled in the art can carry out the claimed invention

The statement in the description does not satisfy the enablement requirement when:

- (i) only a particular embodiment is stated in the description in such a manner that only that embodiment can be carried out; and
- (ii) there is a well-founded reason to find that, because of the fact that the particular embodiment is a singularity included in the claimed invention or any other similar reasons, a person skilled in the art would be unable to carry out the other parts of the claimed invention even when the statements in the description and drawings as well as the common general knowledge at the time of filing are taken into account. It should be noted that methods of experimentation and analysis may be included in the common general knowledge.

Example:

A claim is directed to "a lens system for a single-lens reflex camera comprising a lens type consisting of three lenses wherein the lenses are placed in order of a positive, a negative and a positive lens from the object side, wherein an optical aberration of the lens system being corrected so as to be equal to or less than X% in image height h." The description states, as an embodiment, an example of specific combination of refractive indices of three lenses, or in addition thereto a specific conditional formula for the indices so that the particular optical aberration correction can be done.

In the technical field of optical lenses, a technical fact is known that a specific combination of refractive indices, etc. which embodies a particular optical aberration is of singular nature. In addition, that particular statement such as the example of refractive indices or conditional formula and the like do not teach any generalized manufacturing conditions. Thus, a rational reasoning can be established that a person skilled in the art would be unable to understand how to carry out the other parts of the claimed invention other than embodiments stated even when taking into account methods of experimentation, analysis and manufacture generally known to such a person.

- (3) When a claim is expressed by the Markush grouping or defined by a result to be achieved, see 5.1 or 5.2, respectively.

4. Examination Procedure for Determination of Enablement Requirement
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4.1 Notice of reasons for refusal

4.1.1 Notice of reasons for refusal regarding enablement requirement

When the examiner determines that the statement in the description fails to comply with the enablement requirement under Article 36(4)(i), he/she notifies a reason for refusal. In the notification of reason for refusal, the examiner identifies a claim related to an invention which cannot be carried out and makes clear that the reason for refusal is not a failure to comply with the Ministerial Ordinance requirement but a failure to comply with enablement requirement under Article 36(4)(i). If applicable, the examiner points out particular statements in the description or drawings which constitute the violation of the enablement requirement. The examiner specifically explains the reason why he/she determines that the claimed invention fails to meet the enablement requirement, while showing the grounds for such a determination, e.g., a part of the statement in the description and details of the common general knowledge at the time of filing that he/she has taken into account when making the determination. The examiner is also required to set forth in the notification, to the extent possible, such a clue, e.g., the extent to which the claimed invention can be carried out, that the applicant understands the appropriate strategy for an amendment that should be made in order to overcome the reason for refusal.

For example, it is not appropriate for the examiner to state the reasons for refusal as stated in the following items (i) or (ii) without specific explanation of the reasons, because this may make it difficult for the applicant to present effective arguments and understand the amendments to be made to overcome the reasons for refusal.

- (i) The reason only reads as follows: "Even by taking into account the common general knowledge at the time of filing, the description cannot be regarded as stating the invention clearly and sufficiently as to enable any person skilled in the art to carry out the invention," without any other information.
- (ii) The statement of the reason reads that the description cannot be regarded as stating the invention clearly and sufficiently as to enable any person skilled in the art to carry out the claimed invention solely relying upon the common belief that "it is difficult to predict in the relevant technical field."

Further, it is preferable that the reason is presented with citation of a reference document to the extent possible. In principle, only documents which are

known to a person skilled in the art at the time of filing may be cited. However, descriptions of later applications, certificates of experimental result, written oppositions for a patent right, and written opinions submitted by the applicant for another application, etc. can be referred to for the purpose of pointing out that the violation stems from inconsistency between the statements in the description or drawings and a scientific or technical fact generally accepted by a person skilled in the art.

4.1.2 Relation between enablement requirement and support requirement (See "Chapter 2 Section 2 Support Requirement" for the support requirement in detail)

The purpose of the enablement requirement is to prevent a patent from being granted for an invention which cannot be carried out by a person skilled in the art. Under the patent system, an exclusive right is given for an invention, under predetermined conditions for a predefined period of time, to a person who discloses the invention as a compensation for the disclosure. If the statement in the description is not clear and sufficient for a person skilled in the art to carry out the invention, the description cannot play a role of disclosure. Therefore, it is determined whether or not the claimed invention would be carried out by a person skilled in the art on the basis of the statement in the description.

On the other hand, the purpose of the support requirement is to prevent a patent right from being granted for an invention which is not made available to the public. Claiming an invention that is not stated in the description would incur granting a patent for an undisclosed invention. To avoid such a consequence, it needs to be determined whether or not a claimed invention is supported by the description.

As mentioned above, both requirements are different in their purposes and also in determination thereof. Hence, it should be noted that a violation of one of the two requirements does not necessarily mean a violation of the other. With these in mind, the examiner determines whether or not the description and the claims satisfy each requirement.

4.2 Arguments and/or explanation, etc. by applicant

In response to a notice of reasons for refusal involving failure to comply with the enablement requirement, the applicant may present an argument, explanation, etc. by submitting a written opinion, certificate of experimental results, and the like.

For example, the applicant may, in a written opinion, point out the common general knowledge, etc. at the time of filing other than those that were taken into account by the examiner when making a determination, and argue that, in light of such common general knowledge, the statement in the description can be regarded to be clear and sufficient enough for a person skilled in the art to carry out the claimed invention. The applicant may also submit a certificate of experimental results to support such an argument presented in the written opinion.

However, when, due to an insufficient statement in the description, the statement in the description cannot be regarded to be clear and sufficient in such a manner as to enable a person skilled in the art to carry out the claimed invention even in light of the common general knowledge at the time of filing, the reason for refusal cannot be overcome even though the applicant submits a certificate of experimental results after filing of the application to make up for such a deficiency and thereby argues that the statement is clear and sufficient.

4.3 Response by examiner to argument and/or explanation, etc. by applicant

When the examiner has been convicted that the statement in the description satisfies the enablement requirement in view of the argument, explanation, etc. (see 4.2), the reason for refusal is resolved. Otherwise, the examiner renders a decision of refusal on the basis of the notified reason for refusal to the effect that the statements in the description do not meet the enablement requirement.

5. Claims Including Specific Expressions

5.1 Markush grouping

The description fails to comply with the enablement requirement when a claim includes alternatives written with the Markush grouping, only a part of which is stated in the description, and there is a well-founded reason to find that a person skilled in the art would be unable to carry out the rest of the alternatives even when taking into account the statements in the description and drawings as well as the common general knowledge at the time of filing. It should be noted that methods of experimentation and analysis may be included in the common general knowledge at the time of filing.

Example:

The claimed subject matter is a method for manufacturing para-nitro-substituted benzene by nitrating a starting compound of substituted benzene, wherein a substituent group (X) is recited in an alternative form as CH₃, OH, or COOH. The description only states, as a working example, a case where the starting compound is toluene, i.e., X is CH₃. If a rational reasoning can be established that such a method is inappropriate when the starting compound is benzoic acid, i.e., X is COOH, in view of the technical fact that, for example, considerable difference in the orientation between CH₃ and COOH exists, the statement in the description does not satisfy the enablement requirement.

5.2 Definition of product by result to be achieved

The description fails to comply with the enablement requirement in a case where, although a claim recites a definition of a product by a result to be achieved, only a particular embodiment is stated in the description in such a manner that a person skilled in the art can carry out such an embodiment, and there is a well-founded reason to find that a person skilled in the art would be unable to carry out the remaining parts of the claimed invention even when taking into account the statements in the description and drawings as well as the common general knowledge at the time of filing. It should be noted that methods of experimentation and analysis may be included in the common general knowledge at the time of filing.

Example:

"A hybrid car, energy efficiency of which while running on electricity is a% to b%, as measured by an X test method" is recited in a claim, but the description only states an embodiment in which such a hybrid car comprises a particular controller for obtaining the above-identified energy efficiency.

In addition, it is common general knowledge at the time of filing in the technical field of hybrid cars that the above-mentioned energy efficiency is normally about x%, which is far lower than a% and it is difficult to realize higher energy efficiency, such as a% to b%. Furthermore, the statement of the hybrid car comprising the particular controller fails to teach a general solution for achieving the above-mentioned high energy efficiency. Accordingly, the rational reason may be established that a person skilled in the art would not be able to understand how to implement the remaining parts of the claimed invention even when the common techniques in the

relevant technical field are taken into account.

6. Points to Note

In the following cases, the enablement requirement is not satisfied only when, in accordance with 3. and 5. above, the description is determined to be not stated clearly or sufficiently as to enable a person skilled in the art to carry out a claimed invention.

- (i) Cases where the statements in the description are unclear since they are not accurately stated in the Japanese language (including improper translation)

This includes the following: unclear relation between the subject and the predicate of a sentence, unclear relation between a modifier and the modified word, errors in punctuation, errors in characters (wrong character, omitted character, false substitute character), and errors in reference signs.

- (ii) Cases where terms are not used consistently through the description, claims and drawings
- (iii) Cases where terms are neither academic terms nor technical terms that are commonly used in academic or technical documents and have no definition in the description
- (iv) Cases where trademarks are used for what can be indicated otherwise
- (v) Cases where a physical quantity in the description is not indicated in units provided for in the Measurement Act
- (vi) Cases where the brief description of the drawings (explanation of drawings and reference signs) has deficiency in relation to the description

Note: When any ambiguity of interpretation is found in this provisional translation, the Japanese text shall prevail.

Part II Chapter 1 Section 2 Ministerial Ordinance Requirement

Section 2 Ministerial Ordinance Requirement (Patent Act Article 36(4)(i))

1. Overview

The Ordinance of the Ministry of Economy, Trade and Industry (Article 24bis of the Regulations under the Patent Act) pursuant to the delegation by Article 36(4)(i) requires stating in the detailed description of the invention "matters necessary for a person ordinarily skilled in the art to which the invention pertains to understand the technical significance of the invention" such as the problem to be solved by the invention and its solution so that the nature of the technical contribution realized by the invention can be understood and examination and search are facilitated (hereinafter referred to as "the Ministerial Ordinance requirement").

Since an invention is a creation of new technical idea, it is important that the invention is stated in the detailed description of the invention so as to make a person skilled in the art understand the technical significance of the invention (i.e., the technical contribution made by the invention) in light of the state of the art as of the filing. The statement relating to what is an unsolved problem, in which technical field such a problem resides, and how such a problem has been solved by the invention in the detailed description of the invention is useful for understanding of the technical significance of the invention.

Also, one who wishes to obtain a hint for research and development or to utilize useful patented inventions from patent documents can easily conduct a search of patent documents by paying attention to the problems to be solved by the inventions. Further, in determining inventive step of an invention, a publicly-known prior art document illustrating a problem to be solved which is common to the invention can be a ground for negating the inventive step of the invention. Meanwhile, determination of inventive step becomes easier for applicants and third parties if both the detailed description of the invention of a patent application subject to the examination and a prior art document contain the statements of problems to be solved.

For these reasons, the Ministerial Ordinance requirement is provided.

2. Determination Regarding Ministerial Ordinance Requirement

(1) Matters required to state under the Ministerial Ordinance requirement are regarded as the following items a and b.

a. Technical field to which an invention pertains

It is required in normal cases that at least one technical field to which a claimed invention pertains be stated in the detailed description of the invention as a technical field to which an invention pertains.

However, the "technical field to which an invention pertains" is not required to be explicitly stated if a person skilled in the art can understand it without such explicit statements when taking into account the statements of the description and drawings, as well as the common general knowledge as of the filing.

Further, on the technical field to which an invention pertains, in cases where the invention does not pertain to existing technical fields such as an invention developed based on an entirely new conception which is completely different from prior art, it suffices that the statements of the new technical field developed by the invention be provided and an application for such an invention does not need to state the existing technical fields.

b. Problem to be solved by the invention and its solution

(a) It is required in normal cases that at least one technical problem that the claimed invention aims to solve be stated as "the problem to be solved by the invention" in the detailed description of the invention.

Also, it is required in normal cases that how the problem has been solved by the claimed invention be explained as "its solution" in the detailed description of the invention.

(b) However, the "problem to be solved by the invention" is not required to be explicitly stated in a case where a person skilled in the art can understand it without such an explicit statement, when taking into account the statements of the description and drawings, which include statements of prior art or advantageous effects of the invention, as well as the common general knowledge as of the filing (including a case where a person skilled in the art could comprehend the problem when considering prior art which falls within the common general knowledge). Also, the statement of the solution of the problem to be solved by the invention does not need to be provided in cases where a person skilled in the art would understand how the problem has been solved by a claimed invention by identifying technical problem in the absence of the explicit statement (for example, in a case where how the invention solved the technical problem can be

understood by identifying the claimed invention in view of the statements of the embodiment, etc.).

(c) Further, the technical problem does not need to be explicitly stated in a case where a technical problem is by nature not conceived for the invention such as the following item (i), (ii), etc.

(i) An invention based on an entirely new conception which is completely different from prior art.

(ii) An invention which is based on a discovery resulting from trials and errors (e.g., inventions of chemical compounds).

In addition, when the technical problem is not conceived as mentioned above, how the problem has been solved by the invention (i.e., its solution) is not necessary, either. This is because "its solution" is only meaningful in connection with the technical problem, and how the technical problem was solved by the invention cannot be identified as long as the very technical problem remains unidentified.

(2) The enablement requirement ensures that the disclosure of how the invention is carried out to the public in return for granting of a patent. Accordingly, granting a patent to an application that does not satisfy the requirement would lead to inadmissible unfairness between a patentee and the third parties.

The purpose of the provision of the Ministerial Ordinance requirement, on the other hand, is to clarify the technical significance of an invention and thereby contributes to patent examinations and searches.

Accordingly, the Ministerial Ordinance requirement should be treated as follows.

a. As mentioned in the above section (1), statements of a problem to be solved and its solution may be omitted when it is found that correct understanding of the technical significance of the invention would rather be prevented due to the requirement that the problem to be solved by the invention and its solution be stated.

Also, when it is not conceived that an invention pertains to any existing technical fields, it suffices that the new technical field to which the claimed invention pertains is stated.

b. In the cases other than the above item a, with regard to such a patent application that a person skilled in the art cannot understand the technical field to which the claimed invention pertains or the problem and its solution on the basis of the statements of the description and drawings as well as the common general knowledge as of the filing, the patent application therefor is regarded as not complying with the Ministerial Ordinance requirement.

For example, if the matters specifying the invention include a numerical formula or numerical value but a person skilled in the art is unable to understand the substantial relationship between the problem to be solved by the invention and the specification by such numerical formula or numerical value on the basis of the statements of the description and drawings as well as the common general knowledge as of the filing, and as a result, unable to understand the solution to the problem to be solved by the invention, then the technical significance of an invention is indefinite, which constitutes a failure to comply with the Ministerial Ordinance requirement.

(3) With regard to prior art and advantageous effect in comparison with the prior art, the following points should be noted.

a. Prior art

Statement of prior art is not required under the Ministerial Ordinance requirement. However, when the technical field to which the invention pertains or the problem to be solved by the invention can be understood from the statement of the prior art, the statement of the prior art can be a substitute for statements of the technical field to which the invention pertains or the problem to be solved by the invention.

b. Advantageous effects over prior art

It is not required under the Ministerial ordinance requirement to state an advantageous effect of a claimed invention over a relevant prior art. However, when the problem to be solved by the invention can be understood from the statement of the advantageous effects, the statement of the advantageous effects can be a substitute for a statement of the problem to be solved by the invention.

(4) It is not required under the Ministerial Ordinance requirement to state industrial applicability.

3. Procedures of Examination concerning Determination on Ministerial Ordinance Requirement

3.1 Notice of reasons for refusal

In the case where the examiner determines that the statement of the detailed description of the invention does not satisfy the Ministerial Ordinance requirement under Article 36(4)(i), the examiner shall issue a notice of reasons for refusal on that requirement. In such case, the examiner shall specify a claim, and clearly present in the notice of reasons for refusal that the detailed description of the invention violates the Ministerial Ordinance Requirement, but does not violate the enablement requirements, while pointing out which of the matters necessary to be stated under Ministerial Ordinance (see 2.(1)) is defective.

3.2 Argument and clarification of applicant

The applicant may present prior arts that the examiner would not have recognized, by a written amendment or a written opinion in response to the notice of reasons for refusal due to the violation of the Ministerial Ordinance Requirement, and may present an argument, a clarification, etc. that a person skilled in the art in the technical field to which the claimed invention pertains could have understood, the problems to be solved by the invention and their solution, by referring to the statements of the description and drawings and common general knowledge as of the filing. The applicant may submit a certificate of experimental results so as to support the argument and the clarification.

However, due to the deficiency of the matters stated in the detailed description of the invention, it sometimes happens that a person skilled in the art could not have recognized the problem to be solved by the invention and its solution, on the basis of the statements of the description and drawings and common general knowledge as of the filing. In such case, even when the applicant submits a certificate of experimental results after the filing of the patent application and compensates for such deficiency in the statement of the detailed description of the invention, and asserts that a person skilled in the art could have recognized the problem to be solved by the invention and its solution, the reason for refusal cannot be overcome.

3.3 Response of examiner to argument and clarification of applicant

In the case where the argument, the clarification, etc. (see 3.2) and the amendment make the examiner convinced that the statement of the detailed description of the invention meets the Ministerial Ordinance Requirement, the reason for refusal shall be deemed to have been overcome. If this is not the case, the examiner shall issue a decision of refusal on the grounds of the reason for refusal that the Ministerial Ordinance requirement is not satisfied.

Note: When any ambiguity of interpretation is found in this provisional translation, the Japanese text shall prevail.

Part II Chapter 1 Section 3 Requirements for Disclosure of Information on Prior Art Documents

Section 3 Requirements for Disclosure of Information on Prior Art Documents

(Patent Act Article 36(4)(ii))

1. Overview

The Patent Act Article 36(4)(ii) prescribes the effect that the source of the information concerning the inventions known to the public through publication (Note) such as the name of the publication and others (hereinafter referred to as "information on prior art documents" in this section.) should be described in the detailed description of the invention when the person requesting the grant of a patent (hereinafter referred to as "applicant" in this section.) has knowledge of any inventions related to said invention, that has been known to the public through publication at the time of filing of patent application (hereinafter referred to as "Requirements for disclosure of information on prior art documents" in this section.).

The information on prior art documents is required for a person skilled in the art and the examiner to understand what technical significance the invention for which a patent is sought has and what technical contribution is brought about in light of the state of the art at the time of filing of patent application. Also, the information on prior art documents is required for the examiner to assess the novelty and inventive step of the invention for which a patent is sought. Therefore, the disclosure of information on prior art documents contributes to prompt examination. Moreover, it contributes to stabilization of the right as accurate evaluation on the relation between the invention for which a patent is sought and the prior art can be made if the information on prior art documents is stated in the detailed description of the invention. To that effect, Article 36(4)(ii) prescribes requirements for disclosure of information on prior art document.

Although the non-compliance with requirements for disclosure of information on prior art documents does not directly correspond to the reason for refusal, it corresponds to the reason for refusal where the notice on non-compliance with requirements for disclosure of information on prior art document under the provision of Article 48septies (hereinafter referred to as "notice under Article 48septies" in this section.) was issued and these requirements have still not been satisfied based on the detailed description of the invention (Article 49(5)).

The provision of the Patent Act Article 48septies prescribes that the notice on non-compliance with these requirements may be issued where the examiner recognized

that it does not comply with the requirements for disclosure of information on prior art documents based on the detailed description of the invention. Although the notice under Article 48septies shall not be issued uniformly, it shall be issued where the examiner recognizes it to be necessary. Even when it does not comply with these requirements, there shall be no substantial deficiency in the invention and it shall not damage the interest of a third person remarkably when it is patented. Also, the reason for refusal on non-compliance with these requirements would be notified surely even to applications without any reasons for refusal on other requirements, which may be contrary to the aim of Article 36(4)(ii) this system whose main purpose is achievement of prompt examination.

(Note) The "inventions known to the public through publication" refer to inventions as provided in Article 29(1)(iii) in the "prior art" in this chapter (the parenthesized portion of Article 36(4)(ii)). The "prior art" means inventions as provided in Article 29(1)-(3) in this chapter, and does not include inventions published at the time of filing of the patent application.

2. Determination of Requirements for Disclosure of Information on Prior Art Documents

The information on prior art documents is required to be described in the detailed description of the invention relating the inventions whose information on prior art documents should be disclosed (see 2.1) in the prior art. (see 2.2)

2.1 Inventions whose information on prior art documents should be disclosed

Inventions for which information on prior art documents should be disclosed refer to inventions corresponding to all of the cases shown in 2.1.1 to 2.1.4 below.

2.1.1 To be the inventions known to the public through publication

An examiner shall note that inventions known to the public through publication(see 1.(Note)) are inventions does not include inventions that were publicly known (Article 29(1)(i) in the same paragraph) and inventions that were publicly worked ((ii) in the same paragraph).

Considering the purposes of requirements for novelty, inventive step, and disclosure of information on prior art documents, it is appropriate to interpret that the

source of the information should be stated in the detailed description of the invention even though it does not fall under the an "invention" that is the creation of a technical idea utilizing a law of nature (Article 2(1)), if it relates to the invention for which a patent is sought. For example, where the invention for which a patent is sought is an invention relating to a business method, the applicant is required to describe the name of publications in which the business method is stated if the applicant knows of the related business method being described in a publication. On the other hand, as an invention described in a prior application, which is undisclosed at the time of filing of the patent application to be examined (In this part, hereinafter, referred to as "present application"), is not an invention known to the public through publication, it is not the subject for disclosure of information on prior art documents. However, it is desirable to describe the application number when the invention concerned relates to the invention for which a patent is sought.

2.1.2 To be invention relating to invention for which patent is sought

The invention for which a patent is sought means the claimed invention.

The examiner shall determine whether an invention known to the public through publication "relates to" the claimed invention by considering matters shown in (i) to (iii) below.

- (i) Relevancy between the claimed invention and the invention known to the public through publication in terms of their technical field
- (ii) Relevancy between in the claimed invention and the invention known to the public through publication in terms of their problems to be solved
- (iii) Relevancy between the claimed invention and the invention known to the public through publication in terms of their matters specifying the invention

For example, an inventions known to the public through publication to be a direct premise of the claimed invention (the inventions known to the public through publication corresponding to a part "in ..." when the claim is recited in the forms of "in ..., characterized in ...") relates to the claimed invention.

Also, when the accumulation of technology that has relevancy with the claimed invention is less, there may be no invention that has direct relevancy such as identical technical field or problem. In such a case, the invention showing the general state of the art to be the technical background of the claimed invention is contained in the invention relating to the claimed invention.

Example : the inventions known to the public through publication relating to the claimed invention

The claimed invention relates to "a portable telephone set with a case consisting of special magnesium alloy", on the contrary, the invention known to the public through publication relates to "a portable telephone set with a case consisting of titanium alloy" and when both have the problem to be solved of weight reduction of a portable telephone set.

2.1.3 To be invention known to applicant

The following are inventions known to the applicant, for example.

- (i) Inventions obtained by the applicant in the prior art search, which was carried out in the research and development stage or filing stage of the claimed invention
- (ii) Invention disclosed in a writing such as a thesis etc. that was announced by the applicant prior to filing of the patent application
- (iii) Invention disclosed in the specifications, claims or drawings of a prior patent application that was filed by the applicant.

The applicant usually seems to understand the information known to the inventor with regard to the claimed invention. Therefore, the inventions known to the inventor may be estimated to be known to the applicant.

Where the applicants are more than one person, the inventions known to the public through publication that are known to at least one of the applicants correspond to the inventions known to the applicant.

2.1.4 To be invention known to applicant at the time of filing of patent application

The applicant is required to describe the information on prior art documents concerning the inventions known to the applicant at the time of filing of the patent application. There is no requirement to carry out the prior art search newly for an applicant who does not know the inventions known to the public through publication relating to the claimed invention at the time of filing of the patent application.

Also, Article 36(4)(ii) does not require to add to the detailed description of the invention by amendments the inventions known to the public through publication that were known to the applicant after filing of the patent application. However, it is desirable to add to the specification by amendment the information on prior art

documents concerning the inventions known to the public through publication that were known to the applicant after filing of the patent application, or to present said information by a written statement where the applicant considers said inventions to contribute to prompt and accurate examination.

Where there are inventions known to the public through publication at the time shown in the right column regarding the application shown in the left column in the following table, the information on prior art documents concerned is required to be described. Where a divisional application, a converted application or a patent application based on utility model registration is filed at the time of filing of new patent application, as they do not comply with requirements for divisional application, converted application or patent application based on utility model registration, the inventions known to the public through publication that were known to the applicant at the time of filing of new patent application are the inventions that were known to the applicant at the time of filing of the patent application.

Kinds of application	Time of filing of patent application
Divisional application, converted application or patent applications based on utility model registration	Time of filing of the original application (Article 44(2), Article 46(5), Article 46bis(2))
Application with internal priority claim	Time of filing of the present application (Article 41(2))
Application claiming priority under the Paris Convention (or recognized under the Paris Convention)	Time of filing of the present application (application to Japan)
International patent application	International filing date (Article 184ter(1))

2.2 Description of information on prior art documents in the detailed description of the invention

2.2.1 Description of information on prior art documents

It is enough to describe the source of the information concerning the inventions known to the public through publication that were known as the applicant at the time of filing of patent application, such as the name of the publication and others (bibliographic items on a publication describing the inventions known to the public

through publication, and the technical information and other information obtained through electric communication lines). Also, the applicant is not required to submit an original or a copy of the publications etc.

As the requirements for disclosure of information on prior art documents defines the requirements for the statement of the detailed description of the invention, the information on prior art documents is required to be described in the detailed description of the invention. It is impossible to comply with the requirements for disclosure of information on prior art documents by submitting a written opinion or the written statement in which the information on prior art documents is described.

2.2.2 Where there is a large amount of information on prior art documents to be described

Where there is a large number of inventions known to the public through publication relating to the claimed invention, describing all of them may hinder the understanding of the claimed invention and go against the purpose of the requirements for disclosure of information on prior art documents. Therefore, it is desirable to describe appropriate number of inventions with higher relevancy among them. In addition, the inventions known to the public through publication not relating to the claimed invention should not be described.

2.2.3 Where there is no information on prior art documents to be described

Where there is no information on prior art documents to be described at the time of filing of the patent application, it is desirable to describe the effect with reasons in the detailed description of the invention. For example, where the prior art known to the applicant is not that relating to the inventions known to the public through publication (for example corresponding to the inventions provided in Article 29(1)(ii); that is, "inventions that were publicly worked"), that effect shall be described. In addition, the effect that there is no information on prior art documents to be described and reasons may be shown in the written statement.

2.3 Addition of information on prior art documents by amendments

2.3.1 Determination of amendments for adding information on prior art documents

Amendments for adding information on prior art documents to the detailed description of the invention do not fall under the addition of new matter, and are appropriate. Moreover, amendments for adding the contents described in the prior art documents to the column [Background Art] of the detailed description of the invention do not fall under the addition of new matter, and are appropriate. However, amendments to remove the deficiencies under the provision of Article 36(4)(i) by adding the information on evaluation and implementation of the invention such as comparison with the claimed invention and adding the contents described in the prior art documents fall under the addition of new matters, and are inappropriate.

For details, refer to “Part IV Chapter 2 Amendment Adding New Matter”, 3.3.2(1).

2.3.2 Where requirements for disclosure of information on prior art documents are not satisfied by amendments

The requirements for disclosure of information on prior art documents are not satisfied by amendments in the cases shown in (i) and (ii) below. In this case, the requirements for disclosure of information on prior art documents are not satisfied unless the information on prior art documents is added by the amendments.

- (i) Where the claimed invention becomes one that does not correspond to the information on prior art documents by the claim amendments
- (ii) Where the applicant knows the inventions known to the public through publication relating to the claimed invention at the time of filing of the patent application

2.4 Typical cases in which requirements for disclosure of information on prior art documents are not satisfied

The following are typical cases in which it is recognized that the requirements for disclosure of information on prior art documents are not satisfied.

- (i) Where the information on prior art documents is not described and in addition, the reason is not described at all.
- (ii) Where the information on prior art documents is not described and the reason is described; however, it is recognized that the probability is high that the applicant

knows of the inventions known to the public through publication relating the claimed invention at the time of filing of the patent application.

Example1: Where the information on prior art documents is not described and as the reason, it is described that the prior art known to the applicant is not that relating to the inventions known to the public through publication, however, the applications are disclosed by the applicant in great numbers in the technical field relating to the claimed invention.

(iii) Where the prior art is described in the specifications or drawings but the information on prior art documents corresponding to the prior art concerned is not described and the reason is not described.

The invention described in the specifications or drawings as a prior art shall be treated as an invention that was known to the applicant at the time of filing of the patent application.

(iv) Where only the source of information concerning the inventions known to the public through public not relating to the claimed invention is described, and it is recognized that the probability is high that the applicant knows the inventions known to the public through publication relating to the claimed invention at the time of filing of the patent application.

Example 2: Where only the information on prior art documents on the matters not relating to the claimed invention and being different in technical field or subject from the claimed invention is described, in spite of the fact that the inventions known to the public through publication, which are identical in technical field and subject to the claimed invention are known widely in general

Example 3: Where the information on prior art documents on an old invention known to the public through publication with less connection is described in spite of the fact that new inventions known to the public through publication with high relevancy to the claimed invention are known widely in general

3. Procedure of Examination for Determination of Requirements for Disclosure of Information on Prior Art Documents

The non-compliance with the requirements for disclosure of information on prior art documents does not directly correspond to the reason for refusal. It corresponds to the reason for refusal where the notice under Article 48septies was issued and these requirements have still not been satisfied based on the detailed description of the invention(Article 49(v)).

3.1 Notice under Article 48septies

3.1.1 Notice under Article 48septies

(1) The examiner may issue the notice under Article 48septies where it is recognized that the requirements for disclosure of information on prior art documents are not satisfied based on the detailed description of the invention.

However, the notice under Article 48septies is not issued uniformly; it shall be issued when the examiner recognizes it to be necessary in light of the purpose of these requirements provided for achieving the prompt examination.

The notice under Article 48septies is basically to be issued in order to obtain the information on prior art documents useful for the examination. Therefore, it is appropriate to issue this notice before the first notice of reason for refusal.

(2) Where the notice under Article 48septies is issued, and a part of the claims relates to the non-compliance with requirements for disclosure of information on prior art documents, the claim shall be identified and the reason shall be specifically described in determining that the requirements for disclosure of information on prior art documents are not satisfied.

3.1.2 Response of applicant against notice under Article 48septies

The applicant may add information on prior art documents by filing amendments or argue that the applicant does not know the relating invention known to the public through publication by filing a written opinion against the notice under Article 48septies. When an amendment is performed to add the information on prior art documents, it is desirable to file a written opinion that describes contents of the invention known to the public through publication, and identical features and differences of the claimed invention and the invention known to the public through

publication (see 2.3.1 in this Chapter).

3.1.3 Handling of examiner after response of applicant shown in 3.1.2

The examiner shall determine that the reason for refusal is overcome for non-compliance with the requirements for disclosure of information on prior art documents, and proceed with the examination where the examiner comes to be convinced that the description of the information on prior art documents in the detailed description of the invention complies with the requirements for disclosure of information on prior art documents by the filed written amendment or written argument.

Otherwise, where the previous conviction on the non-compliance with the requirements for disclosure of information on prior art documents is not changed even after considering the written amendment and the written opinion; for example, in the case (i) or (ii) below, the examiner may issue the notice of reason for refusal on non-compliance with the requirements for disclosure of information on prior art documents according to 3.2 below (Article 49(v)).

- (i) Where the information on prior art documents is still not disclosed, and the written opinion does not provide a rational explanation that there is no invention known to the public through publication
- (ii) Where the information on prior art documents is disclosed by the amendments, but appropriate information on prior art documents is not disclosed

3.2 Notice of reason for refusal

3.2.1 Notice of reason for refusal on non-compliance with requirements for disclosure of information on prior art documents

(1) The examiner may issue the notice of reason for refusal on non-compliance with requirements for disclosure of information on prior art documents where the examiner comes to be convinced that the requirements for disclosure of information on prior art documents are not satisfied after considering the written amendment and the written opinion where the notice under Article 48septies was issued (Article 49(v)).

Since Article 49(v) is a provision, which prescribes the case where the requirements for disclosure of information on prior art documents are not satisfied in spite of the notice under Article 48septies, the reason for refusal on non-compliance

with requirements for disclosure of information on prior art documents cannot be issued without the notice under Article 48septies.

(2) Where only a part of the claims relates to the non-compliance with these requirements, the claim shall be identified and the reason shall be specifically described in determining that the requirements for disclosure of information on prior art documents are not satisfied in the notice of reason for refusal.

Where the notice of reason for refusal is issued stating that the requirements for disclosure of information on prior art documents are not satisfied without assessing patentability such as novelty, inventive step and the like, the effect shall be specified.

3.2.2 Response of applicant against notice of reason for refusal

The applicant may add information on prior art documents by filing amendments or argue that the applicant does not know of the related inventions known to the public through publication by filing a written opinion against the notice of reason for refusal. When an amendment is performed to add the information on prior art documents, it is desirable to file a written opinion that describes contents of the invention known to the public through publication, and identical features and differences of the claimed invention and the invention known to the public through publication (see 2.3.1).

3.2.3 Handling by examiner after response of applicant shown in 3.2.2

The examiner shall determine that the reason for refusal is overcome for violation of the requirements for disclosure of information on prior art documents, and proceed with the examination where the examiner comes to be convinced that the description of the information on prior art documents in the detailed description of the invention complies with the requirements for disclosure of information on prior art documents by the filed written amendment or written argument.

Otherwise, where the examiner does not come to convince that the description of the information on prior art documents in the detailed description of invention complies with the requirements for disclosure of information on prior art documents even after considering the amendments and written opinion, for example, in the case (i) or (ii) below, the examiner shall determine that the reason for refusal is not overcome for non-compliance with the requirements for disclosure of information on prior art

documents and issue the decision of refusal.

- (i) Where the information on prior art documents has not been still disclosed, and the written opinion does not provide a rational explanation that there is no invention known to the public through publication
- (ii) Where the information on prior art documents is disclosed by the amendments, but appropriate information on prior art documents is not disclosed

4. Procedures for Describing Information on Prior Art Documents in Specifications

Procedures for describing information on prior art documents in specifications by applicant are as follows.

4.1 Method for describing information on prior art documents

4.1.1 Principle

The information on prior art documents shall be described changing a line for information on prior art documents. The column [Prior art documents] is set forth preferably in front of the information on prior art documents.

In that case, a column with a serial number is prepared in order to describe as [Patent document 1] and [Patent document 2] when names of gazettes on patents, utility models, or designs are described and as [Non-patent document 1] and [Non-patent document 2] when places of other information such as periodical publications or information on the Internet and the like are described and only the information on prior art documents is described one by one in each column. Matters other than information on prior art documents shall not be described in a column for describing information on prior art documents (see 4.2.2).

The columns [Patent documents] and [Non-patent documents] are preferably set forth in front of the columns [Patent document 1] and [Non-patent document 1], respectively.

Where a place for describing information on prior art documents in the publications can be specified, the place concerned shall be specified by describing page number, line, number, paragraph number, drawing number, and the like in the column, in which information on prior art documents is described.

4.1.2 Description of contents of prior art

Where contents of prior art relating to the information on prior art documents and comparison with the claimed invention and the like are described, they shall be described in the column [Background art] of the detailed description of the invention.

Where the information on prior art documents is mentioned in the description of contents and the like of the prior art relating to the information on prior art documents, it is desirable to use the name of the column in which the information on prior art documents is described ([Patent document 1] and the like) (see 4.2.1).

4.1.3 Description of prior application

Where the invention described in a prior application, which is not disclosed at the time of filing of patent application is described, the application number of the application concerned shall be described in the column [Background art] of the detailed description of the invention.

4.1.4 Where there is no information on prior art documents to be described

Where the effect that there is no information on prior art documents to be described and the reason are described, they shall be described in the column [Background art] of the detailed description of the invention.

4.2 Examples of description of information on prior art documents

4.2.1 Examples of appropriate description

[Technical field]

[0001]

.....

[Background art]

[0002]

The existing is doing (for example, see Patent document 1 (see Pages 5 to 7 and Figure 1)).

Also, some are doing (for example, see Non-patent document 1).

[Prior art documents]

[Patent document]

[0003]

[Patent document 1] Japanese Patent Application Laid-open No. 2001-XXXXXX

[Non-patent document]

[0004]

[Non-patent document 1] "ΔΔΔΔΔ" Written by OOOOO, XXPublication, January 1, 2001, pages 12 to 34

[Summary of the invention]

[Problem to be solved by the invention]

[0005]

....

4.2.2 Examples of inappropriate description

[Technical field]

[0001]

....

[Background art]

[0002]

The existing is doing.

[Prior art documents]

[Patent document]

[0003]

[Patent document 1]

Japanese Patent Application Laid-open No. H5-XXXXXX

The above document discloses

[Summary of the invention]

[Problem to be solved by the invention]

[0004]

....

(Explanation)

The explanation on contents of information on prior art documents is described in the

Part II Chapter 1 Section 3 Requirements for Disclosure of Information on Prior Art Documents

column (column in [Patent document 1] and the like) for describing information on prior art documents in the example. However, the matters other than information on prior art documents should not be described in the column for describing information on prior art documents. When explaining contents of information on prior art documents and the like, they shall be described in the column [Background art].

Chapter 2 Requirements for Claims

Section 1 Patent Act Article 36(5)

(1) In the first sentence of Article 36(5), it is provided that the claims shall state a claim or claims and state for each claim all matters necessary to specify the invention for which the applicant requests the grant of a patent. This sentence is provided that matters which the applicant deems necessary to define the invention for which a patent is sought should be stated in the claims without excess or shortage, so that he/she neither states unnecessary matters nor omits necessary matters.

Since it is the applicant who determines for what invention to seek a patent, the Article sets forth that the applicant shall state in the claim all matters the applicant himself/herself deems necessary to define the invention for which a patent is sought.

(2) In the second sentence of Article 36(5), it is provided that an invention specified by a statement in one claim may be the same invention specified by a statement in another claim. This sentence is provided to prevent the misunderstanding that a single invention shall not be defined in more than a single claim.

(3) Article 36(5) also makes clear the nature of the claims. By clearly providing that it is in a claim that the applicant states matters specifying the invention, this Article makes it clear that the technical scope of the patented invention is determined based on the statement of the claim (Article 70(1)), and that the subject of the examination is the invention identified based on the statement of the claim.

(4) The claims must be divided into one or more claims, and each of which sets forth matters specifying the invention. A claim constitutes a basic unit for a determination of patentability (Articles 29, 29bis, 32 and 39), effects of a patent right (Article 68), abandonment of a patent right (Articles 97(1) and 185), a request for a trial for patent invalidation (Article 123), fees (Articles 107 and 195), etc.

(5) It is neither a reason for refusal nor a ground for invalidation whether all matters necessary to specify the invention are stated in a claim.

Section 2 Support Requirement (Patent Act Article 36(6)(i))

1. Overview

Patent Act Article 36(6)(i) provides that a claimed invention shall be disclosed in the description. The purpose of this requirement (support requirement) is to prevent a patent from being granted for an invention which is not disclosed to the public.

2. Determination of Support Requirement

2.1 Basic ideas of determination of support requirement

(1) **It is determined whether the statement in the claims satisfies the support requirement by comparing the claimed invention and the invention stated in the description.**

This comparison is made by considering what is stated in the description on the basis of the claimed invention. The examiner should not apply the support requirement so strictly as to oblige the applicant to limit the scope of the claimed invention to its specific mode disclosed in the description.

(2) **In performing this comparison, the examiner examines a substantial correspondence between the claimed invention and the invention stated in the description regardless of the consistency of expression.** Given that the support requirement is satisfied only by the consistency of expression, a patent right for the invention which has not substantially been disclosed to the public would be granted, thus it is against the purpose of the provision of Article 36(6)(i).

(3) **The consideration of the substantial correspondence done by the examiner is to examine whether or not the claimed invention exceeds “the extent of disclosure in the description to which a person skilled in the art would recognize that a problem to be solved by the invention would be actually solved” (hereinafter, referred to as “the extent of disclosure in the description”).** When it is determined that the claimed invention exceeds “the extent of disclosure in the description,” the claimed invention and the invention disclosed in the description do not substantially correspond with each other, and thus, the statement in the claims does not satisfy

the support requirement.

In principle, the examiner identifies a problem to be solved by the invention from the statement in the description. The examiner, however, identifies the problem while taking into account the common general knowledge at the time of filing in addition to all of the statements in the description and drawings in either (i) or (ii) of the following cases:

- (i) when any problem is not clearly indicated in the description; or
- (ii) when, although a problem is clearly indicated, it is unreasonable as a problem to be solved by the claimed invention in light of the other parts of the statement in the description and/or the common general knowledge at the time of filing, e.g. a case when a problem clearly indicated in the description attached to a divisional application is the same as that indicated in the description attached to the original application (see “Part VI Chapter 1 Section 1 Requirements for Division of Patent Application” 1.), but the problem is found to be unreasonable as a problem to be solved by the invention claimed in the divisional application when taking into account other parts of the statements in the description and/or the common general knowledge at the time of filing.

When identifying “the extent of disclosure in the description,” the examiner takes into account the common general knowledge at the time of filing in addition to all of the statements in the description and drawings.

2.2 Types of violations of support requirement

The following (1) to (4) are types of cases in which the statements in the claims do not satisfy the support requirement.

- (1) No statement or implication of claimed elements in the description

Example 1

The claim has a numerical limitation, while any specific numerical value is neither stated nor implied in the description.

Example 2

The claim solely recites an invention using an ultrasonic motor, while the

description states only an invention using a DC motor and it neither states nor implies anything about using an ultrasonic motor.

- (2) Unclear correspondence between the claimed invention and the statement in the description due to inconsistent use of terms therein

Example 3

A “data processing means” of a word processor is recited in the claim, while a “means for changing the size of characters” and a “means for changing line spacing” are stated in the description. It is unclear whether the “data processing means” in the claim corresponds to the former or the latter means in the description, or both of them, thus the claim does not substantially correspond to the statement in the description.

- (3) Over-expanded or over-generalized invention claimed

The examiner should note the following points when applying this type.

- a A claim may be recited with expansion or generalization based on one or more specific examples in the description. The maximum extent to which the claimed invention may be expanded or generalized without going beyond the extent of disclosure in the description depends on technical fields to which the invention pertains. For example, compared with in the technical field where it is difficult to understand the correspondence between function, characteristics, etc. of a product (see 4.1 in “Section 3 Clarity Requirement”) and structure of the product, in the technical field where it is relatively easy to understand such correspondence, the maximum extent to which the invention may be expand or generalized based on the specific examples tends to be wider. The examiner firstly determines to which technical field the invention concerned pertains and what kind of common general knowledge at the time of filing exists in the relevant technical field. And then, he/she makes a determination, on an invention-by-invention basis, as to whether the details provided in the description can be expanded or generalized to the scope of the claimed invention.
- b Type (3) may be applied only when, in accordance with the basic ideas of the determination of the substantial correspondence (see 2.1(3)), a claimed invention is found to exceed the extent of disclosure in the description. The examiner does

not apply Type (3) independently of the problem to be solved by the claimed invention.

Example 4

A claim comprehensively recites R receptor activating compounds. However, the description discloses no specific example other than the chemical structures and a manufacturing method of novel R receptor activating compounds, X, Y, and Z. The details provided in the description can be neither expanded nor generalized to the scope of the claimed invention even in light of the common general knowledge at the time of filing.

Example 5

A claim is defined by a result to be achieved, e.g. a claim relates to a hybrid car defined by the desired level of energy efficiency. However, the description discloses only an invention with a specified means to achieve the result. The details provided in the description can neither be expanded nor generalized to the scope of the claimed invention even in light of the common general knowledge at the time of filing.

Example 6

A claim relates to a product defined by a mathematical formula or a numerical range of values, e.g. a polymer composition, a plastic film, a synthetic fiber, or a tire. The description states that the mathematical formula or the numerical range of values is specified for the purpose of solving a problem. However, the description does not contain such a sufficient example or explanation that a person skilled in the art would recognize that the problem would be solved by such a formula or a range of numerical values even in light of the common general knowledge at the time of filing. Therefore, the details provided in the description can neither be expanded nor generalized to the scope of the claimed invention.

In a case when a numerical range of values is not the technical characteristics of the claimed invention and the numerical range recited in the claim is merely desirable one, such a claim does not fall under Type (3) even if any specific values within such a numerical range are not stated in the description.

- (4) No recitation of elements necessary for the solution of the problem to be solved specified in the description

The examiner should note the following points when applying Type (4).

- a Type (4) may be applied only when, in accordance with the basic ideas of the determination of the substantial correspondence (see 2.1(3)), a claimed invention is found to exceed “the extent of disclosure in the description.”
- b When two or more problems are identified from the statements in the description, it is required that at least one solution for one of the problems to be recited in the claim.

Example 7

According to the description, the problem to be solved is only to provide a system wherein a server can send information to any terminals that use different data formats each other. The description only discloses, as a solution for the problem, a system comprising a server and terminals for providing the terminals with information by the server, wherein the server retrieves from the storage means the data format conversion parameter corresponding to a destination terminal, converts the data format of the information based on the retrieved data format conversion parameter, and transmits the information in the converted format to the terminal. On the other hand, the claim does not recite the conversion of data format. Therefore, the scope of the claimed invention goes beyond the extent of disclosure in the description due to lack of recitation of the element necessary for solving the problem.

Example 8

The problem to be solved by the invention identified from the description is only to prevent an automobile from exceeding the speed limit, and only a solution of the problem provided in the description is a mechanism which increases force needed to push the accelerator pedal further as speed increases. On the other hand, the claim only recites a force adjusting means that adjusts the force required to operate a means of acceleration along with increase in speed, and, even in light of the common general knowledge at the time of filing, it is evident that the problem cannot be solved when the force needed for the operation decreases along with increase in speed. Therefore, the scope of the claimed invention goes beyond the extent of disclosure in the description due to lack of recitation of the element

necessary for the solution of the problem.

3. Examination Procedure for Determination of Support Requirement

3.1 Notice of reasons for refusal

When the examiner determines that the statement in the claims does not satisfy the support requirement, the examiner notifies the reason for refusal.

The following explanation is related to a notice of reasons for refusal coming under Types (3) and (4) in 2.2.

3.1.1 Type (3) (see 2.2(3))

When the examiner determines that the details provided in the description can neither be expanded nor generalized to the scope of the claimed invention in light of the common general knowledge at the time of filing, the examiner notifies the reason for refusal. In the notification of reasons for refusal, the examiner specifically explains the reason why he/she determines so, while showing the grounds for such determination, e.g. a part of the statement in the description and details of the common general knowledge at the time of filing that he/she has taken into account when making the determination. The examiner is also required to set forth in the notification, to the extent possible, such a clue, e.g. the extent to which the invention can be expanded or generalized, that the applicant understands how the claim should be amended in order to overcome the reason for refusal.

The examiner should not state the reason for refusal as stated in the following items (i) or (ii) without specific explanation of the reason, because this would make it difficult for the applicant to make an effective argument or understand the direction of an amendment that should be made in order to overcome the reason for refusal.

- (i) The statement only reads as follows: "The details provided in the description can neither be expanded nor generalized to the scope of the claimed invention even in light of the common general knowledge at the time of filing."
- (ii) The statement of the reason reads that the details provided in the description can neither be expanded nor generalized to the scope of the claimed invention solely relying upon the common belief that "it is difficult to predict in the technical field concerned".

In addition, the examiner should take care not to determine so strictly as to oblige the applicant to limit the scope of the claimed invention to its specific mode disclosed in the description (see 2.1(1)).

3.1.2 Type (4) (see 2.2(4))

When the examiner determines that a claimed invention goes beyond the extent of disclosure in the description due to lack of recitation of a solution for the problem to be solved, which is stated in the description, the examiner notifies a reason for refusal. In the notification of reasons for refusal, the examiner specifically explains the reason why he/she determines so, while showing the problem to be solved by the invention and the solution therefor as identified by him/her. When the examiner determines that the problem clearly indicated in the description is unreasonable as a problem to be solved by the claimed invention, he/she should also specify a reason for such determination.

When showing the solution for the problem, the examiner should, while being careful not to be prejudiced by specific examples (see 2.1(1)), make efforts to ensure that the applicant understands how the claim should be amended in order to overcome the reason for refusal.

It is not appropriate for the examiner to merely state that “an element necessary for solving the problem, which is stated in the description, is not recited in the claim”, because this would make it difficult for the applicant to make an effective argument or understand the direction of an amendment that should be made in order to overcome the reason for refusal.

3.2 Argument and/or explanation by applicant

In response to a notice of reasons for refusal involving a violation of the support requirement, the applicant may make an argument, explanation, etc. by submitting a written opinion, certificate of experimental results, and the like.

The following explanation is related to Types (3) and (4) in 2.2.

3.2.1 Type (3) (see 2.2(3))

Upon receiving a notice of reasons for refusal coming under Type (3), the applicant may make an argument in a written opinion, for example, pointing out the common general knowledge at the time of filing other than one taken into account by the examiner when making the determination, and arguing that, in light of such common general knowledge, the details provided in the description can be expanded or

generalized to the scope of the claimed invention. The applicant may also submit a certificate of experimental results to support such an argument.

However, when, due to an insufficient statement in the description, the details provided in the description can neither be expanded nor generalized to the scope of the claimed invention even in light of the common general knowledge at the time of filing, the reasons for refusal cannot be overcome even by submitting a certificate of experimental results after filing of the application in order to make up for such deficiency, and thereby arguing that the provided details can be expanded or generalized to the scope of the claimed invention.

(see: case on the action to seek rescission of the JPO decision to revoke the patent, Decision by the Intellectual Property High Court, Grand Panel, November 11, 2005 [Heisei 17 (Gyo KE) No. 10042], “Manufacturing Method of Polarizing Film”)

3.2.2 Type (4) (see 2.2(4))

In response to a notice of reasons for refusal coming under Type (4), the applicant may make an argument, while taking into account the statements of the description and drawings as well as the common general knowledge at the time of filing, that it is possible to identify a problem and/or a solution therefor other than those identified by the examiner, and that such a solution is recited in the claim.

3.3 Response by examiner to argument and/or explanation by applicant

In cases when an argument, explanation, etc. (see 3.2) convinces the examiner that the statement in the claims satisfies the support requirement, the reason for refusal is resolved. Otherwise, the examiner issues a decision of refusal based on the same reason as notified before that the statement in the claims does not satisfy support requirement.

Section 3 Clarity Requirement (Patent Act Article 36(6)(ii))

1. Overview

Article 36(6)(ii) is a provision on Clarity Requirement for Claims, which prescribes that an invention for which a patent is sought shall be clear .

The statement in the claims has great significance, since the claims are used for the basis of determination on novelty and inventive step, etc., and also used for the basis of determination of the technical scope of a patented invention. Thus, it is necessary that an invention can be clearly identified from one claim.

Article 36(6)(ii) is a significant provision for securing these functions of the claims.

2. Determination of Clarity Requirement

2.1 Basic ideas of determination of clarity requirement

(1) For a claimed invention to be clearly understood, it is necessary that the scope of the claimed invention shall be clear, that is to say, that the claims shall be stated such that a person skilled in the art can understand whether a specific product or process falls within the scope of the claimed invention, and to that end, the matter specifying the invention shall be clear.

Also, since an invention for which a patent is sought is described on a claim-by-claim basis, one invention should be identified based on matters stated in one claim (see 2.2(4)).

(2) Examination of the clarity requirement shall be made for each claim based on matters specifying the invention stated in the claim.

However, when interpreting the meanings or technical meanings (see 2.2(2)b) of the matters specifying the invention, the examiner shall consider not only the statement of the claim but also the statements of the description and drawings as well as the common general knowledge as of the filing.

In identifying an invention, a matter not stated in a claim shall not be considered by the examiner. On the contrary, a matter stated in a claim shall be necessarily taken into consideration by the examiner.

(3) Where the statement of a claim is clear by itself, an examiner shall examine whether a term in the claim is defined or explained in the description or drawings, and determine whether such definition or explanation, if any, makes (the statement of)the claim unclear instead. For example, if clear definition of a term in a claim, which is either completely inconsistent with or different from what it normally means, is mentioned in the description, such definition could make the claimed invention unclear. This is because such definition could raise confusion in interpretation of the term, under the practice that identification of the claimed invention should be done primarily based on the statement of the claim and also be done by considering the statements of the description .

Where the statement of a claim is unclear by itself, an examiner shall examine whether a term in the claim is defined or explained in the description or drawings, and determine whether such definition or explanation, if any, makes (the statement of)the claim clear by interpreting the term in the claim considering the common general knowledge as of the filing. If the examiner determines that the invention for which a patent is sought can be clearly identified as a result of this determination, the clarity requirement is satisfied.

2.2 Types of violation of clarity requirement

Types (1) to (5) as the examples of statements in the claims violating the clarity requirement are shown below.

(1) The case where the statement of a claim itself is unclear, and as a result, a claimed invention is unclear.

a The case where an expression in a claim is inadequate as a Japanese language expression, and as a result, a claimed invention is unclear.

For example, it corresponds to a case where a claim includes statements inadequate as Japanese language expressions such as clerical errors or ambiguous statements, thereby a claimed invention is made unclear. It is not a violation of the clarity requirement, however, if defects in a claim are minor and do not render the claimed invention unclear to a person skilled in the art.

- b The case where the meaning of a term in a claim is incomprehensible to a person skilled in the art even by considering the statements of the description and drawings as well as the common general knowledge as of the filing, and as a result, a claimed invention is unclear.

Example1:

[claim]

A process for manufacturing compound D, consisting of the steps of:
synthesizing compound C by reacting compound A and compound B in ethanol at a normal temperature, and
synthesizing compound D by heating compound C at a temperature between 80 and 100°C in the presence of KM-II catalyst.

(Explanation)

The meaning of the term "KM-II catalyst" is incomprehensible because this term is neither defined in the description nor included in the scope of the common general knowledge as of the filing.

- (2) The case where a technical defect is included in matters specifying the invention, and as a result, a claimed invention is unclear.

- a The case where a technically incorrect matter is included in matters specifying the invention, and as a result, a claimed invention is unclear.

Example2:

[claim]

An alloy composed of 40 to 60 wt% of component A, 30 to 50 wt% of component B, and 20 to 30 wt% of component C

(Explanation)

This claim includes a technically incorrect statement because the total sum of the maximum amount of component A and the minimum amounts of components B and C exceeds 100 wt%.

- b The case where the technical meaning of a matter specifying the invention is incomprehensible to a person skilled in the art, and further, it is evident that the matter specifying the invention is deficient in light of the common general knowledge as of the filing, and as a result, the invention is unclear.

When the scope of a claimed invention is clear, normally, the invention can be clearly identified from the statement in the claim.

However, even when the scope of an invention is clear, if the “technical significance” of a matter specifying the invention is incomprehensible and it is evident that a matter specifying the invention is deficient in light of the common general knowledge as of the filing, the claimed invention cannot be examined precisely on the patentability requirements, such as novelty or inventive step, etc. In such a case, the function of the claims, which requires that an invention can be clearly identified from one claim, is not secured, and therefore, the claim violates the clarity requirement.

The technical meaning of a matter specifying an invention refers to the function or role that these elements play in the claimed invention. In understanding the function or role, an examiner shall consider the statements of the description and drawings as well as the common general knowledge as of the filing.

The function or role that the claimed elements play in the claimed invention can be usually understood by considering the statement of the description (see 3.1.1(2) and (3) in “Chapter 1 Section 1 Enablement Requirement”) or the common general knowledge as of the filing. Such a case does not constitute this type of violation.

A case where the technical meaning of a matter specifying an invention is just incomprehensible does not constitute this type of violation. A case where a matter specifying the invention is deficient in light of the common general knowledge as of the filing, in addition to the incomprehensibility of the technical meaning of the matter specifying the invention, constitutes this type of violation.

An examiner shall determine whether deficiency in matters specifying the invention is evident, based on the common general knowledge as of the filing in the technical field to which the invention pertains. Therefore, this type of violation shall not apply when the content of the common general knowledge as the ground for such determination cannot be specified.

Example 3:

[claim]

A machining center comprising a bed made of metal, an elastic body, a metal plate, an automatic tool change arm, and a tool magazine

(Explanation)

The claim fails to define the structural relationship of the elastic body and metal plate with other components, and the technical meanings of the elastic body and the metal plate cannot be understood even by considering the statements of the description and drawings as well as the common general knowledge as of the filing. With regard to an invention relating to a machining center, it is the common general knowledge as of the filing that the structural relationship of a particular component with other components greatly differs depending on the technical meaning of the relevant component. In light of this common general knowledge, it is evident that the matters specifying the invention in this claim are deficient for understanding the structural relationship of the elastic body and metal plate with other components. Therefore, the invention cannot be clearly identified from the statement of the claim.

(Supplementary explanation)

In light of the common general knowledge as of the filing, the technical meanings of the "bed made of metal", the "automatic tool change arm", and the "tool magazine" are obvious. However, in order to understand the technical meanings of the "elastic body" and the "metal plate", it is insufficient that the claim only states that the invention is equipped with these components. Suppose the description indicates a specific example in which the elastic body is mounted on the lower part of the bed made of metal and the metal plate is mounted on the lower part of the elastic body, both serving as damping members. While it is possible to understand the roles that the elastic body and the metal plate play in this specific example, the claim does not state such structural relationships, and therefore, this limitative interpretation cannot be applied to the roles to be played by the elastic body and the metal plate in the claimed invention. Therefore, even by considering the statements of the description and drawings, the technical meanings of the elastic body and metal plate cannot be understood.

Example 4:

[claim]

An image encoding chip which compresses input image data and outputs X-encoded image data, comprising: an A-encoding circuit which encodes externally input image data by an A-encoding system that is reversible, thereby producing A-encoded data; an A-decoding circuit decoding the produced A-encoded data into the

original image data by an A-decoding system; and an X-encoding circuit which encodes the decoded image data by an X-encoding system that is irreversible, thereby producing X-encoded image data, and externally outputs the produced X-encoded image data.

(Explanation)

It is the common general knowledge as of the filing that speeding up, downsizing, electric power saving, and cost reduction are of importance for an invention of an image encoding chip. Thus, providing a circuit which only decodes the encoded data into the original data, as stated in the claim, is against the common general knowledge. Therefore, even in light of the statements of the description and drawings, the technical meanings of the A-encoding circuit and the A-decoding circuit cannot be understood. With regard to an invention relating to an image encoding chip, it is also the common general knowledge as of the filing that what to be processed by the image encoding chip greatly differ depending on the technical meanings of the circuits mounted on the chip. In light of the common general knowledge as of the filing, it is evident that the matters specifying the technical functions of the A-encoding circuit and the A-decoding circuit in the image encoding chip are not sufficiently described in the claims. Therefore, the invention cannot be clearly identified from the statement of the claim.

(Supplementary explanation)

If the description describes a specific example in which the A-encoding circuit measures an encoding time, and the parameter to be used for X-encoding is determined based on the encoding time it is possible to understand the technical function that the A-encoding circuit and the A-decoding circuit performs in this specific example, however, the claim fails to specify a feature of using the information obtained by the A-encoding circuit for X-encoding, and therefore, it cannot interpret the technical function of the A-encoding circuit and the A-decoding circuit performed in the claimed invention as such limitative way as specified in the example in the description. Therefore, even by considering the statements of the description and drawings, the technical significance of the A-encoding circuit and A-decoding circuit cannot be understood.

- c The case where matters specifying the invention are inconsistent with each other, and as a result, the invention is unclear.

Example 5:

A claim states "a method for producing a final product D comprising a first step of producing an intermediate product B from a starting material A, and a second step of producing the final product D from a starting material C" in which the product produced by the first step is different from the starting material in the second step, and thus, the relation between the first step and the second step is not clear even if interpreting the meaning of the terms "the first step" and "the second step" by considering the statements of the description and drawings as well as the common general knowledge as of the filing

- d The case where matters specifying the invention are not technically related to each other, and as a result, the invention is unclear.

Example 6: A road on which an automobile equipped with a specific engine is traveling

Example 7: Information transmission media transmitting a specific computer program
(Explanation)

The transmission of information is a function inherent to the transmission media. To define the matter specifying the invention to be "information transmission media transmitting a specific computer program" only means that a specific computer program is being transmitted at any time and to any place on the information transmission media. It only defines the inherent function of the transmission media, and does not specify any relation between the information transmission media and the computer program.

- e The case where a claim states a non-technical matter, as a whole, since the claim includes such statements as sales area or distributors, etc., and as a result, the invention is unclear.

(Points to note)

Where a claim includes a statement to specify a product by means of a brand name, for example, it is noted such a statement makes the claimed invention unclear unless it is clear to a person skilled in the art that the product specified by such brand name have had the specific quality, composition and structure, etc., at least from prior to the filing date to the filing date.

- (3) The case where the category of a claimed invention is unclear, or cannot be identified as any category, and as a result, the invention is unclear.

The Patent Act prescribes that "a patentee shall have the exclusive right to work the patented invention" (Article 68), and defines the term "working" by categorizing inventions into an invention of a product, an invention of a process, and an invention of a process for producing a product (Article 2(3)). In considering them, in a case where the category of the claimed invention is unclear or cannot be identified as any category, it is inadequate to grant a patent to such invention since it makes the extent of the patent right unclear.

(Examples of the case where an invention is unclear)

Example 8: A method or apparatus comprising ...

Example 9: A method and apparatus comprising ...

Example 10:

A claimed invention which cannot be determined whether it is directed to a "product" or a "process" as a result that the claim states only an operation, a function, a property, an objective or an effect (e.g., "an anti-cancer effect of a chemical compound A").

In determination of the category, an examiner shall consider the following points.

- a The term "system" (e.g., "telephone system") is treated as a term meaning the category of a "product".
- b The terms "use" and "utilize" are treated as terms meaning a method for using something which is categorized into a "process".

Example 11:

The expression "use (utilize) substance X as an insecticide" is treated as that meaning a "method for using substance X as an insecticide".

Example 12:

The expression "use (utilize) substance X of manufacturing a medicament for therapy of ..." is treated as that meaning a "method for using substance X of manufacturing a medicament for therapy of ...".

- (4) The case where the matters specifying the invention are expressed in alternatives

and the alternatives have no similar characteristics or functions to each other, and as a result, the invention is unclear.

Considering the purpose of the provision of Clarity Requirement an invention should be clearly identified from one claim. Also, considering the purpose of the system of claims, one invention should be identified based on matters stated in one claim.

Consequently, when there exist two or more alternatives related to a matter specifying the claimed invention and these alternatives do not have similar characteristics or functions, it falls under a violation of Clarity Requirement.

(Examples of the case where an invention is unclear)

Example 13: A specific component or an apparatus incorporated said component

Example 14: A transmitter or a receiver which has a specific power supply

Example 15: In a case where an intermediate and a final products of a chemical compound are stated in an alternative form in one claim.

It is not a violation of the requirements, however, as long as the intermediate per se is also regarded as a final product in one sense and meets Description Requirements of a Markush-type claim along with other final products, even though the product is the intermediate product of the certain final product.

(5) The case where a claim includes an expression which may make the scope of an invention ambiguous, and as a result, the scope of the invention is unclear.

The examiner shall not immediately determine that the scope of an invention is unclear, even when a certain expression may make the scope ambiguous. The examiner shall evaluate whether a person skilled in the art can understand the scope of a matter specifying the invention including the relevant expression by considering the description and drawings as well as the common general knowledge as of the filing.

a Negative expressions (e.g., "except ..." or "not ..."), resulting in making the scope of the invention unclear.

When what is excluded by a negative expression is unclear (e.g., "except for the invention stated in Cited Document 1"), the scope of the claimed invention including the relevant expression is unclear.

However, even if a claim includes a negative expression, the scope of an

invention nothing of which has been excluded by the negative expression is clear and at the same time the scope of part to be excluded by the negative expression is also clear, usually, the scope of the claimed invention shall be clear.

b Expressions using a numerical limitation which only indicates either an upper limit or a lower limit such as "not less than..." or "not greater than...", and as a result, the scope of the invention is unclear.

c Expressions where a basis or a degree of comparison criterion is unclear (e.g., "with slightly greater specific gravity", "much bigger", "high temperature", "low temperature", "hard to slip", "easy to slip") or terms having ambiguous meanings, resulting in making the scope of the invention unclear.

However, when an expression in a claim is widely used in a particular technical field and its meaning is clear (e.g., the term "high frequency" relating to amplifiers), the scope of the invention shall not be unclear, usually.

d Expressions where the scope cannot be identified (e.g., "about", "approximately", "substantially", "essentially"), resulting in making the scope of the invention unclear.

However, even if a claim includes an expression where the scope cannot be identified, an examiner shall not immediately determine that the scope of the invention is unclear, but consider whether the scope of the invention can be understood by considering the statements of the description and drawings as well as the common general knowledge as of the filing.

Example:16

[claim]

A coating method comprising depositing a raw material for coating on a surface of a semiconductor substrate wherein in the deposition of the raw material for coating, the semiconductor substrate is rotated so that the raw material for coating can be supplied on the substrate in a substantially uniform way.

(Explanation)

Although it is the common general knowledge as of the filing that a raw material for coating cannot be supplied in a completely uniform way,, it can be understood from the statements of the description and drawings as well as the common general knowledge as of filing that the claimed invention provides a

substantially uniform supply of the raw material for coating on the surface of the semiconductor substrate by rotating the semiconductor substrate. It can be clearly understood that the expression "be supplied ... in a substantially uniform way" means such a degree of uniformity that can be obtained by the rotation of the semiconductor substrate. Therefore, the scope of the invention is clear. It is determined equally even if "substantially" is replaced by "approximately" in this example.

Example:17

[claim]

A folding-type mobile phone comprising a first housing having keypads, a second housing having a display, and a hinge connecting the first housing and the second housing so as to rotate the first housing approximately 360 degrees in relation to the second housing, wherein an electric circuit in the first housing and an electric circuit in the second housing are connected each other with a flexible substrate.

(Explanation)

It can be understood that the claimed invention is an improvement invention of the known art in which one housing rotates approximately 360 degrees in relation to the other housing around the connecting part on the basis of the statements of the description and drawings. It is obvious that the fact that one housing rotates approximately 360 degrees in relation to the other indicates an arrangement where the back side of the first housing is opposed to the back side of the second housing (i.e. the keypads and the display facing outside) on the basis of the statements of the description and drawings as well as the common general knowledge as of the filing. Accordingly the scope of the invention is clear. Note that, it is determined equally even if "approximately" is replaced by "about" or "substantially" in this example.

e Expressions where optionally additional matters or selective matters are stated along with such words as "when desired", "if necessary", etc., resulting in making the scope of the invention unclear (the same is applied to statements including such words as "especially", "for example", "etc.", "preferably", and "suitably").

Such expressions make it unclear in what condition on which the optionally added or selective matters are chosen unclear, and thus, the matters stated in the claim would be interpreted in many ways.

On the other hand, when selective matters, for example, can be understood as

just an example of a generic concept for the matters specifying the invention (e.g., "Alkali metal (e.g., lithium))", the scope of the invention shall be clear.

Further, also when optionally additional matters in a claim are stated in the description such that it can be understood that the additional matter is optional, the scope of the invention shall be clear.

f A numerical limitation in a claim which includes zero (0) (e.g., "from 0 to 10%"), resulting in making the scope of an invention unclear.

When it is clearly stated in the description that a component defined by the numerical limitation is an essential component, such statement in the description is inconsistent with the expression "from 0 to 10%" in the claim which is interpreted as the component being an optional component, thereby such expression of the numerical limitation would have various meanings, and as a result, the scope of the invention is unclear. On the other hand, when the description describes in an understandable way that the component defined by the numerical limitation is an optional component, the numerical limitation including zero (0) is permissible.

g A claim is made by a reference to the description or drawings, as a result, the scope of the invention is unclear.

Example 18: A claim which includes such statement made by a reference as "an automatic drilling mechanism as shown in Figure 1"

(Explanation)

Drawings generally have ambiguous meanings and could be interpreted in many ways. Thus, when a claim is made by a reference to a drawing, the scope of the invention is usually unclear,

Example 19: A claim in which a statement is made by a reference but the portion to be referred to is unclear (e.g. "cup described in the description")

An examiner shall note that the invention may be clear even when the claim is made by a reference to the description or drawings, as in the following example.

Example 20: In an invention related to an alloy, components of the alloy have a specific relation among them and the relation can be defined by reference to the drawings as clearly as by a numerical or other literal expression.

"Heat-resisting Fe·Cr·Al alloy for electric-heating composed of Fe, Cr, Al and impurities equal to or less than x% within the area circumscribed by points A(), B(), C() and D() shown in Figure 1. ".

2.3 Points to note

(1) Article 36(5) prescribes that "all matters necessary to specify the invention for which a patent is sought shall be stated" (see "Section 1 Patent Act Article 36(5)"). Considering the purpose of this Article, various forms of expression can be used in a claim by the applicant to specify an invention for which a patent is sought.

For example, in a case of "an invention of a product", various forms of expression such as operation, function, property, characteristics, method, use and others can be used to describe matters specifying the invention, in addition to the forms of expression such as a combination of products or a structure of products. Similarly, in a case of "an invention of a process (a sequence of acts or operations connected in time series)", a form of expression of objects used for these acts or operations or others can be used as matters specifying the invention, in addition to the forms of expression such as a combination of processes (acts or operations).

On the other hand, Article 36(6)(ii) prescribes that a claim should be stated in such a manner that an invention can be clearly identified from one claim. Hence, it should be noted that it is allowed as far as the claimed invention can be clearly identified to specify the invention by the various forms of expression.

(2) In a case where the statement of a claim which is directed to an invention of use does not express a specific use but a general use, it is not appropriate the examiner shall determine a violation of the clarity requirement merely on the ground that the statement is a general expression, i.e., the concept of the claim is broad, unless the expression of the general use makes unclear the claimed invention.

For example, when a claim expresses "a pharmaceutical (or agrochemical) agent comprising ..." instead of "a pharmaceutical (or agrochemical) agent for disease X comprising ...", , it is not appropriate the examiner shall determine a violation of the clarity requirement merely based on the expression is a general expression.

In a case where a claim is directed to a composition and does not include any statement to specify the use or property of the composition, it is not appropriate the examiner shall determine a violation of the clarity requirement merely based on the

claim does not include any statement to specify the use or property of the composition.

(3) An examiner shall consider that a multiple dependent form claim (Note) makes an invention unclear, in some cases, depending on its dependent form.

(Note) A multiple dependent form claim is a claim defined by making reference to statements of two or more claims (regardless of independent or dependent).

(4) The requirement for clarity is not satisfied in the cases of (i) to (vi) in “Chapter 1 Section 1 Enablement Requirement” 6. (however "the description " should be read as "claims.") where the claimed inventions are unclear since a person skilled in the art cannot understand accurately the mattes recited in the claims.

3. Examination Procedure for Determination of Clarity Requirement

3.1 Notice of reasons for refusal

When an examiner determines that a claimed invention is unclear, the examiner may notify the notice of reasons for refusal to the effect that the claimed invention does not comply with the clarity requirement. In such notice of reasons for refusal, the examiner specifically explains the reason why the claimed invention is not clear, in a manner that he/she indicates the grounds for the determination (e.g., the part of the statements of the description which has been considered in the determination and the content of the common general knowledge as of the filing),as well as pointing out the term(s) used in the claim that has been found to be incomprehensible.

It is not appropriate that the examiner merely states "the claimed invention is unclear" without explaining a specific reason for such determination, because this would make it difficult for the applicant to make an effective argument or understand the direction of an amendment to resolve the reasons for refusal the applicant has received.

3.2 Applicant's argument or explanation etc.

In response to a notice of reasons for refusal due to violation of the clarity requirement, the applicant can make an argument or explanation by submitting a written opinion, etc.

The applicant has opportunities to argue, in a written opinion, for example, (i) that the meaning of the term(s) used in the claim that the examiner has found to be incomprehensible can be understood from the common general knowledge as of the filing, or (ii) that the claimed invention is clear, by pointing out the part of the statement of the description or the common general knowledge as of the filing other than that considered by the examiner when making the determination.

3.3 Examiner's response to applicant's argument or explanation etc.

In the case where the examiner has been convinced that the claims comply with the clarity requirement by the argument and explanation (see 3.2) made by the applicant, the reasons for refusal is resolved. If this is not the case, the examiner shall issue a decision of refusal based on the reason for refusal notified that the claims does not comply with the clarity requirement.

4. Claims including Specific Expression

4.1 Expression specifying the product by function or characteristics, etc.

4.1.1 Types of unclear inventions

(1) The case where a person skilled in the art cannot understand the meaning of a function or characteristics, etc. (Note) (definition, a method for testing or a method for measuring etc.) stated in a claim even by considering the statements of the description and drawings as well as the common general knowledge as of the filing, and as a result, the invention is unclear (see 2.2(1)b).

Example 1:

[claim]

A composition for adhesion including a component Y, viscosity of which measured in accordance with the test method of X laboratory is a to b pascal seconds
(Explanation)

The definition of "the test method of X laboratory" and its concrete method are not stated in the description , nor is it included in the common general knowledge as of the filing. Thus, a person skilled in the art cannot understand the function or

characteristics, etc of "the viscosity measured in accordance with the test method of X laboratory is a to b pascal seconds"

(Note) In principle, a function or a characteristic, etc. to be stated as a matter specifying the invention shall be a standard one, namely, either one which is defined by the JIS (Japanese Industrial Standards), ISO (International Organization for Standardization)-Standards or IEC (International Electrotechnical Commission)-Standards, or one which can be quantitatively determined (e.g., "specific gravity" or "boiling point") by the method for testing or measuring provided in these Standards.

When a function or characteristics, etc. is not expressed by using the above Standards, except the following case (i) or (ii), the definition or method for testing or measuring thereof should be explicitly stated in the description and it should be made clear such function or characteristics stated in a claim is according to the definition and the testing and measuring methods described in the description.

- (i) It is commonly used by a person skilled in the art in the field that claimed invention pertains.
- (ii) A person skilled in the art can understand the definition or method for testing or measuring thereof although it is not commonly used.

(2) The case where it is evident, , that a matter specifying the invention stated by a function or a characteristic, etc. is not sufficiently specified from a technical perspective even in light of the common general knowledge as of the filing, and a person skilled in the art cannot clearly identify the invention from the statement of the claim even by considering the statement of the description and drawings.

When the scope of a claimed invention is clear, normally, a person skilled in the art can clearly identify the invention from the statement of the claim.

However, if a claim includes the expression of a function or characteristics, etc., there may be cases where, although the scope of the invention is clear, it is evident, even in light of the common general knowledge as of the filing, that a matter specified by the function or characteristics, etc. is not sufficiently specified from a technical perspective, and the claimed invention cannot be examined precisely on the patentability , such as novelty or inventive step, etc. based on the statement of the claim,

even by considering the statements of the description and drawings. In such case, the function of the claims, which requires that an invention shall be clearly identified from one claim (see 1.), is not secured, and therefore, the claim violates the clarity requirement.

(Points to note)

Determination as to whether it is evident that a matter specified by a function or characteristics, etc. is not sufficiently specified from a technical perspective shall be made based on the common general knowledge as of the filing in the technical field to which the invention pertains. Thus, an examiner shall not apply this type to an invention when the content of common general knowledge as a ground for such determination cannot be specified.

Further, an invention does not fall under this type if the invention can be clearly identified from the statement of a claim by considering the statements of the description and drawings as well as the common general knowledge as of the filing.

Example 2 : A compound having R receptor activating action

(Explanation)

Although the description states that the applicant was the first to discover "R receptor", it is the common general knowledge as of the filing that it is difficult to understand compounds specifically which are defined only by their action of activating a newly discovered receptor. In light of such common general knowledge, it is evident that the "compounds", which are defined only by the aforementioned action without any chemical structure etc. required to have the action being specified, are not sufficiently specified from a technical perspective, and the invention cannot be clearly identified from the statement of the claim even by considering the statements of the description and drawings.

(Points to note)

Even when an invention of a product pertains to a technical field where it is difficult to predict the structure of the product from the function or characteristics, etc. of the product, what has the relevant function or characteristics, etc. may be clearly understood by considering the common general knowledge as of the filing. In such case, the matter specified by the relevant function or characteristics, etc. is deemed to be sufficiently specified from a technical perspective.

Example 3 :

[claim]

A hybrid car energy efficiency of which during running on electricity is a to

b%, as measured by the X test method

(Explanation)

In the technical field of hybrid cars, it is the common general knowledge as of the filing that the energy efficiency during running on electricity is normally about x%, which is far lower than a%, and it is difficult to realize a higher energy efficiency such as a to b%. In light of this, it is difficult to understand the specific hybrid car defined only by such high energy efficiency. Thus, it is evident that the "hybrid car", which is defined only by the aforementioned energy efficiency without any means to realize the aforementioned energy efficiency being specified, is not sufficiently specified from a technical perspective, and the invention cannot be clearly identified from the statement of the claim even by considering the statements of the description and drawings.

4.1.2 Points to note

(1) It is possible to state in a claim expansion or generalization of one or more specific examples described in the description by using expressions defining an invention by a function or characteristics. However, if, as a result of using these expressions, the claimed invention exceeds the scope stated in the description which is described in such a way that a person skilled in the art could recognize that a problem to be solved by the invention would be actually solved, the relevant claim falls under a violation of the support requirements (see "Section 2 Support Requirement", 2.1(3)).

Where a claim includes an expression defining an invention by a function or characteristics, etc., and it is difficult to compare the claimed invention and a cited invention and cannot make a strict comparison between them, the examiner may notify a notice of reasons for refusal for the invention due to lack of novelty and inventive step as far as the examiner has a reasonable doubt for determining the patentability requirements of the claimed invention such as novelty or inventive step that the claimed invention and the cited invention are *prima facie* identical. (see "Part III Chapter 2 Section 4 Claims Including Specific Expressions" 2.2.2).

(2) A matter specifying an invention in the claims may be expressed by a function or characteristics, etc. However, particularly ambiguous or unclear terms should not be used even though it is easy to clearly state the claims.

4.2 Expression specifying the invention of a sub-combination by elements of "another

sub-combination”

A sub-combination refers to an invention of each device or step of the combination thereof while an invention of a combination refers to an invention of a whole device combining two or more devices or of a manufacturing process combining two or more steps.

Types of unclear inventions when a claim includes an expression identifying an invention of a sub-combination by using a matter concerning “another sub-combination” are shown below.

- (1) The case where a person skilled in the art cannot understand a matter concerning “another sub-combination” based on the matter stated in a claim even by considering the statements of the description and drawings as well as the common general knowledge as of the filing, and as a result, the invention is unclear.
- (2) The case where it cannot be clearly understood whether or how an invention of a sub-combination is specified by a matter concerning “another sub-combination”, even by considering the statements of the description and drawings as well as the common general knowledge as of the filing, and as a result, the invention is unclear.

Example:

[claim]

A client apparatus for sending words to be searched to a search server, receiving the reply information from the search server through a repeater, and displaying the search results on a display means, wherein the search server encrypts the reply information by an encryption system A before sending the information.

(Explanation)

It is well known to those skilled in the art that the information encoded by an encryption system A cannot be understood without decrypting the information. Because the information is sent to a client apparatus through a repeater by a search server in the claimed invention, it is not apparent whether a decoding means is provided in the repeater or the client apparatus. Thus, the examiner cannot clearly understand whether the client apparatus which is invention of the sub-combination is identified by a matter of “another sub-combination”.

4.3 Expression specifying a product by a manufacturing process

4.3.1 Types of unclear Inventions

Types of unclear inventions when a claim includes an expression for specifying a product by a manufacturing method thereof are shown below.

- (1) The case where a manufacturing process (e.g., starting materials or manufacturing processes) cannot be understood based on the matter stated in a claim even by considering the statements of the description and drawings as well as the common general knowledge as of the filing, and as a result, the invention is unclear.

Where a claim does not state a starting material or conditions set forth each manufacturing step, but these matters can be understood by considering the statements of the description and drawings as well as the common general knowledge as of the filing, such claim does not fall under this type.

- (2) The case where the characteristics of a product (e.g., the structure or property) cannot be understood even by considering the statements of the description and drawings as well as the common general knowledge as of the filing, and as a result, the invention is unclear.

Where a claim includes an expression specifying a product by the manufacturing method thereof, normally, the invention specified by the relevant expression shall be examined on the patentability requirements such as novelty or inventive step, etc., while considering that such invention refers to the final product itself. A precise examination on the patentability requirements may not be made if the structure or property, etc. of the product cannot be understood. In such case, the function of the claims, which requires that an invention shall be clearly identified from one claim (see 1.), is not secured, and therefore, such claim constitutes violation of the clarity requirement.

For example, if, in a case where the claimed invention of a product is specified only by the manufacturing method thereof, the description and drawings only state the features of the product which do not reflect the characteristics of the product (e.g., high yield or high manufacturing efficiency) and thereby the characteristics of the

product (e.g., the structure or property) cannot be understood even by considering the statements of the description and drawings as well as the common general knowledge as of the filing, such claim constitutes violation of the clarity requirement.

Example:

[claim]

Wash-free rice manufactured by a wash-free rice manufacturing method comprising steps of: receiving a feed of rice within a tank and removing bran by washing the rice in water; opening a drop valve situated at the bottom of the tank and dropping the bran-removed rice into the container provided down below; and drying the rice dropped into the container, wherein the manufacturing method further includes a step of spraying oily ingredient X onto the inner wall of the tank before feeding rice, and a step of blowing air into the tank immediately before opening the drop valve.

(Explanation)

The description states that the step of spraying oily ingredient X onto the inner wall of the tank before feeding rice makes the inner wall of the tank lubricious so as to prevent the rice from adhering to the wall, and that the step of blowing air into the tank immediately before opening the drop valve enables the rice on the inner wall of the tank to be dropped efficiently into the container provided down below. Even when considering the statements of the description and drawings as well as the common general knowledge as of the filing, however, it is uncertain how the step of spraying oily ingredient X onto the inner wall of the rice washing tank could affect the wash-free rice to be obtained, and the characteristics of the claimed wash-free rice cannot be understood.

4.3.2 The case where a claim concerning an invention of a product includes a manufacturing method for a product

When a claim concerning an invention of a product recites a manufacturing method for the product, the statement of claim comply with the requirement of “the invention is clear” only when the invention involves the situation where it is impossible or utterly impractical to define the product by its structure or characteristics at the time of filing. Otherwise the invention of the product is judged to be not clear. (Reference) Judgment of the Second Petty Bench of the Supreme Court (June 5, 2015, 2012(Ju) No. 1204,2658, Case of suit against appeal decision) Case of " Pravastatin sodium“

Examples of above circumstances are below.

- (i) It is technically impossible to analyze its structure or characteristics at the time of filing.
- (ii) It requires an outrageously large economic expenditure or time to carry out the work necessary to identify the structure or property of the product in view of the nature of a patent application which requires speed, etc.

The applicant can show above circumstances in the description or a written opinion.

4.3.3 Points to note

Where a claim includes an expression specifying a product by the manufacturing method thereof, normally, such expression shall be construed to refer to the final product itself (see “Part III Chapter 2 Section 4 Claims Including Specific Expressions”, 5.1). When it is extremely difficult to determine the structure of the product itself specified by such expression and comparison with cited invention is difficult due to the expression of a function or characteristics, etc. and thus a strict comparison cannot be made, if an examiner has a reasonable doubt for determining the patentability requirements of the claimed invention such as novelty or inventive step that the claimed invention would be *prima facie* identical to the cited invention the examiner may notify the notice of reasons for refusal notifying lack of novelty or inventive step for the claimed invention. (see “Part III Chapter 2 Section 4 Claims Including Specific Expressions”, 5.2.2)

Section 4 Conciseness Requirement (Patent Act Article 36(6)(iii))

1. Overview

Article 36(6)(iii) of the Patent Act provides that the statement for each claim shall be concise (Conciseness Requirement).

Claims are to be used for the basis of identifying the claimed invention which is a subject of examination of the patentability requirements such as novelty, inventive step, etc., and the description requirements. The statement of claims should also serve as a document of title defining the technical scope of a patented invention accurately (see Section 1 Patent Act Article 36(5)). Therefore, it is appropriate to recite the claims with conciseness while also complying with the requirement for clarity in order for third parties to understand the claimed invention as easily as possible. From this purpose, Article 36(6)(iii) prescribes the conciseness requirement.

This provision does not deal with the inventive concept defined by the statement of the claim but deals with the conciseness of the statement itself. Also when the application contains two or more claims, it does not require for the entirety of claims to be concise, rather requires each claim to be concise.

2. Determination of Conciseness Requirement

The following (1) and (2) are typical examples of the statement of claims not complying with the conciseness requirement.

- (1) A claim includes statements with same the contents in a duplicated manner, and these statements are excessively redundant.

However, in light of the purpose of Article 36(5) that a claim shall state the matters an applicant itself deems necessary to define the invention, the examiner shall deem "excessively redundant" only when the duplication is excessive, even where matters having the same contents are included in a claim. It shall not be deemed "excessively redundant" merely because a matter to define a claimed invention is an obvious limitation to a person skilled in the art or is a dispensable limitation for meeting the patentability requirements or the description requirements (excluding Article 36(6)(iii)).

When the statement of a claim is made by reference to the statement in the detailed description of the invention or drawings, an applicant shall note that the statement of the claim and the corresponding statement in the detailed description of the invention or the drawings should not be redundant as a whole.

- (2) Where claims are expressed in alternatives (e.g., a Markush-type claim for chemical compounds) and the number of alternatives is so large that conciseness is drastically damaged

When determining whether the conciseness is extremely damaged or not, the following matters should be taken into account by the examiner.

- (i) In a case where a significant structural element is not shared by the alternatives, fewer alternatives should be deemed so large that conciseness is drastically damaged than in a case where a significant structural element is shared by the alternatives.
- (ii) In a case where the alternatives are expressed in a complicated way, such as conditional options, fewer alternatives should be deemed so large that conciseness is drastically damaged than otherwise.

Even in this case, the examiner should choose at least one group of chemical compounds which is expressed as alternatives in the claim and which involves a chemical compound indicated as a working example ("a group of chemical compounds expressed as specific alternatives corresponding to a working example"), and shall examine the patentability of those chemical compounds. Regardless of existence or nonexistence of reason for refusal under patentability requirements, the examiner should point out in the notice of reasons for refusal, the group of chemical compounds which is examined on patentability.

3. Procedure of Examination for Determination of Conciseness Requirement

3.1 Notice of reason for refusal

Where the examiner determines that the statement of claims does not comply with the conciseness requirement, the claim concerned and the matters on which such

determination is based in the claim shall be described in the notice of reason for refusal. Also, the reason for determining that the invention is not concise shall be described specifically.

It is inappropriate to describe "the claimed invention is not concise" only without the specific reason, because it is difficult for the applicant to file the effectual response and to understand the direction for amendments to overcome the reason for refusal.

The examiner should note that the notice of reason for refusal may be issued only when duplication is excessive, even where matters having the same contents are included in a claim as stated in 2. Also, the examiner should note that the notice of reason for refusal may be issued only when the conciseness in the statement of claims is drastically damaged even where the claims are expressed in alternatives (e.g., a Markush-type claim for chemical compounds), and the number of alternatives is very large.

3.2 Arguments and clarifications, etc. of applicant

The applicant may make an argument or clarification by filing the written argument and the like against the notice of reason for refusal on violation of the conciseness requirement.

3.3 Handling of examiner on argument, clarification of applicant and so on

Where the examiner comes to be convinced that the statement of claims complies with the conciseness requirement by arguments and clarifications, etc. (see 3.2), the reason for refusal will be overcome. Otherwise, the decision of refusal shall be issued based on the reason for refusal that the statement of claims does not comply with the conciseness requirement.

Note: When any ambiguity of interpretation is found in this provisional translation, the Japanese text shall prevail.

Part II Chapter 2 Section 5 Ministerial Ordinance Requirement on Statement of Claims

Section 5 Ministerial Ordinance Requirement on Statement of Claims
(Patent Act Article 36(6)(iv))

1. Overview

Patent Act Article (36(6)(iv)) refers to the legal requirements regarding technical rules on the statement of claims to Regulations under the Patent Act Article 24ter.

2. Determination of Article 36(6)(iv)

The following (1) to (4) are typical examples in which the statement of the scope of claims does not satisfy the support requirements:

- (1) Where for each claim, the statement does not start on a new line, or one number is not assigned thereto (non-compliance with the provision of Regulations Article 24ter(i))

Example 1:

[Claim 1] A ball bearing having a specific structure [Claim 2] The ball bearing as defined in claim 1 that is provided with an annular cushion around the outer race
(Explain) Claim 2 does not start on a new line.

Example 2:

[Claim] A ball bearing having a specific structure
[Claim] A ball bearing that is provided with an annular cushion around the outer race
(Explain) One number is not assigned to each claim

- (2) Where claims are not numbered consecutively (non-compliance with the provision of Regulations Article 24ter(ii))

Example3:

[Claim 1] A ball bearing having a specific structure
[Claim 3] The ball bearing as defined in claim 1 that is provided with an annular cushion around the outer race

(Explain) Claim 3 starts immediately after claim 1; that is, claims are not numbered consecutively.

- (3) Where in the statement of claims, reference to the statement of other claims is not made by the numbers assigned thereto (non-compliance with the provision of Regulations Article 24ter(iii))

Example4:

[Claim 1] A ball bearing having a specific structure

[Claim 2] A process for producing the aforementioned ball bearing by use of a specific method

(Explain) With regard to "the aforementioned ball bearing" in claim 2, reference is not made by the number assigned to the claim 1.

- (4) Where, when a claim refers to a statement of another claim, the claim precedes the other claim to which it refers (non-compliance with the provision of Regulations Article 24ter(iv))

Example5:

[Claim 1] The ball bearing as defined in claim 2 that is provided with an annular cushion around the outer race

[Claim 2] A ball bearing having a specific structure

(Explain) Claim 1 referring to claim 2 precedes claim 2.

3. Procedure of Examination for Determination of Requirement under the Provision of Article 36(6)(iv)

3.1 Notice of reason for refusal

Where the examiner determines that the statement of claims does not comply with the requirement under the provision of Article 36(6)(iv) and conveys that effect in the notice of reason for refusal, the claim concerned and the reason for such determination shall be explained specifically.

It is inappropriate to describe only "the statement of claims does not comply with the requirement under the provision of Article 36(6)(iv)" without explaining the specific reason, because it is difficult for the applicant to file an effectual response and

to understand the direction for amendments to overcome the reason for refusal.

3.2 Argument and clarification of applicant

The applicant may make an argument or clarification by filing a written argument and the like against the notice of reason on the non-compliance with the requirement under the provision of Article 36(6)(iv).

3.3 Handling of examiner on argument, clarification of applicant and so on

Where the examiner comes to be convinced that the statement of claims complies with the requirement under the provision of Article 36(6)(iv) by argument and clarification (see 3.2), the reason for refusal will be overcome. Otherwise, the decision of refusal shall be issued based on the reason for refusal that the statement of claims does not comply with this requirement.

Chapter 3 Unity of Invention (Patent Act Article 37)

1. Overview

Patent Article 37 of the Patent Act provides that two or more inventions may be the subject of a single patent application, provided that these inventions are of a group of inventions which fulfill the requirements of unity of invention based on a certain technical relation among them.

If two or more inventions that are technically closely interrelated can be filed for patents in a single application, the application procedures become simplified and rationalized to the applicant and it becomes easier for third parties to use patent information and transact rights. In addition, it allows the Patent Office to examine such inventions together in an efficient way. In light of these points, Article 37 is established.

In this way, Article 37 is a provision for the convenience of applicants, third parties, and the Japanese Patent Office (JPO). Even if two or more inventions included in a single patent application do not fulfill the requirements of unity of invention, as long as there is no substantive deficiency in the inventions, such lack of unity of invention constitutes a mere formal deficiency that the single patent application should have been drafted as different applications for the two or more inventions which do not fulfill the requirements of unity of invention. Accordingly, the fact that a patent application which fails to fulfill the requirements of Article 37 is granted a patent does not directly inflict serious damages on the interests of third parties. Therefore, failure to fulfill the requirements of Article 37 constitutes a reason for refusal, but does not constitute a reason for invalidation.

Considering these circumstances, the examiner shall not make an unnecessarily strict determination on the requirements of Article 37.

2. Determination on Requirements of Article 37

The examiner shall decide a group of inventions which fulfill the requirements of unity of invention (a group of inventions having the same or corresponding special technical features) and inventions which fulfill certain requirements among the inventions stated in the claims, as the subject of the examination on requirements other than the requirements of Article 37 (in this

chapter, hereinafter, simply referred to as "subject of the examination"). Then, only in the case where there is an invention which is not decided the subject of the examination, the examiner shall make a determination that the patent application fails to fulfill the requirements of Article 37.

Understanding of special technical features of inventions and making a determination on the requirements of unity of invention are necessary for deciding inventions as the subject of the examination.

For making a determination on the requirements of unity of invention and understanding special technical features of inventions, the examiner shall follow 3. to be described later.

For deciding the subject of the examination, the examiner shall follow 4. to be described later.

(Explanation)

If not all the inventions stated in the claims are of a group of inventions which fulfill the requirements of unity of invention, essentially, the patent application does not fulfill the requirements of Article 37. In this case, the examiner shall decide only a group of inventions which fulfill the requirements of unity of invention as the subject of the examination, and shall not need to decide the other inventions as the subject of the examination.

However, the examiner shall decide the inventions that meet certain requirements as the subject of the examination as well as the group of inventions that meets the requirements of unity of invention, based on the fact that Article 37 is a provision with the purpose of promoting the convenience of applicants, etc. Then, only in the case where there is an invention which is not decided the subject of the examination, the examiner shall make a determination that the patent application fails to fulfill the requirements of Article 37.

3. Determination on Requirements of Unity of Invention

(1) The examiner shall make a determination on the requirements of unity of invention by determining whether two or more inventions stated in the claims have the same or corresponding special technical features.(Note 1)

The term "special technical feature" here means a technical feature defining a contribution made by an invention over the prior art (a technical significance of the invention in contrast to the prior art. (Note 2)

(Note 1) Usually, a determination on the requirements of unity of invention shall be made

between two or more "claimed invention." If a matter specifying the invention in one claim are expressed by pro forma or de facto alternatives (in this chapter, hereinafter, simply referred to as "alternatives." See 4.1.1(Note 1) in "Part III Chapter 2 Section 3 Procedure of Determining Novelty and Inventive Step"), a determination on the requirements of unity of invention shall also be made between two or more inventions identified based on the respective alternatives.

(Note 2) "Prior art" refers to the inventions that fall under each item of Article 29(1), and does not include the inventions that had not been published at the time of filing of the application concerned.

The examiner shall make a determination on the requirements of unity of invention by determining whether a special technical feature of one invention is the same as or corresponds to a special technical feature of another invention.

If a special technical feature of one invention is the same as or corresponds to a special technical feature of another invention, these inventions fulfill the requirements of unity of invention.

An examiner determines whether "special technical features are same or corresponding" based on substantial contents irrespective of mere differences in expression.

Since there are cases where both "the same" and "corresponding" are applicable to a special technical feature, the examiner shall not need to clearly determine whether "the same" or "corresponding" is applicable, at the time of making a determination on the requirements of unity of invention.

(2) An examiner determines "special technical features" of an invention based on a content of the description, claims and drawings and common general knowledge as of the filing.

However, in cases where it becomes clear that what was deemed to be a "special technical feature" does not make contribution over the prior arts relevant to the invention, it is denied a posteriori that said technical feature is a "special technical feature" (Note 3).

In this context, cases "where it becomes clear that what was deemed to be a "special technical feature" does not make contribution over the prior arts relevant to the invention" are the cases that fall under any of the following (i) to (iii):

- (i) where what was deemed to be a "special technical feature" is found in the prior art;
- (ii) where what was deemed to be a "special technical feature" is an addition, deletion, or replacement of well-known or commonly used art to one prior art, which does not produce any new effect; or
- (iii) where what was deemed to be a "special technical feature" is a mere design variation of one prior art.

(Note 3) Even if any technical feature of an invention is denied to be a "special technical feature", an examiner should note that another technical feature may be a "special technical feature" in some cases.

- (3) In a case where two or more inventions have "the same special technical feature," these inventions have the same technical feature which makes a contribution over the prior art.

Example 1:

[Claim 1] Polymeric compound A (transparent substance having improved oxygen barrier characteristics).

[Claim 2] A food packaging container composed of polymeric compound A.

(Explanation)

Polymeric compound A is a special technical feature which makes a contribution over the prior art. The inventions claimed in claims 1 and 2 both have this technical feature, and thus have the same special technical feature.

Example 2:

[Claim 1] A method of lighting comprising shielding a part of illumination light from a light source.

[Claim 2] A lighting system with a light source and a light shielding part that partially shields against illumination light from the light source.

(Explanation)

Shielding a part of illumination light is a special technical feature which makes a contribution over the prior art. The inventions claimed in claims 1 and 2 both have this technical feature, and thus have the same special technical feature.

- (4) The case where two or more inventions have "corresponding special technical

"features" is any of the following cases a and b.

- a Cases where two or more inventions have common or closely related technical significance in comparison with the prior art among them

In cases where two or more inventions solve the same or overlapping problems with respect to the prior art (the problems are limited to unsolved problems at the time of filing of the application concerned), technical significance of the inventions are considered as common or closely related in comparison with the prior art.

Example 3:

[Claim 1] Conductive ceramics made by adding titanium carbide to silicon nitride.

[Claim 2] Conductive ceramics made by adding titanium nitride to silicon nitride.

(Explanation)

The inventions claimed in claims 1 and 2 have different technical features, differing in whether titanium carbide or titanium nitride is added in silicon nitride. The problems solved by the inventions of Claims 1, 2 with respect to the prior art lie in making electric discharge machining possible by giving conductivity to ceramics composed of silicon nitride. Since the inventions of Claims 1, 2 solve the same or overlapping problems solved with respect to the prior art, they have common technical significance of the inventions in comparison with the prior art, thus, they have the corresponding special technical feature.

In this example, in cases where making electric discharge machining possible by giving conductivity to ceramics composed of silicon nitride is not considered as an unsolved problem at the time of filing of the application concerned, technical significance of the inventions in comparison with the prior art is not considered to be common or closely related. Therefore, the inventions of Claims 1, 2 fail to have a corresponding special technical feature.

- b Cases where special technical features of two or more inventions are related complementarily to each other

Example 4:

[Claim 1] A transmitter with a time axis extender for a video signal.

[Claim 2] A receiver with a time axis compressor for a received video signal.

(Explanation)

The inventions claimed in claims 1 and 2 have different technical features, that is, a transmitter with a time axis extender and a receiver with a time axis compressor, respectively. Here, extension of the time axis to transmit a video signal by the transmitter and reception of a video signal to compress the time axis by the receiver have a complementary relationship. Therefore, the inventions of Claims 1, 2 have the corresponding special technical feature.

- (5) For a determination on "the same or corresponding special technical features" in the case where two or more inventions have a specific relation, see 6.

4. Specific Decision Procedures for Subject of Examination

An examiner determines the subject of the examination based on "special technical features" and "examination efficiency."

Specifically, the examiner shall perform an examination for requirements other than the requirements of Article 37, on an invention which is decided as the subject of the examination based on any of the following decision procedures 4.1 and 4.2 (for a flow of specific decision procedures for the subject of the examination, see figure below.).

4.1 Decision of subject of the examination based on special technical features

An examiner determines the invention which is decided the subject of the examination based on "special technical features" according to following procedures (1) to (4). In cases where a matter specifying an invention of claims is expressed by alternatives in a claim (including a multiple dependent form claim), an examiner follows procedures below as if each invention understood by choosing each alternative is described as a separate claim in the order of said alternatives.

- (1) It is determined whether the invention first described in the claims (Note 1) has any special technical feature.

(Note 1) In principle, it corresponds to the invention claimed in Claim 1. If matters specifying the invention of Claim 1 are expressed by alternatives, in principle, the invention understood by choosing the first alternative shall be deemed to be the invention. However, for an

invention relating to a chemical substance that is described by Markush-form etc., the examiner shall deem the invention that is understood by choosing an appropriate alternative in consideration of the description of working examples, etc. to be the invention of Claim 1.

(2) In cases where the invention first described in the claims has no special technical feature, it is determined whether there are inventions claimed in the same category (Note 3) that include all matters specifying the invention of Claim 1 (Note 2). In cases there are such inventions, it is determined whether the invention of the claim to which the smallest claim number is attached has any special technical feature.

(Note 2) The cases of "including all matters specifying the invention" of an invention shall mean, for example, the following cases (i) to (iv). The examiner shall make a determination on whether a claim includes all matters specifying an invention is determined irrespective of whether the claim is formally an independent claim or a dependent claim.

- (i) The case where other matters specifying the invention are attached to said invention
- (ii) The case where part or all of the matters specifying the invention of said invention are converted into more specific concepts
- (iii) The case where, if there are elements that are written in an alternative form, part of the elements are deleted
- (iv) The case where, if one of the matters specifying the invention of said invention is a numerical range, the range is further limited

(Note 3) There is no longer a requirement to determine whether there is any special technical feature, in the case where the claimed invention for which a determination is to be made on whether there is any special technical feature falls under the following cases (i) and (ii).

- (i) The case where a technical feature with low technical relevance is added to the claimed invention for which a determination has been made immediately before on whether there is any special technical feature
- (ii) The case where a specific problem to be solved by the invention understood by said technical feature also has low relevance

(3) In cases where an claimed invention for which whether there is any special technical feature has already been determined has no special technical feature, it

is determined whether there is any invention claimed in the same category that include all matters specifying the claimed invention for which whether there is any special technical feature has been determined immediately before. In cases where there are such inventions, the examiner choose a claimed invention with the smallest claim number among claimed inventions and determine whether there is any special technical feature.(See Note 3 in (2)) This procedure is repeated until any special technical feature is found or there is no other claimed invention in the same category that includes all matters specifying the claimed invention for which whether there is any special technical feature has been determined immediately before.

(4) In the case where any special technical feature is found in any of the procedures (1) to (3), the following inventions (i) and (ii) shall be the subject of the examination. In the case where no special technical feature is found in any of the procedures (1) to (3), the following invention (i) shall be the subject of the examination.

- (i) the invention for which whether there is any special technical feature has already been determined
- (ii) the invention having any special technical feature which is same as or corresponding to the special technical feature found (Notes 4, 5)

(Note 4) For determining whether an invention for which a special technical feature has already been found and another invention have the same or corresponding special technical features, the examiner shall follow 3..

Note that the examiner may also make this determination by finding a common technical feature between an invention for which a special technical feature has already been found and another invention and determining whether the found technical feature is a special technical feature. Even if no special technical feature has been found by this method, the examiner should note that a special technical feature may be found in technical features different from the common technical feature.

(Note 5) In cases where an invention for which any special technical feature has been found has several different special technical features, an examiner shall choose one of those special technical features and an invention having a special technical feature same as or corresponding to said special technical feature shall be the subject of the examination.

In this regard, when one special technical feature is selected, if the subject of the examination becomes more advantageous to the applicant than in the case where another special technical feature is selected (for example, when one special technical feature is selected, a larger number of inventions involving an invention is decided the subject of the examination than another special technical feature is selected is decided the subject of the examination), the examiner shall select such a special technical feature with higher priority.

4.2 Decision of subject of the examination based on examination efficiency

If it is efficient to examine an invention together with those that is decided the subject of the examination, an examiner shall add the invention to the subject of the examination. The examiner shall determine whether it is efficient to examine an invention collectively by comprehensively taking into consideration matters described in the description, claims, drawings and common general knowledge as of the filing, and perspectives of prior art searches.

For example, an examiner adds an inventions that falls under (1) or (2) below to the subject of the examination, as it is efficient to examine it together with inventions that is decided the subject of the examination.

(1) Claimed inventions in the same category that include all matters specifying the invention of the invention first claimed in the claims

However, inventions which fall under the following case (i) or (ii) may be excluded.

- (i) The case where a problem to be solved by the invention first claimed in the claims (Note 1) and a specific problem to be solved understood by technical features added to said invention have low relevance
- (ii) The case where technical features of the invention first claimed in the claims (Note 2) and technical features added to said invention have low technical relevance

The relevance in (i) and the technical relevance in (ii) shall be determined by taking into consideration matters described in the description, claims, drawings and common general knowledge (Note 3) as of the filing and perspectives of prior art searches.

(Note 1) An examiner shall identify the problem to be solved by the invention first claimed in the claims by taking into consideration matters described in the description, claims, drawings and common general knowledge (Note 3) as of the filing. In cases where several problems are identified, the examiner shall identify one problem by giving consideration to the problem to be solved by the other inventions that is decided the subject of the examination in line with 4.1. In cases where identified problems are now-resolved and well-known, the examiner shall identify the problems in the same way.

(Note 2) In cases where the invention first claimed in the claims belongs to the common general knowledge as of the filing (Note 3) , technical features of the invention first claimed in the claims shall be identified by giving consideration to the technical features of the problem to be solved by the other inventions that is decided the subject of the examination in line with 4.1.

(Note 3) The common general knowledge refers to technologies generally known to a person skilled in the art (including well-known or commonly used art) or matters clear from empirical rules (See 2. in "Chapter 1 Section 1 Enablement Requirement ").

(Explanation)

Claimed inventions in the same category that include all matters specifying the invention of the invention first claimed in the claims generally belong to a technical field which is the same as or associated with the invention first claimed in the claims, and in many cases a prior art search can be conducted from a similar perspective. Therefore, those inventions shall, in principle, be added to the subject of the examination as inventions for which it is efficient to conduct an examination together with the invention first claimed in the claims.

However, inventions which fall under case (i) or (ii) require a prior art search from different perspectives, and hence it is not efficient to conduct an examination collectively. Therefore, the examiner may exclude these inventions from the subject of the examination.

(2) An invention for which an examination may be made without substantially conducting additional prior art searches and making a determination as a result of examining inventions that is decided the subject of the examination based on 4.1 and

4.2(1)

For example, an invention that falls under any of (i) to (v) below is usually deemed as an invention for which an examination may be made without substantially conducting additional prior art searches and making a determination.

- (i) Other inventions that differ only in terms of expression from inventions that is decided the subject of the examination based on said 4.1 and 4.2(1)
- (ii) Other inventions which added, deleted or replaced well-known or commonly used art with respect to inventions that is decided the subject of the examination based on said 4.1 and 4.2(1), which do not produce any new effects
- (iii) Other inventions whose difference from inventions that is decided the subject of the examination based on said 4.1 and 4.2(1) is a "designs modified along specific application of techniques" or "optimally or preferably modified numerical ranges" and it is easily determined said change does not produce any advantageous effects in comparison with the prior art (Note 4)
- (iv) In cases where it has been found that an invention has no novelty or inventive step as a result of examining inventions that is decided the subject of the examination based on said 4.1 and 4.2(1), other inventions which have wider concept that covers said invention
- (v) In cases where a point having some matters specifying the invention has been found out to have novelty and inventive step as a result of examining inventions that is decided the subject of the examination based on said 4.1 and 4.2(1), other inventions that include said matters specifying the invention

(Note 4) The prior art refers to an invention that falls under each item of Article 29(1) with respect to inventions that is decided the subject of the examination based on special technical features and it does not include inventions that had not been published as of the filing.

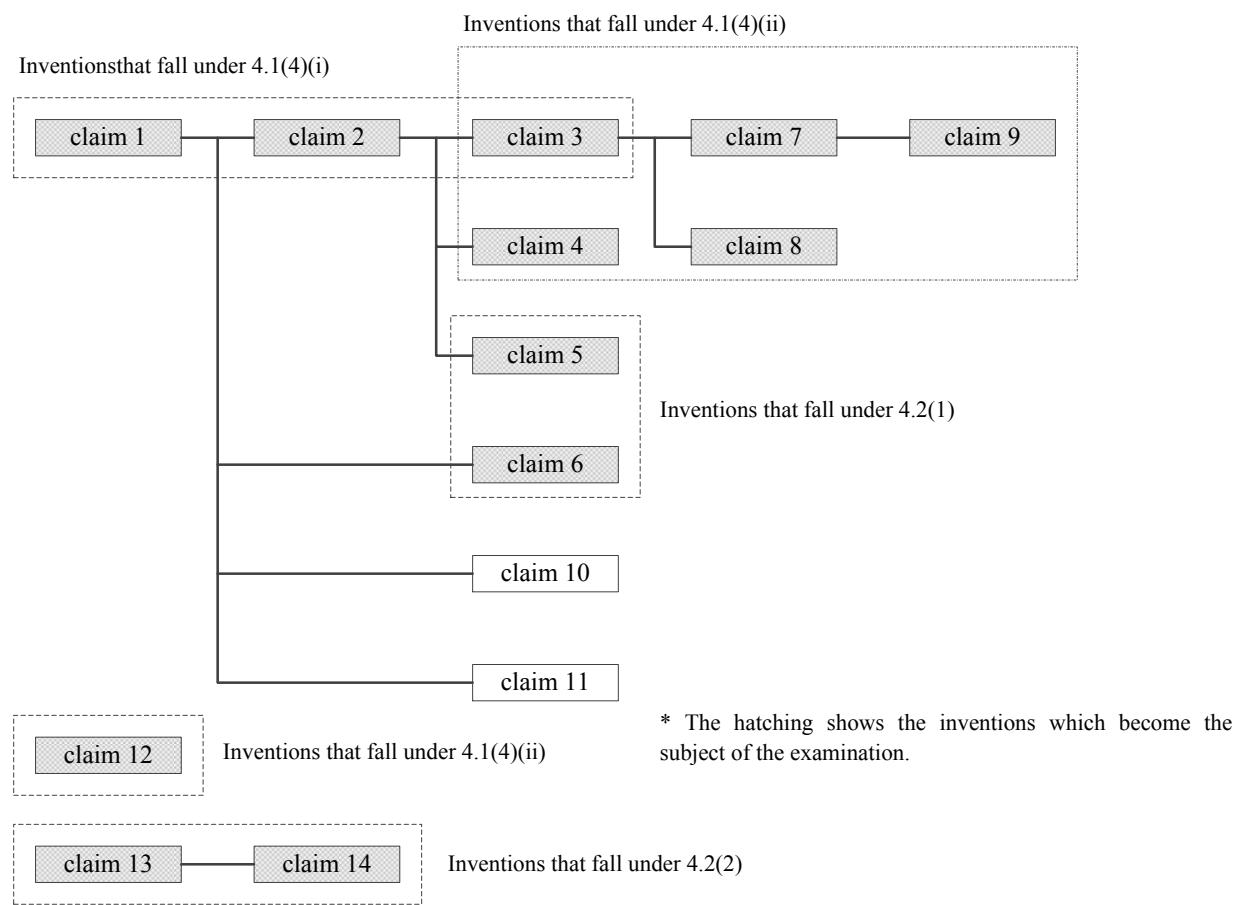
4.3 Example of decision of subject of the examination

There were no special technical features in the inventions of claims 1 and 2, but a special technical feature was found in the invention of claim 3. The inventions of claims 4, 7 to 9 and 12 have special technical features same as or corresponding to the found special technical feature.

Furthermore, the inventions of claims 5, 6, 10 and 11 are in the same category that includes all matters specifying the invention of claim 1. However, the specific problem to be solved by the invention of claim 10 that can be identified from the technical feature which is added to the invention of claim 1 and the problem to be solved by the invention of claim 1 have little relevance. Furthermore, the technical feature of the invention of claim 11 which is added to the invention of claim 1 and the technical feature of the invention of claim 1 have low technical relevance.

Claim 13 is an invention which differs only in terms of expression from claim 1.

Claim 14 is an invention which differs only in terms of expression from claim 6.



(Explanation)

In the case of this example, the examiner shall decide subject of examination as described below.

- (1) Decision of subject of the examination based on special technical features (See

4.1)

The inventions of claims 1 to 3 shall become the subject of the examination as inventions for which whether there is any special technical feature has been determined.

The inventions of claims 4, 7 to 9 and 12 shall become the subject of the examination as inventions having a special technical feature which is same as or corresponding to the special technical feature found.

(2) Decision of subject of the examination based on examination efficiency (See 4.2(1), (2))

The inventions of claims 5 and 6 are in the same category that includes all matters specifying the invention of claim 1 so that they shall be added to the subject of the examination.

The invention of claim 10 is in the same category that includes all matters specifying the invention of claim 1. However, the problem to be solved by the invention of claim 1 and the specific problem to be solved by the invention understood by technical features added to the invention of claim 1 have little relevance. Therefore, if it is not an invention for which an examination may be made without substantially conducting additional prior art searches and making a determination as a result of examining the inventions of claims 1 to 9 and 12 and there are no other reason that it is efficient to examine the inventions collectively, the invention of claim 10 may be excluded from the subject of the examination.

The invention of claim 11 is in the same category that includes all matters specifying the invention of claim 1. However, the technical feature of the invention of claim 1 and the technical feature added to the invention of claim 1 have little technical relevance. Therefore, if it is not an invention for which an examination may be made without substantially conducting additional prior art searches and making a determination as a result of examining the inventions of claims 1 to 9 and 12 and there are no other reason that it is efficient to examine the inventions collectively, the invention of claim 11 may be excluded from the subject of the examination.

The invention of claim 13 is an invention that differs only in terms of expression from the invention of claim 1 and for which an examination may be made without substantially conducting additional prior art searches and making a determination as a result of examining the invention of claim 1, so that the invention of claim 13 shall be added to the subject of the examination.

The invention of claim 14 is an invention that differs only in terms of expression from the invention of claim 6 and for which an examination may be made without substantially conducting additional prior art searches and making a determination as a result of examining the invention of claim 6, so that the invention of claim 14 shall be added to the subject of the examination.

5. Procedure of Examination under Article 37

In the case where the examiner has determined that there is an invention which is not decided the subject of the examination and the patent application does not fulfill the requirements of Article 37, the examiner shall issue a notice of reasons for refusal to the effect that the patent application does not fulfill the requirements of Article 37. The examiner shall indicate the inventions that are not decided the subject of the examination and describe reasons for the inventions being ruled out in the notice of reasons for refusal.

6. Example of "the same or corresponding special technical features" in Specific Examples

6.1 Examples with specific relation among inventions of claims

6.1.1 A product and method of producing the product or product and machine, instrument, device, the other means for producing the same

If a method of producing a product, and machine, instrument, device, the other means for producing a product (in this chapter, hereinafter referred to as "production method or production device, etc.") is suitable for producing "the product," they have the same or corresponding special technical feature. Even if something other than "the product" is produced by "production method or production device, etc.," they have the same or corresponding special technical feature, if the "production method or production device, etc." is suitable for producing "the product."

The phrase "the other means" in the above "machine, instrument, device, the other means for producing a product" encompasses a catalyst, microorganism etc., which acts on other materials, work pieces, etc., and turns them into a product.

(Explanation)

The case where a "production method or production device, etc." is "suitable" for producing "the product" is, for example, a case where a special technical feature of a "production method or production device, etc." necessarily causes conversion of raw material into a special technical feature of "the product" (including the "product" itself). In this case, the contribution over the prior art of the invention which is made by the special technical feature of the "production method or production device, etc." gives the special technical feature of the "product." Therefore, the contributions over the prior art of the invention which are respectively made by the special technical features of the two are closely related, and hence the two have the same or corresponding special technical features.

6.1.2 A product and method of using the product or product and another product solely utilizing specific properties of the product

- (1) If a "method of using a product" is suitable for use of the "product", both have the same or corresponding special technical feature.

(Explanation)

The case where a "method of using a product" is "suitable" for use of the "product" is, for example, a case where a special technical feature of the "method of using the product" utilizes properties and/or functions particular to a special technical feature of the "product".

In this case, the contribution over the prior art of the invention which is made by the special technical feature of the "method of using a product" lies in the utilization of the particular properties and/or functions of the special technical feature of the "product." Therefore, the contributions over the prior art of the invention which are respectively made by the special technical features of the two are closely related, and hence the two have the same or corresponding special technical features.

- (2) If a special technical feature of "a product solely utilizing the specific properties of another product" solely utilizes the specific properties of the special technical feature of "another product", both "a product" and "another product" have the same or corresponding special technical features.

(Explanation)

If a special technical feature of "a product solely utilizing the specific properties of

"another product" solely utilizes the specific properties of the special technical feature of "another product", the contribution over the prior art of the invention, which is made by the special technical feature of "a product solely utilizing the specific properties of another product", lies in the sole utilization of the specific properties of the special technical feature of "another product". Therefore, the contributions over the prior art of the invention which are respectively made by the special technical features of the two are closely related, and hence the two have the same or corresponding special technical features.

6.1.3 A product and method of handling the product or product and another product handling the product

If a method of handling a product or another product handling the product (in this chapter, hereinafter referred to as "a handling method or another handling product") is suitable for handling "the product", both have the same or corresponding special technical features. Even if "a handling method or another handling product" is applicable to handling something other than the "product", both still have the same or corresponding special technical features, if they are suitable for handling said "product".

(Explanation)

The case where "a handling method or another handling product" is "suitable" for handling "the product" is, for example, a case where the special technical feature of "a handling method or another handling product" necessarily maintains or exercises the function by external action on the special technical feature of "the product" and does not basically give substantial changes to "the product".

In this case, the contribution over the prior art of the invention which is made by the special technical feature of the "handling method or another handling product" is to necessarily maintain and exercise the function of the special technical feature of the "product." Therefore, the contributions over the prior art of the invention which are respectively made by the special technical features of the two are closely related, and hence the two have the same or corresponding special technical features.

6.1.4 A method and machine, instrument, device, or other means directly used to carry out the method

If "a machine, instrument, device or other means directly used to carry out a

"method" (in this chapter, hereinafter referred to as "device directly used to carry out a method") are suitable for direct use to carry out "the method", both have the same or corresponding special technical features. Even if the "device directly used to carry out a method" can be directly used to carry out a method other than "the method", both still have the same or corresponding special technical features, if the "device directly used to carry out a method" is suitable for direct use to carry out "the method." The phrase "the other means" in "a machine, instrument, device or other means directly used to carry out a method" encompasses catalysts, microorganisms, raw materials, work pieces and all other means directly used to carry out the method rather than a machine, instrument and device.

(Explanation)

The case where a "device directly used to carry out a method" is "suitable" for direct use to carry out "the method" is, for example, a case where a special technical feature of a "device directly used to carry out a method" is directly utilized to carry out a special technical feature of "the method".

In this case, the contribution over the prior art of the invention which is made by the special technical feature of the "device directly used to carry out a method" is to carry out the special technical feature of the "method." Therefore, the contributions over the prior art of the invention which are respectively made by the special technical features of the two are closely related, and hence the two have the same or corresponding special technical features.

6.2 Markush-form

Where a claim is described in the Markush-Form, the examiner makes a determination on the requirements of unity of invention in the claim by finding out whether inventions understood based on the alternatives have the same or corresponding special technical features.

Especially, where a claim described in the Markush-Form is related to a chemical compound written in an alternative form, inventions understood based on the alternatives have the same or corresponding special technical features, if the following requirements (1) and (2) are both satisfied:

- (i) All the inventions respectively identified based on the respective alternatives have a common property or activity; and

(ii) (ii-1) a common chemical structure is present, i.e., a significant chemical structural element is shared by all the inventions understood based on the alternatives (Note 1),

or

(ii-2) in cases where the common chemical structure cannot be the unifying criteria, all the inventions understood based on the alternatives belong to a group of chemical substances that is recognized as one genus in the art to which the inventions pertain (Note 2).

(Note 1)"a significant chemical structure element is shared by all the inventions identified based on the respective alternatives" refers to the cases where all the chemical substances identified based on the respective alternatives share a common chemical structure which occupies a large portion of the whole structure. If all the chemical compounds identified based on the respective alternatives have in common only a small portion of the structure, it refers to the cases where the commonly shared structure constitutes a structurally distinctive portion in view of the prior art. The chemical structural element may be a single component or a combination of individual components linked together.

(Note 2)the phrase "a group of chemical substances recognized as one genus" means that there is an expectation from the knowledge in the art that species of the genus will behave in the same way in the context of the claimed invention. In other words, each species which belongs this group of chemical compounds could be substituted for the other, with the expectation that the similar intended result would be achieved.

When dealing with alternatives in the Markush-Form, if at least one of the inventions understood based on the alternatives is found in the prior art, an examiner shall reconsider the question of unity of invention.

6.3 Intermediate and final product

If the following requirements (i) and (ii) are both satisfied, an invention related to an intermediate product and an invention related to a final product have the same or corresponding special technical features.

(i) An intermediate and a final product have the same or technically closely related

new structural element, namely:

- (i-1) the basic skeleton which is not found in prior art is common to the chemical structures of the intermediate product and the final product; or
 - (i-2) the chemical structures of the intermediate product and the final product are technically closely related to each other.
- (ii) The intermediate product and the final product are technically related to each other. In other words, the final product is prepared directly from an intermediate product or prepared via a small number of other new intermediate products that are not found in prior arts, which include the same substantial structural element.

Even if the structure is unclear, an intermediate product and a final product may have the same or corresponding special technical features in some cases. For example, an intermediate product with a clear constitution structure and a final product with an unclear constitution structure or an intermediate product with an unclear constitution structure and a final product with an unclear constitution structure sometimes may have the same or corresponding special technical features.

In such a case, in order to prove that the intermediate product and the final product have the same or corresponding special technical features, sufficient evidence is required showing that the structures of the intermediate product and the final product are technically closely related to each other (for example, the intermediate product includes the same main structural element as that of the final product or the intermediate product incorporates a main structural element in the final product).

In the case where individual intermediate products which are used in different processes to prepare one final product include the same main structural element, this main structural element is the same or corresponding special technical feature. Therefore, the inventions related to the final product and the individual intermediate products have the same or corresponding special technical features.

In cases where an intermediate product and a final product are defined in claims so as to constitute a group of chemical compounds, the respective intermediate compounds must correspond to one of the chemical compounds in the final product in the claims. However, some of the final products may not have a corresponding intermediate compound. Therefore, the two groups do not need to correspond to each other completely.

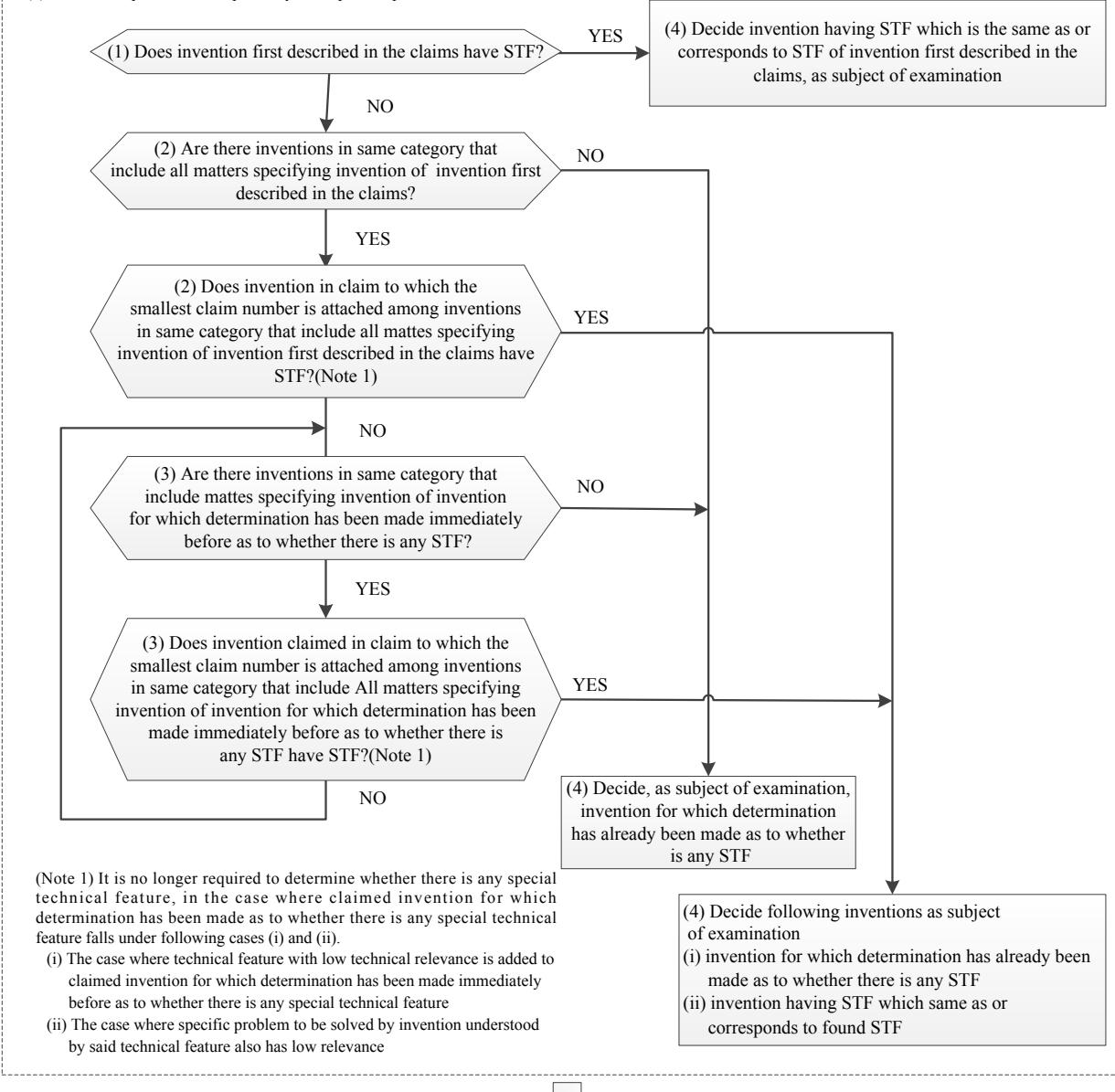
Showing that the intermediate product has other effects or exhibits other

activities than the final product does not affect the examination of unity of invention.

Figure : Specific Decision procedures for subject of examination

[1] Decision of subject of examination based on special technical features[STF](4.1)

(* Numbers in parentheses respectively correspond to procedures in 4.1



[2] Decision of subject of examination based on examination efficiency(4.2)

(1) Decide as subject of examination claimed inventions in same category that include all matters specifying invention of claim 1(Note 2)

Note 2: Inventions which fall under the following case(i) or (ii) may be excluded.

(i) The case where problem to be solved by invention claimed in claim 1 and specific problem to be solved understood by technical features added to said invention have low relevance

(ii) The case where technical features of invention of invention claimed in claim 1 and technical features added to said invention have low technical relevance

(2) Decide, as subject of examination, invention for which examination can be made without substantial need for additional prior art searches and determinations as result of examining inventions decided as subject of examination based of [1] and [2](1) above

Note: When any ambiguity of interpretation is found in this provisional translation, the Japanese text shall prevail.

Part II Description and Claims

<Relevant Provisions>

Patent Act

(Patent applications)

Article 36

(Omitted)

(2), (3) (Omitted)

(4) The statement of the detailed description of the invention as provided in item (iii) of the preceding paragraph shall comply with each of the following items:

(i) in accordance with Ordinance of the Ministry of Economy, Trade and Industry, the statement shall be clear and sufficient in such a manner as to enable any person ordinarily skilled in the art to which the invention pertains to work the invention; and
(ii) where the person requesting the grant of a patent has knowledge of any inventions (inventions as provided in Article 29(1)(iii), hereinafter the same shall apply in this item) related to said invention, that has been known to the public through publication at the time of filing of patent application, the statement shall provide the source of the information concerning the inventions known to the public through publication such as the name of the publication and others.

(5) The scope of claims as provided in paragraph (2) shall state a claim or claims and state for each claim all matters necessary to specify the invention for which the applicant requests the grant of a patent. In such a case, an invention specified by a statement in one claim may be the same invention specified by a statement in another claim.

(6) The statement of the scope of claims as provided in paragraph (2) shall comply with each of the following item:

(i) the invention for which a patent is sought is stated in the detailed description for the invention;
(ii) the invention for which a patent is sought is clear;
(iii) the statement for each claim is concise;
(iv) This provision refers the legal requirements regarding technical rules on the statement of claims to an ordinance of the Ministry of Economy, Trade and Industry.

7 (omitted)

Article 37

Two or more inventions may be the subject of a single patent application in the same application provided that, these inventions are of a group of inventions recognized as fulfilling the requirements of unity of invention based on their technical relationship designated in Ordinance of the Ministry of Economy, Trade and Industry.

(Notice of description of information concerning invention known to the public through publication)

Article 48septies

Where the examiner recognizes that a patent application does not comply with the requirements under the provision of Article 36(4)(ii), the examiner may notify the applicant of that effect and give said applicant an opportunity to file a written argument, designating an adequate time limit for such purpose.

(Decision of refusal)

Article 49

The examiner shall render an examiner's decision to the effect that a patent application is to be refused where the patent application falls under any of the following:

- (i)-(iv) (Omitted)
- (v) Where notice under the preceding Article has been issued, and the patent application does not comply with the requirements under Article 36(4)(ii) even after considering the amendments for the specifications or the written argument filed.
- (vi) and (vii) (Omitted)

Regulations under the Patent Act

(Statement of the Detailed Description of the Invention)

Article 24bis

The statement of the detailed description of the invention which is to be in accordance with Ordinance of the Ministry of Economy, Trade and Industry under the Patent Act, Article 36(4)(i) shall be made by stating the problem to be solved by the invention and its solution, and other matters necessary for a person ordinarily skilled in the art to which the invention pertains to understand the technical significance of the invention.

(Statement of claims)

Article 24ter

Statement of claims under the provision of Article 36(6)(iv) of the Patent Act which are to be in accordance with an ordinance of the Ministry of Economy, Trade and Industry shall be as provided in each of the following items:

- (i) for each claim, the statement shall start on a new line with one number being assigned thereto;
- (ii) claims shall be numbered consecutively;
- (iii) in the statements in a claim, reference to other claims shall be made by the numbers assigned thereto;
- (iv) when a claim refers to another claim, the claim shall not precede the other claim to which it refers.

(Unity of Invention)

Article 25octies

- (1) The technical relationship designated in Ordinance of the Ministry of Economy, Trade and Industry under Patent Act Article 37 means a technical relationship in which two or more inventions must be linked so as to form a single general inventive concept by having the same or corresponding special technical features among them.
- (2) The special technical feature provided in the former paragraph stands for a technical feature defining a contribution made by an invention over the prior art.
- (3) The technical relationship provided in the first paragraph shall be examined, irrespective of whether two or more inventions are described in separate claims or in a single claim written in an alternative form.

Part III

Patentability

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Part III Patentability

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<Relevant Provisions>

Note: When any ambiguity of interpretation is found in this provisional translation, the Japanese text shall prevail.

Part III Chapter 1 Eligibility for Patent and Industrial Applicability

Chapter 1 Eligibility for Patent and Industrial Applicability (Main Paragraph of Article 29(1) of the Patent Act)

1. Overview

The main paragraph of Article 29(1) of the Patent Act defines that any person who has made an invention which is industrially applicable may obtain a patent therefor. Article 2(1) of the Patent Act defines "invention" as "the highly advanced creation of technical ideas utilizing the laws of nature". An invention which does not comply with this definition shall not be patented. An invention for which a patent is sought shall be industrially applicable even if the patent complies with this definition, since the purpose of the Patent Act is the development of industry (Article 1).

The main paragraph of Article 29(1) of the Patent Act provides the two following points as the patentability requirements:

- (i) A statutory "invention" (hereinafter, referred to as "eligibility for a patent" in this chapter) (see 2.)
- (ii) An "industrially applicable invention" (hereinafter, referred to as "industrial applicability" in this chapter) (see 3.)

This chapter explains determination on eligibility for a patent and industrial applicability.

In this chapter, an invention complying with the requirements of eligibility for a patent is referred to as a statutory "invention". The word "invention" in the expression "claimed invention" does not mean that the invention complies with the requirements of eligibility for a patent.

2. Determination on Requirements of Eligibility for Patent

The subject of determination on the requirements of eligibility for a patent is a claimed invention.

When a claimed invention is considered as any of (i) to (vi) in 2.1 , an examiner shall determine that the claimed invention does not comply with the requirements of eligibility for a patent. For a claimed invention utilizing computer software, see 2.2 .

When there are two or more claims in the claims, an examiner shall determine

on requirements of eligibility for a patent for each claim.

The expression "highly advanced" in the definition of the statutory "invention" has been introduced to differentiate the "invention" from "device" under the Utility Model Act. Thus, an examiner may disregard this expression in judging eligibility for a patent.

2.1 List of Subject Matters Not Corresponding to Statutory "Inventions"

To be considered as a statutory "invention", an invention needs to be a "creation of a technical idea utilizing a law of nature". Since (i) to (vi) shown below are not a "creation of a technical idea utilizing a law of nature", it is not considered as a statutory "invention".

- (i) A law of nature as such (see 2.1.1)
- (ii) Mere discoveries and not creations (see 2.1.2)
- (iii) Those contrary to a law of nature (see 2.1.3)
- (iv) Those in which a law of nature is not utilized (see 2.1.4)
- (v) Those not regarded as technical ideas (see 2.1.5)
- (vi) Those for which it is clearly impossible to solve the problem to be solved by any means presented in a claim (see 2.1.6)

2.1.1 A law of nature as such

Since a statutory "invention" shall utilize a law of nature, a law of nature as such, like a law of preservation of energy or a law of universal gravitation, is not considered as a statutory "invention".

2.1.2 Mere discoveries and not creations

Since a statutory "invention" shall be a creation, mere discoveries, such as discoveries of natural things (e.g., ore) or natural phenomena, for which an inventor does not create any technical idea with intention, are not considered as a statutory "invention".

However, if things in nature such as chemical substances or microorganisms have been isolated artificially from their surroundings, those are creations and considered as a statutory "invention".

2.1.3 Those contrary to a law of nature

If a matter necessary to specify a claimed invention (hereinafter referred to as "a matter specifying the invention" in this part) involves any means contrary to a law of nature like a law of preservation of energy (e.g., the so-called "perpetual motion"), the claimed invention is not considered as a statutory "invention".

2.1.4 Those in which a law of nature is not utilized

When a claimed invention is considered as any of (i) to (v) shown below, the claimed invention is not deemed to utilize a law of nature, and thus, is not considered as a statutory "invention" (see Example 1 and Example 2).

- (i) Any laws other than a law of nature (e.g., economic laws)
- (ii) Arbitrary arrangements (e.g., a rule for playing a game as such)
- (iii) Mathematical formula
- (iv) Mental activities of humans
- (v) Those utilizing only (i) to (iv) (e.g., methods for doing business as such)

Even if a part of matters specifying the invention stated in a claim utilizes a law of nature, when it is judged that the claimed invention as a whole does not utilize a law of nature, the claimed invention is deemed as not utilizing a law of nature (see Examples 3 to 6).

On the contrary, even if a part of matters specifying the invention stated in a claim does not utilize a law of nature, when it is judged that the claimed invention as a whole utilizes a law of nature, the claimed invention is deemed as utilizing a law of nature.

The characteristic of the technology is to be considered in judging whether a claimed invention as a whole utilizes a law of nature.

(Examples of those contrary to a law of nature)

Example 1: Computer programming languages (applicable to (ii) in the above)

Example 2:A method of collecting money for an electricity bill or a gas bill etc., by rounding off the total amount to be collected to the nearest 10 yen unit (applicable to (v) in the above)

Example 3:A method of plying a container vessel to transport a large amount of beverages from

a region where crude oil is expensive and beverages are inexpensive to another region where crude oil is inexpensive and beverages are expensive, and after unloading the beverages, transporting a large amount of crude oil instead of beverages to the homeward voyage

Example 4:A method of billboard advertising using utility poles, characterized by forming in advance groups A, B, C, D, ... with a prescribed number of poles in each group, placing a holding frame to post thereon a billboard for each pole, and posting the billboards in each group on holding frames placed to poles in each group in circulation in a certain time interval

Example 5:A method of playing *shogi* (Japanese chess) between players remote from each other, the method comprising: a step of transmitting a move of one player to the other player through a chat system in the one player's turn; and a step of transmitting a move of the other player to the one player through the chat system in the other player's turn, the steps being repeated alternately.

(Explanation)

It does not fall under “the invention” since the method described above applies only artificial arrangements as a whole where two players remote from each other play alternately although the chat system is used as the technical means.

Example 6:A method of playing a game in which cards with $n \times n$ (n is an odd number that is three or more) numbers thereon are distributed to each player, each player marks a number drawn by a computer if his/her card includes the drawn number, and a player who first marks all numbers in a vertical, horizontal or diagonal row can be a winner

(Explanation)

It does not fall under “the invention” since the method described above applies only the specific rules of the game as a whole where each player marks a drawn number if the player has such number in the card and the player who first marks all numbers in a vertical, horizontal or diagonal row can be a winner, although the drawing is carried out by the computer as the technical means.

2.1.5 Those not regarded as technical ideas

- (1) Personal skill (which is acquired through personal experience and cannot be shared with others as knowledge due to lack of objectivity)

Example1: A method of throwing a split-fingered fast ball characterized in the way of holding the ball in fingers and throwing the same

(2) Mere presentation of information (where the feature resides solely in the content of the information, and the main object is to present information)

Example 2: A written manual for instructing an operation of a machine or directing a use of a chemical substance

Example 3: An audio CD the feature of which resides solely in music recorded thereon

Example 4: Image data taken with a digital camera

Example 5: A program of an athletic meeting made by a word processor

Example 6: A computer program list (mere representation of computer programs by means of printing them on paper, displaying them on a screen, etc.)

If a technical feature resides in presentation of information (presentation per se, means for presentation, a method for presentation, etc.), a claimed invention is not considered as mere presentation of information.

Example 7: A test pattern for use in checking the performance of a television set
(Explanation)

The technical feature resides in the pattern per se.

Example 8:A plastic card on which information is recorded with characters, letters and figures embossed on it

(Explanation)

The information is printed on the plastic card by emboss processing and the printed information on the card is copied by affixing the card on paper. The technical feature resides in the means for presentation.

(3) Mere aesthetic creations

Example9: paintings, carvings, etc.

2.1.6 Those for which it is clearly impossible to solve the problem to be solved by any means presented in a claim

Example: A method of preventing explosion in a volcano by forming balls of neutron-absorbing material (e.g., boron) covered with substance having a relatively high melting temperature (e.g., tungsten) and throwing them into the volcanic vent

(Explanation)

This invention allegedly works on the assumption that volcanic explosion is caused by nuclear fission substances like uranium at the bottom of the volcanic vent.

2.2 Points to consider in examination on an invention utilizing computer software

(1) For inventions relating to a method for doing business, playing a game or calculating a mathematical formula, since there are cases in which the claimed invention a part of which utilizes an article, apparatus, device, system, computer software, etc., is judged as not utilizing a law of nature when considered as a whole, whether they are "creation of a technical idea utilizing a law of nature" shall be carefully examined.

On the other hand, there is possibility for an invention to be considered as a "creation of a technical idea utilizing a law of nature" where the invention is made having an intention of utilizing computer software such as software used in doing business, in playing a game or in calculating a mathematical formula as a whole, even though the invention is made related to a method for doing business, playing a game or calculating a mathematical formula.

An examiner shall examine whether such an invention is to be considered as a "creation of a technical idea utilizing a law of nature" from a viewpoint of computer software. On the whole

(2) Those utilizing a law of nature as a whole and being considered as a "creation of a technical idea utilizing a law of nature" irrespective of whether computer software is utilized (e.g., (i) or (ii) shown below) constitute a statutory "invention" without being examined from a viewpoint of computer software.

Computer software for causing a computer to execute a method, which is a "creation of a technical idea utilizing a law of nature" and thus constitutes a statutory "invention", or a computer or system for executing such method is normally a creation of a technical idea utilizing a law of nature as a whole, and thus, it constitutes a

statutory "invention".

- (i) Those concretely performing control of an apparatus (e.g., rice cooker, washing machine, engine, hard disk drive, chemical reaction apparatus, nucleic acid amplifier), or processing with respect to the control
- (b) Those concretely performing information processing based on the technical properties such as physical, chemical, biological or electric properties of an object (e.g., rotation rate of engine, rolling temperature, relation between gene sequence and expression of a trait in a living body, physical or chemical relation of bound substances)

3. Determination on Industrial Applicability Requirements

The subject of determination on the industrial applicability requirements is a claimed invention.

When a claimed invention is considered as any of (i) to (iii) in 3.1 , an examiner shall determine that the claimed invention does not comply with the industrial applicability requirements.

When there are two or more claims in the claims, an examiner shall make examination of the industrial applicability requirements for each claim.

Here, the word "industry" is interpreted in a broad sense, including manufacturing, mining, agriculture, fishery, transportation, telecommunications, etc.

3.1 List of industrially inapplicable inventions

An invention considered as any one of (i) to (iii) shown below does not comply with the industrial applicability requirements.

- (i) Inventions of methods of surgery, therapy or diagnosis of humans (see 3.1.1)
- (ii) Commercially inapplicable inventions (see 3.1.2)
- (iii) Obviously impracticable inventions (see 3.1.3)

3.1.1 Inventions of methods of surgery, therapy or diagnosis of humans

Methods of surgery therapy or diagnosis of humans have been termed "medical activity" and are normally practiced by medical doctors (including those who are directed by medical doctors, hereinafter referred to as "medical doctors").

A method considered as any one of (i) to (iii) shown below is considered as an "invention of methods of surgery, therapy or diagnosis of humans".

- (i) Methods of surgery of humans (see (1))
- (ii) Methods of therapy of humans (see (2))
- (iii) Methods of diagnosis of humans (see (3))

The following methods of (a) and (b) are included in "inventions of methods of surgery, therapy or diagnosis of humans".

- (a) Methods for contraception or delivery
- (b) Methods for processing samples that have been extracted from a human body (e.g., a method of dialyzing blood) or analyzing the samples during the process on the presumption that the samples are to be returned to the same body for therapy (except for the methods described in 3.2.1(4)b)

Even if methods of surgery, therapy or diagnosis are practiced on animals in general, unless it is clear that the methods practiced on humans are explicitly excluded, the methods are deemed as being "inventions of methods of surgery, therapy or diagnosis of humans".

(1) Methods of surgery of humans

Methods of surgery of humans include the following:

- (i) Methods for surgical treatment (such as incision, excision, centesis, injection and implant)
- (ii) Methods of using (e.g., inserting, moving, maintaining, operating and extracting) a medical device (e.g., a catheter or an endoscope) inside the human body (excluding inside the mouth, inside the external nostril, and inside the external ear canal)
- (iii) Preparatory treatment for surgery (e.g., anesthetic treatment for surgery and method of disinfecting skin before injection)

Cosmetic methods having surgical operations whose purpose is not therapeutic or diagnostic are also considered methods of surgery of humans.

(2) Methods of therapy of humans

Methods of therapy of humans include the followings:

- (i) Methods of administrating medicine or giving physical treatment to a patient for curing or restraining a disease
- (ii) Methods of implanting substitute organs such as artificial internal organs or

artificial limbs

- (iii) Methods of preventing a disease (e.g., methods of preventing tooth decay or influenza)

Methods of treatment for the maintenance of physical health (e.g., methods of massage or shiatsu therapy) are also considered to be methods of preventing a disease.

- (iv) Preparatory treatment for therapy (e.g., method for arranging electrodes for electrical therapy)

- (v) Supplemental methods for improving treatment effects (e.g., rehabilitation methods)

- (vi) Methods for nursing associated with treatment (e.g., methods to prevent bedsores)

(3) Methods of diagnosis of humans

Methods of diagnosis of humans include methods of judging for the medical purposes the physical condition of a human body as indicated in (i) or (ii) below:

- (i) Physical condition of a human body such as conditions of diseases and physical health or the mental condition of a human body

- (ii) Prescription or treatment/surgery plans based on the above (i)

Example: Methods of judging whether the patient has had a stroke by observing an image obtained by an MRI scan.

3.1.2 Commercially inapplicable inventions

An invention which corresponds to the invention indicated in (i) or (ii) below is considered to be a "commercially inapplicable invention".

- (i) An invention applied only for personal use (for example, a method of smoking)

- (ii) An invention applied only for academic or experimental purposes

3.1.3 Obviously impracticable inventions

An invention which cannot be practically implemented is not considered to be an "obviously impracticable invention" even if it works in theory.

Example: A method for preventing an increase in ultraviolet rays associated with the destruction of the ozone layer by covering the whole earth's surface with an ultraviolet ray-absorbing plastic film.

3.2 Types of industrially applicable inventions

In principle, an invention which does not correspond to any one of (i) to (iii) in 3.1 is considered to be an industrially applicable invention. Inventions not considered to be a "method of surgery, therapy, or diagnosis of humans" and a "commercially inapplicable invention" include the following:

3.2.1 Types of methods not considered to be a "method of surgery, therapy or diagnosis of humans"

(1) Product such as medical device or medicine

A medical device or a medicine is a product, and is not considered to be a "method of surgery, therapy, or diagnosis of humans." A product combining them is also not considered to be a "method of surgery, therapy, or diagnosis of humans."

(2) Method for controlling the operation of a medical device (Note)

A method for controlling the operation of a medical device is not considered to be a "method of surgery, therapy, or diagnosis of humans" as long as the function of the medical device itself is represented as a method. The "method for controlling the operation of the medical device" here may include not only a method for controlling the internal operation of the medical device but also a functional or systematic operation provided to the medical device itself, such as the moving, opening, and/or closing of an incising means in accordance with an operating signal, the emission and/or receiving of a radioactive ray, an electromagnetic wave, a sound wave, or the like.

(Note) A method including any one of the following steps (i) or (ii) is not considered to be a "method for controlling the operation of a medical device."

(i) An action of a medical doctor (for example, a step where a medical doctor operates a device in order to provide medical treatment in accordance with a symptom)

(ii) A step with an influence on the human body by a device (for example, the incision or excision of a specific site of patient's body by a device or the irradiation of radiation, electromagnetic wave or sound wave by a device)

(3) Method for gathering various kinds of information from the human body by measuring structures and functions of organs in the human body

The methods indicated in (i) or (ii) below, which are intended to collect various types of data about a human body by measuring structures or functions of organs in the human body, is not considered to be a "method of diagnosis of humans".

- (i) Method of extracting samples and data from the human body, or methods of analyzing, e.g., comparing such samples and data with standards, by utilizing samples and data extracted from the human body (see the following Example 1 to Example 5).
- (ii) Preparatory treatment for measuring structures or functions of various organs of the human body (see the following case 6)

Except the case where it includes the step indicated in (a) or (b) below of judging for medical purposes.

- (a) Physical condition of a human body such as conditions of diseases and physical health or the mental condition of a human body
- (b) Prescription or treatment or surgery plans based on the conditions of (a)

Also, even if corresponding to such method, the methods that include steps corresponding to methods of surgery or therapy of humans are deemed to be "methods of surgery or therapy of humans."

(Examples of methods not considered to be a "method of surgery, therapy or diagnosis of humans")

Example 1: A method for an influenza test by extracting oral mucous membranes with a cotton bud

Example 2: A method for capturing the image of a lung by X-ray irradiation to the chest

Example 3: A method for measuring the body temperature by inserting an electronic ear thermometer into the external ear canal

Example 4: A method for judging the sugar level in urine by dipping a test strip in a collected urine sample, and comparing the color of the test strip with colors on a color chart

Example 5: A method of examining the susceptibility of the examinee to hypertension by

determining the type of base on the nth line of the base sequence of the X gene of the examinee and comparing the base with a standard in which when the base type is A the susceptibility is low, and when the type is G the susceptibility is high

Example 6: A method of preventing uneven smear of jelly for ultrasonography that is spread on the body

(4) Method for treating samples that have been extracted from the human body

A method for treating samples that have been extracted from the human body (e.g., blood, urine, skin, hair, cells, or tissue) or a method for gathering data by analyzing such samples such as the following (i) or (ii) is not considered to be a "method of surgery, therapy, or diagnosis of humans."

(i) Method for the presumption that the samples extracted from the human body are not to be returned to the same body

(ii) Method for the presumption that the samples extracted from the human body are to be returned to the same body such as any one of the followings (ii-1) to (ii-4):

(ii-1) A method for manufacturing a medicinal product (e.g., blood preparation, vaccine, genetically modified preparation and cell medicine) by utilizing raw material collected from a human body

(ii-2) A method for manufacturing a medical material (e.g., an artificial substitute or alternative for a part of the human body, such as an artificial bone, a cultured skin sheet, etc.) by utilizing raw material collected from a human body

(ii-3) A method of manufacturing an intermediate product for a medicinal product or a medical material (e.g. methods for differentiation and induction of the cells, methods for separation and purification of the cells) by utilizing raw material collected from a human body

(ii-4) A method of analyzing a medicinal product or a medical material, or an intermediate product thereof which is manufactured by utilizing raw material collected from a human body

3.2.2 Commercially inapplicable inventions

An invention concerning marketable or tradable subject matter is not considered to be "commercially inapplicable".

For example, a "method of waving hair" can be used for a commercial purpose in the beautician field while being personally used, is not considered to be an "invention applied only for personal use." indicated in 3.1.2 (i). Likewise, a "kit for scientific experiments," which is used in experiments at school, is not considered to be an "invention applicable only for academic or experimental purposes" indicated in 3.1.2 (ii), as it is marketable and tradable.

4. Procedure of Examination for Determining Eligibility for Patent and Industrially Applicability

(1) If the examiner determines that the claimed invention does not fulfill the requirements of the provision of Article 29(1) main paragraph based on the 2. and 3. , the reasons for refusal shall be notified.

The applicant can amend the claims by filing the amendments to be made to the claims and make an argument or clarification by filing the arguments against the notice of reasons for refusal stating that the claimed invention cannot be patentable since it does not satisfy the provision of Article 29(1) main paragraph.

When the examiner comes to be convinced that the claimed invention fulfills the requirements of the provision of Article 29(1) main paragraph by the amendments, argument or clarification, the reasons for refusal are overcome. Otherwise, the examiner shall notify a decision of refusal based on the reasons for refusal stating that the claimed invention cannot be patentable since it does not satisfy the provision of Article 29(1) main paragraph.

(2) The examiner shall explain the specific reasons in determining that the claimed invention cannot be patentable under the provision of Article 29(1) main paragraph in notifying the reasons for refusal or issuing the decision of refusal. It is not appropriate to state only "does not fulfill the requirements for eligibility for a patent," or "does not fulfill the requirements for industrial applicability" etc. since it is difficult for the applicant to make the effectual argument and understand the direction of an amendment for overcoming the reasons for refusal.

Chapter 2 Novelty and Inventive Step (Patent Act Article 29(1) and (2))

Section 1 Novelty

1. Overview

Patent Act Article 29(1) provides as the unpatentable cases (i) inventions that were publicly known, (ii) inventions that were publicly worked (iii) inventions that were described in a distributed publication or made available to the public through electric telecommunication lines in Japan or a foreign country prior to the filing of the patent application. The same paragraph provides that a patent shall not be granted for these publicly known (Note) inventions (inventions lacking novelty, hereinafter referred to as "prior art" in this chapter.).

The patent system is provided to grant an exclusive right to the patentee in exchange for disclosure of the invention. Therefore, the invention which deserves the patent should be novel. This paragraph is provided to achieve such a purpose.

This Section describes the determination of novelty for an invention of the patent applications to be examined (hereinafter referred to as "the present application" in this Section.)

(Notes) The term "publicly known" generally falls under Article 29(1)(i), or under the 29(1)(i) to (iii), hereinafter the latter is applied.

2. Determination of Novelty

Inventions subject to determination of novelty are claimed inventions.

The examiner determines whether the claimed invention has novelty by comparing the claimed inventions and the prior art cited for determining novelty and an inventive step (the cited prior art) to identify the differences between them. Where there is a difference, the examiner determines that the claimed invention has novelty. Where there is no difference, the examiner determines that the claimed invention lacks novelty.

Where there are two or more claims, the examiner determines the existence of novelty for each claim.

Section 2 Inventive Step

1. Overview

Article 29(2) provides that a patent shall not be granted for an invention (an invention lacking an inventive step) where a person ordinarily skilled in the art of the invention (hereinafter referred to as "a person skilled in the art" in this Part) would have been easily able to make the invention based on the prior art.

That is because granting patent rights for inventions which a person skilled in the art would have been easily able to make does not promote the progress of the technology but rather prevents it.

This Section describes the determination of an inventive step for an invention for which a patent is sought, that is, how to determine whether a person skilled in the art would have been easily able to make the invention.

2. Basic Idea of Determination of Inventive Step

Inventions subject to determination of an inventive step are claimed inventions.

The examiner determines whether the claimed invention involves an inventive step by considering whether or not it could be reasoned that a person skilled in the art easily arrives at the claimed invention based on the prior art.

Whether or not a person skilled in the art easily arrives at the claimed invention should be determined by assessing comprehensively various facts in support of the existence or non-existence of an inventive step. The examiner attempts the reasoning by assessing these facts legally.

In this Part, "a person skilled in the art" means a hypothetical person who meets all the following conditions (i) to (iv). In some cases, it is appropriate to consider a person skilled in the art to be a "team of experts" in several technical fields rather than an individual person.

- (i) A person who has the common general knowledge (Note 1) in the technical field of the claimed invention at the time of filing.
- (ii) A person who is able to use ordinary technical means for research and development (including document analysis, experiment, technical analysis,

manufacture, etc.).

- (iii) A person who is able to exercise ordinary creativity in selecting materials and modifying designs.
- (iv) A person who is able to comprehend all the matter in the state of the art (Note 2) in the technical field of the claimed invention at the time of filing, and comprehend all technical matters in the field relevant to problems to be solved by the invention.

The examiner should precisely understand the state of the art in technical field of the claimed invention at the time of filing in attempting the reasoning. The examiner attempts the reasoning by certainly considering what would be done by a person skilled in the art who does not have the knowledge for the claimed invention at the time of filing but comprehends all the matter in the state of the art.

(Note 1) "Common general knowledge" refers to matter clear from technique generally known to a person skilled in the art (including well-known art and commonly used art) or empirical rules. Therefore, the common general knowledge includes methods of experimentation, analysis and manufacture; theories of a technology, etc., as far as they are generally known to a person skilled in the art. Whether a certain technical matter is generally known to a person skilled in the art should be determined based upon not only how many documents show the technical matter but also how much attention has been given to the technical matter by such a person.

"Well-known art" refers to technical matter generally known in the relevant technical field. For example, it includes the following items.

- (i) Technical matter which is shown in many prior art documents (see 3.1.1 in "Section 3 Procedure of Determining Novelty and Inventive Step") or webpages (see 3.1.2 in "Section 3 Procedure of Determining Novelty and Inventive Step") etc. (hereinafter referred to as "prior art documents, etc." in this Chapter)
 - (ii) Technical matter which is widely known throughout the industry
 - (iii) Technical matter which is well-known to the extent that it is needless to present examples
- "Commonly used art" refers to well-known art which is used widely.

(Note 2) "State of the art" includes not only the prior art but also common general knowledge and other technical knowledge (technical findings etc.).

3. Detail of Determination of Inventive Step

The examiner selects the prior art most suitable for the reasoning (hereinafter referred to as "the primary prior art" in this Chapter), and determine whether it is possible to reason that a person skilled in the art would easily arrive at the claimed invention from the primary prior art by following the steps (1) to (4). The examiner should not regard the combination of two or more independent pieces of prior art as the primary prior art.

Where there are two or more claims, the examiner should determine the existence of an inventive step for each claim.

(1) The examiner determines whether or not the reasoning is possible based on the various factors in support of the non-existence of an inventive step (see 3.1) for the differences between the claimed invention and the primary prior art by adopting other pieces of prior art (hereinafter referred to as "secondary prior art" in this Chapter) or considering the common general knowledge.

(2) If the examiner determines that the reasoning is impossible based on the above step (1), the examiner determines that the claimed invention involves an inventive step.

(3) If the examiner determines that the reasoning is possible based on the above step (1), the examiner determines whether the reasoning is possible by comprehensively assessing various factors which includes factors in support of the existence of an inventive step (see 3.2).

(4) If the examiner determines that the reasoning is impossible based on the above step (3), the examiner determines that the claimed invention involves an inventive step.

If the examiner determines that the reasoning is possible based on the above step (3), the examiner determines that the claimed invention does not involve an inventive step.

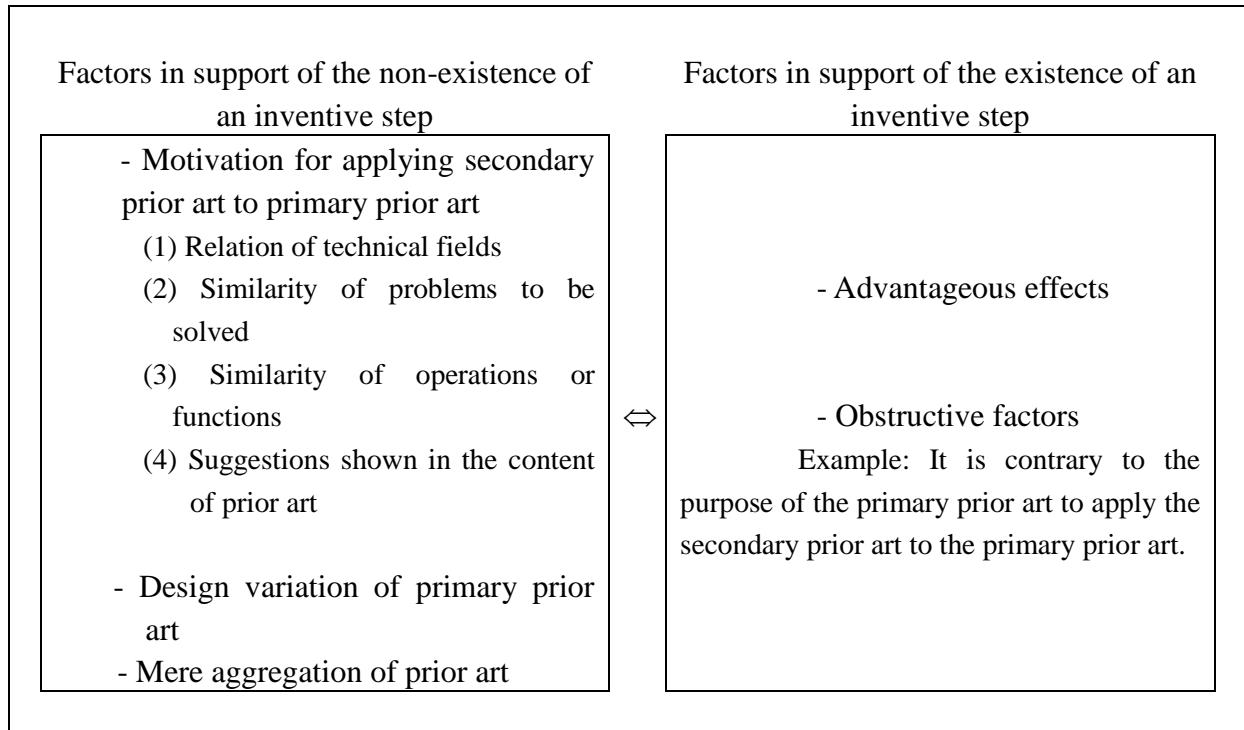


Figure: Main factors for reasoning

For example, the reasoning fails in the above step (2) if no secondary prior art corresponds to the differences between the claimed invention and the primary prior art, nor the differences are a design variation.

On the other hand, the reasoning is achieved in the second sentence of the above step (4) if there is a piece of secondary prior art corresponding to the differences between the claimed invention and the primary prior art, there is a motivation for applying the secondary prior art to the primary prior art (one of the factors for reasoning, see the above figure), and there is no factor in support of the existence of an inventive step.

3.1 Factor in support of the non-existence of an inventive step

3.1.1 Motivation for applying secondary prior art to primary prior art

If the secondary prior art (B) is applied to the primary prior art (A) and then the resultant (A+B) is equivalent to the claimed invention (Note 1), the motivation to attempt this application is a factor in support of the non-existence of an inventive step.

It is determined whether or not there is motivation for applying the secondary prior art to the primary prior art by comprehensively considering the following points of

view (1) to (4). The examiner should note that it is not always possible to determine whether there is motivation by paying attention to only one of these points of view (1) to (4).

- (1) Relation of technical fields
- (2) Similarity of problems to be solved
- (3) Similarity of operations or functions
- (4) Suggestions shown in the content of prior art

(Note 1) The design variation etc. (see 3.1.2(1)) which is the exercise of the ordinary creativity of a person skilled in the art should also be considered in applying the secondary prior art to the primary prior art. Therefore, the case includes the application of the secondary prior art to the primary prior art with design variation to arrive at the claimed invention.

(1) Relation of technical fields

It is regarded as the exercise of the ordinary creativity of a person skilled in the art that he/she attempts to apply to the primary prior art any technical means of the technical field related to the primary prior art in order to solve the problems in the primary prior art. For example, the presence of a technical means that would be replaced in or be added to the prior art in the technical fields related to the primary prior art could be grounds for determining that there is motivation for a person skilled in the art to derive the claimed invention by applying that means.

In determining the presence of the motivation for applying the secondary prior art to the primary prior art, with respect to the "relation of technical fields", the examiner should also consider another point among the points of view (1) to (4) for motivation.

However, in the case where the understanding of "technical field" (Note 2) involves consideration of the points of view for problems to be solved, operations and functions as well as the point of view for products to which the prior art is applied, the determination based on the "relation of technical fields" also involves the consideration of "similarity of problems to be solved" and the "similarity of operations or functions". In this case, if it is found that there is a motivation based on the "relation of technical fields" without considering the other points of view for motivation, it is not necessary to consider the "similarity of problems to be solved" and the "similarity of operations or functions" for determination whether or not motivation involves.

(Note 2) The technical field is to be understood by paying attention to the applied products etc., and the principle and mechanism, and operations and functions.

Example 1:

[Claim]

A telephone apparatus which sorts records in an address book according to communication frequencies

[Primary prior art]

A telephone apparatus which sorts records in an address book according to levels of importance set by a user

[Secondary prior art]

A facsimile apparatus which sorts records in an address book according to communication frequencies

(Explanation)

The apparatus of the primary prior art and the apparatus of the secondary prior art share a feature of an apparatus comprising an address book. Their technical fields are mutually related from this viewpoint.

Moreover, if it was determined that they share the feature which makes a user's call operation easy, the relation between the two technical fields would be considered as well as the point of view for the problems to be solved, and operations and functions.

(2) Similarity of problems to be solved

The similarity of the problems to be solved between the primary prior art and the secondary prior art can be a ground for determining that there is motivation for a person skilled in the art to derive the claimed invention by applying the secondary prior art to the primary prior art.

The similarity of problems to be solved can be recognized where there is similarity of the problems obvious to or easily conceived by a person skilled in the art at the time of filing between the primary prior art and the secondary prior art. The examiner determines whether the problems to be solved by the primary prior art and the secondary prior art are obvious or easily conceived based on the state of the art at the time of filing.

The examiner can also attempt the reasoning by a thinking process different from the claimed invention, based on the primary prior art which solves a problem

different from the claimed invention. Same applies to a claimed invention of which the problem to be solved cannot be recognized, such as an invention obtained through trial and error.

Example 2:

[Claim]

A plastic bottle for which a hard carbon film is formed on a surface

[Primary prior art]

A plastic bottle for which a silicon oxide film is formed on a surface

(The publication disclosing the primary prior art discloses that the silicon oxide film enhances gas barrier properties.)

[Secondary prior art]

A sealed vessel for which a hard carbon film is formed on a surface

(The publication disclosing the secondary prior art discloses that the hard carbon film enhances gas barrier properties.)

(Explanation)

There is similarity of the problems to be solved between the primary prior art and the secondary prior art with focusing on the film coating for enhancing gas barrier properties.

Example 3:

[Claim]

A pair of cooking scissors having a cap opener in a handle portion thereof

[Primary prior art]

A pair of cooking scissors having a shell cracker in a handle portion thereof

[Secondary prior art]

A petit knife having a cap opener in a handle portion thereof

(Explanation)

Providing multifunctionality to a cooking utensil such as a pair of cooking scissors or a knife is an obvious problem to be solved in the field of the cooking utensil, and there is similarity of the problems to be solved between the primary prior art and the secondary prior art.

(3) Similarity of operations or functions

The similarity of the operations or functions between the primary prior art and the secondary prior art can be a ground for determining that there is motivation for a person skilled in the art to derive the claimed invention by applying the secondary prior

art to the primary prior art or associating the secondary prior art with the primary prior art.

Example 4:

[Claim]

A printing machine which cleanses a blanket cylinder by swelling a swelling member to contact a cleansing sheet

[Primary prior art]

A printing machine which cleanses a blanket cylinder by using a cam structure to contact a cleansing sheet

[Secondary prior art]

A printing machine which cleanses an intaglio cylinder by swelling a swelling member to contact a cleansing sheet

(Explanation)

There is similarity of the operations between the primary prior art and the secondary prior art with focusing on that the cam structure of the primary prior art and the swelling member of the secondary prior art are provided to make the cleansing sheet contact and separate from the cylinder of the printing machine.

(4) Suggestions shown in the content of prior art

The suggestion shown in the content of prior art for applying the secondary prior art to the primary prior art is a strong evidence for motivation for a person skilled in the art to derive the claimed invention by applying the secondary prior art to the primary prior art.

Example 5:

[Claim]

A transparent film comprising an ethylene/vinyl acetate copolymer and an acid-acceptor particle dispersed in the copolymer, wherein the copolymer is cross-linked by a cross-linking agent

[Primary prior art]

A transparent film comprising an ethylene/vinyl acetate copolymer and an acid-acceptor particle dispersed in the copolymer

(The publication disclosing the primary prior art mentions that ethylene/vinyl acetate copolymer is used as a member in contact with the components of the solar battery.)

[Secondary prior art]

A transparent film for use in a sealing film for a solar battery comprising an ethylene/vinyl acetate copolymer, wherein the copolymer is cross-linked by a cross-linking agent

(Explanation)

The publication disclosing the primary prior art suggests that the technique of the transparent film used as the sealing film for a solar battery is to be applied to the primary prior art.

3.1.2 Factor in support of the non-existence of an inventive step other than motivation

(1) Design variation etc.

If a person skilled in the art would arrive at the claimed elements that correspond to the differences between the claimed invention and the primary prior art by the following items (i) to (iv) (hereinafter referred to as "design variation etc." in this Chapter) starting from the primary prior art, there is a factor in support of the non-existence of an inventive step. Moreover, suggestion in the primary prior art for the design variation etc. is an effective factor in support of the non-existence of an inventive step.

- (i) Selection of optimum materials from publicly known materials to solve certain problems (Example 1)
- (ii) Optimally or preferably modified numerical ranges to solve certain problems (Example 2)
- (iii) Materials replaced by equivalents to solve certain problems (Example 3)
- (iv) Design variation or design choice associated with an application of specific techniques to solve certain problems (Examples 4, 5)

This is because they are merely regarded to be art derived from the ordinary creativity of a person skilled in the art.

Example 1:

Adopting a well-known water reaction adhesive material as an adhesive material of an outer surface of a skin side with a ball side in a ball for a ball game in place of an adhesive material for pressured adhesion is regarded to be merely a selection of optimum materials from publicly known materials.

Example 2:

In unhardened concrete, reducing the contained amount of particles measuring 75

micrometers or less to 1.5 percent by mass or less, that deteriorate flow property, is regarded to be merely an optimal or preferable modification of numerical ranges by a person skilled in the art.

Example 3:

Adopting a well-known brushless DC motor in place of a DC motor with a brush as a driving means of a bathroom drying apparatus characterized by a means for sensing temperature is regarded merely as replacement by equivalents.

Example 4:

In connecting an output terminal of a mobile phone to a digital television set as an external display device and displaying an image on the digital television set, generating and outputting an image signal (digital displaying signal) adapted to a display size and image resolution of the digital television set is merely a selection of a suitable method according to a type and performance of the external display device, and is regarded to be a design variation chosen by a person skilled in the art as appropriate.

Example 5:

In a system for providing accommodation facility information to a consumer in response to information input from a consumer terminal, it is a design variation chosen as appropriate by a person skilled in the art to adopt a list of foods and drinks as alternatives input from the consumer terminal and age of accommodation facility as the accommodation facility information provided.

(2) Mere aggregation of prior art

Mere aggregation of prior art means that each of the claimed elements is well-known and their functions and operations are not related to each other. The claimed invention is determined to be made by the exercise of the ordinary creativity of a person skilled in the art where it is a mere aggregation of prior art. Mere aggregation of prior art is a factor in support of the non-existence of an inventive step. Moreover, the implication for aggregation of prior art in the primary prior art is an effective factor in support of the non-existence of an inventive step.

Example 6:

It is mere aggregation of prior art to attach a well-known windbreak cover member and a well-known tool storage means to a gondola apparatus for working at an outward walls of a

building comprising a well-known lift means A.

3.2 Factor in support of the existence of an inventive step

3.2.1 Advantageous effects

Advantageous effects over the prior art are factors in support of the existence of an inventive step. Where the examiner understands such effects based on the description, claims and drawings, the examiner should take them into consideration as factors in support of the existence of an inventive step. Advantageous effects mean effects which are given by the claimed invention and advantageous over the prior art (particular effects).

(1) Consideration of advantageous effects over the prior art

Where the claimed invention has advantageous effects over the prior art, the examiner should take them into consideration and attempt the reasoning that a person skilled in the art would have easily arrived at the claimed invention. The inventive step of the claimed invention is denied regardless of the existence of the advantageous effects where it is sufficiently reasoned that a person skilled in the art would have easily arrived at the claimed invention.

However, where the advantageous effects over the prior art satisfies the following condition (i) or (ii) and exceeds what is predictable based on the state of the art, they should be considered as factors in support of the existence of an inventive step.

- (i) The claimed invention has an effect different from that of the prior art and a person skilled in the art is not able to expect the effect of the claimed invention on the basis of the state of the art at the time of filing.
- (ii) The claimed invention has an effect of the same nature but significantly superior to that of the prior art and a person skilled in the art is not able to expect the effect of the claimed invention on the basis of the state of the art at the time of filing.

Especially for claimed inventions that belong to a technical field where it is difficult to expect the effect based on the structures of the products such as a selection invention (see 7 in “Section 4 Claims Including Specific Expressions”), the advantageous effects over the prior art are an important factor for determining the existence of an inventive step.

Example:

The claimed invention relates to motilin which has a specific amino acid sequence, shows six to nine times more active than the motilin of the prior art, and has advantageous effects in increasing intestinal motility. Where such effects exceeds what is predictable based on the state of the art at the time of filing, these effects are factors in support of the existence of an inventive step.

(2) Consideration of effects stated in written opinion

In the following case (i) or (ii), the examiner should consider the advantageous effects over the prior art argued and proved in the written opinion (e.g. experimental results), etc.

- (i) Case where these effects are stated in the description
- (ii) Case where these effects are not stated in the description, but can be speculated by a person skilled in the art from the description or drawings

However, the examiner should not take these effects into consideration where these effects are not stated in the description and cannot be speculated by a person skilled in the art from the description or drawings.

3.2.2 Obstructive factor

(1) The factor which obstructs application of the secondary prior art to the primary prior art (obstructive factor) supports the existence of an inventive step. However, if it is sufficiently reasoned that a person skilled in the art would easily conceive the claimed invention after considering the obstructive factor, the claimed invention does not involve an inventive step.

Examples of obstructive factor are the following.

- (i) The secondary prior art applied to the primary prior art cannot achieve the purpose of the primary prior art. (Example 1)
- (ii) The secondary prior art applied to the primary prior art cannot adequately function. (Example 2)
- (iii) The secondary prior art which is considered to be excluded from application and unable to be adopted by the primary prior art. (Example 3)
- (iv) The secondary prior art which a person skilled in the art would not apply due to a publication disclosing that the secondary prior art is inferior to the other embodiment in respect of operations and effects of the prior art. (Example 4)

Example 1:

[Primary prior art]

A method for sterilization treatment of tap water by ozone, comprising the steps of: divericating a water flow into a main flow and sub flow, introducing tap water from the sub flow to an anode, and producing directly ozone water by electrolyzing.

(The publication disclosing the primary prior art discloses that the purpose of the primary prior art is to avoid using an expensive apparatus for mixing gas and liquid (gas-liquid contact apparatus).)

[Secondary prior art]

A method for producing ozone water, comprising the steps of: electrolyzing pure water to generate ozone-containing gas in an anode chamber of an electrolysis tank, extracting the gas from the electrolysis tank to separate the gas from anode solution, and injecting the separated ozone-containing gas to water to be treated

(Explanation)

Using an expensive apparatus for mixing gas and liquid (gas-liquid contact apparatus) is contrary to the purpose of the primary prior art. Therefore, there is a factor teaching away from extracting the ozone-containing gas from the anode solution and injecting and dissolving it in the sub flow or main flow by adopting the secondary prior art in the primary prior art.

Example 2:

[Primary prior art]

A vane pump having a predetermined structure

[Secondary prior art]

A gasket having a predetermined form

(Explanation)

There is a factor teaching away from applying the secondary prior art to the primary prior art where the vane pump does not adequately function due to a gap by using the gasket of the secondary prior art for sealing the vane pump of the primary prior art.

Example 3:

[Primary prior art]

A thermostatic expansion valve adopting a method for joining a resin valve body having a pathway through which a liquid refrigerant passes and a pathway through which a gas phase refrigerant passes, and a control mechanism by caulking and fixing them

(The publication disclosing the primary prior art describes as a problem to be solved of the prior art that forming an external screw for screw fastening is expensive, an adhesive agent is

required for attachment and the attachment is laborious, and also describes a caulking and fixing method as a solution.)

[Secondary prior art]

A pressure control valve adopting a screw-fastening method using a screw joint for fixing two members

(Explanation)

The primary prior art excludes positively the screw-fastening method using the screw joint, and there is a factor teaching away from applying to the primary prior art the screw-fastening method using the screw joint disclosed in the secondary prior art.

Example 4:

[Primary prior art]

A method for driving a synthetic fiber in the process of false twisting in a thread passage guide and heating it with one non-contact heating device

(The publication disclosing the primary prior art describes decreasing dyeing spots as a purpose.)

[Secondary prior art]

A method for heating the synthetic fiber in the process of false twisting with a plurality of non-contact heating devices (The publication disclosing the secondary prior art describes several embodiments and the fact that the embodiment which operates all non-contact heating devices at temperature a is likely to generate dyeing spots compared to the other embodiments.

(Explanation)

The embodiment of the secondary prior art is shown as an inferior example in terms of decreasing dyeing spots which is the purpose of the primary prior art. Therefore, there is a factor teaching away from operating the non-contact heating device of the primary prior art at temperature a by applying the secondary prior art to the primary prior art.

(2) A piece of prior art is inappropriate for citation where the publication which discloses the prior art provides the descriptions that obstruct a person skilled in the art from easily arriving at the claimed inventions. Therefore, there is an obstructive factor for reasoning where the primary prior art or the secondary prior art is inappropriate. However, even if the prior art documents etc. provide the descriptions that obstruct a person skilled in the art from easily arriving at the claimed inventions at first glance, the prior art is appropriate as cited prior art where there is a sufficient factor in support of the non-existence of an inventive step and the reasoning.

3.3 Notes for determining an inventive step

(1) The examiner should take note of the avoidance of hindsight such as the following case (i) or (ii) due to determining an inventive step after acquiring knowledge of the claimed inventions.

- (i) The examiner assumes that a person skilled in the art would have easily arrived at the claimed invention.
- (ii) The examiner understands that a cited invention is approximate to the claimed invention (see 3.3 in “Section 3 Procedure of Determining Novelty and Inventive Step”).

(2) The examiner selects generally the primary prior art which is same as or close to the claimed invention from the aspect of technical field or problem to be solved (Note 1).

The primary prior art of which technical field or problem to be solved is considerably different from that of the claimed invention is likely to make the reasoning difficult. In this case, it should be noted that it is required to reason more deliberately whether or not a person skilled in the art would arrive at the claimed invention starting from the primary prior art (e.g. considering whether or not there is a sufficient factor for motivating to apply the secondary prior art to the primary prior art).

(Note 1) Problems to be solved obvious to or easily arrived by a person skilled in the art are included.

It should be considered whether or not the problems to be solved are considerably different between the claimed inventions and the primary prior art. The problems to be solved by the primary prior art and the secondary prior art are not necessarily the same as the problems to be solved discussed in 3.1.1(2) (the problems to be solved which is considered in terms of a similarity between the primary prior art and the secondary prior art).

Moreover, where the problem to be solved of the claimed inventions is novel and inconceivable by a person skilled in the art, the claimed invention is usually completely different from the primary prior art in terms of the problems to be solved. Therefore, the fact that the problem to be solved is novel and inconceivable by a person skilled in the art may be a factor in support of the existence of an inventive step.

(3) The examiner should not omit to consider the reasoning (considering whether or not there is a factor teaching away from applying the well-known art) only because the cited

prior art as the ground of the reasoning or design modification is well-known.

(4) Where the applicant admits that a technique stated in the description is prior art at the time of filing, the examiner may consider such technique as a part of the state of the art at the time of filing.

(5) In principle, an invention of a process for manufacturing a product and use of a product involve an inventive step where the invention of the product involves an inventive step (Note 2).

(Note 2) The exception is a method of manufacturing a product where an invention related to the product per se is a use invention (see 3.1.2 in “Section 4 Claims Including Specific Expressions”).

(6) The examiner may consider commercial success and the fact that the invention had been desired to achieve for a long time as a secondary consideration for supporting the existence of an inventive step only if the examiner is convinced that these facts are not derived from other factors such as sales promotion techniques or advertisements but from the technical features of the claimed inventions on the basis of the applicant's arguments and evidences.

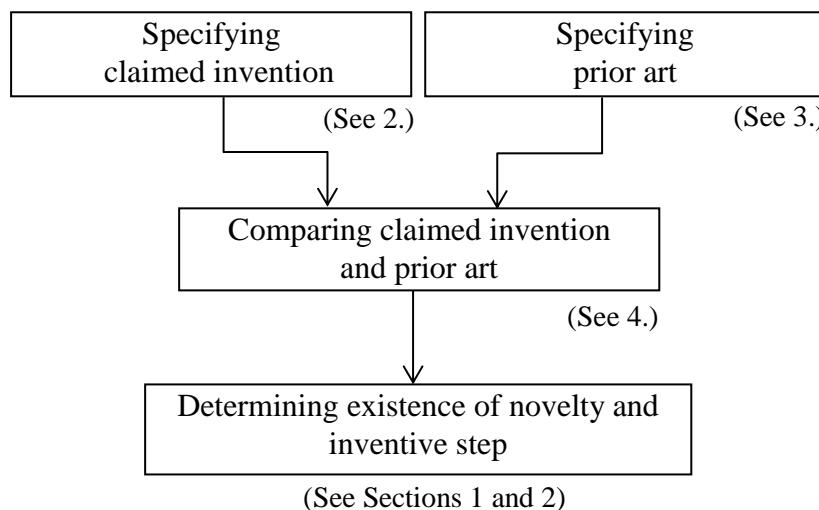
Note: When any ambiguity of interpretation is found in this provisional translation, the Japanese text shall prevail.

Part III Chapter 2 Section 3 Procedure of Determining Novelty and Inventive Step

Section 3 Procedure of Determining Novelty and Inventive Step

1. Overview

The examiner specifies the claimed invention and the prior art, and then compare both in determining novelty and an inventive step. As a result of the comparison, the examiner determines that the claimed invention lacks novelty where there is no difference (Section 1). He/she determines whether there is an inventive step where there is a difference (Section 2).



2. Specifying Claimed Invention

The examiner specifies the claimed inventions based on the claims. The examiner takes the description, drawings and the common general knowledge at the time of filing into consideration in interpreting the meanings of words in the claims.

Even if an invention identified by the claims does not correspond to the invention described in the description or drawings, the examiner should not ignore the claims and specify the claimed invention which is subject to examination based only on the description or drawings. The examiner specifies the claimed invention without considering the technical matters or terms which are not described in claims but in the description or drawings. On the other hand, the examiner should always consider the matters or terms described in the claims and should not ignore them.

(Reference) Judgment of the Second Petty Bench of the Supreme Court (March 8, 1991, 1988(Gyo-Tsu) No. 3, Minshu vol. 3 No. 45 Page 123) "Method for measuring triglyceride" ("Lipase Case")

2.1 The case where the claims are clear

In this case, the examiner should specify the claimed invention as is written in the claim. The examiner also interprets terms in the claim based on their usual meanings.

However, where meanings of the terms described in the claims are defined or explained in the description or drawings, the examiner takes the definition and explanation into consideration to interpret the terms. In addition, examples of more specific concepts included in the concepts of the terms in the claims, which are merely shown in the description or drawings, are not the definition or explanation mentioned above.

2.2 The case where the claims appear to be unclear and incomprehensible

In this case, where the claims are clear by interpreting the terms in the claims based on the description, drawings and common general knowledge at the time of filing, the examiner takes them into consideration.

2.3 The case where the claims are unclear even if description, drawings and common general knowledge at the time of filing are taken into consideration

In this case, the examiner does not specify the claimed inventions. Such claimed inventions may be excluded from the prior art search (see 2.3 in "Part I Chapter 2 Section 2 Prior Art Search and Determination of Novelty, Inventive Step, etc.").

3. Specifying Prior Art

The examiner specifies the prior art based on evidence for the prior art.

3.1 Prior art

The prior art falls into any one of the cases 3.1.1 to 3.1.4 prior to the filing of

the application in Japan or foreign countries. It is determined whether or not it is prior to the filing of the application in units of hours, minutes and seconds. Where it is publicly known in a foreign country, it is determined based on Japan time translated from the foreign country's time.

3.1.1 Prior art disclosed in a distributed publication (Article 29(1)(iii))

"Prior art disclosed in a distributed publication means prior art described in the publications (Note 2) which anyone can read (Note 1).

(Note 1) The fact that someone actually accessed such publications is not necessary.

(Note 2) "Publications" include documents, drawings or other similar information media which are duplicated to distribute and disclose the contents to the public.

(1) Prior art disclosed in publications

a "Prior art disclosed in publications" mean prior art recognized on the basis of the descriptions in the publications or equivalents of such descriptions. The examiner specifies prior art recognized on the basis of the descriptions as the prior art described in publications. Equivalents of descriptions in the publications mean descriptions that a person skilled in the art could derive from the description in the publications by considering the common general knowledge at the time of filing.

The examiner should not cite what is neither a disclosure of the publications nor the equivalent of the disclosure of the publications because such a matter is not "prior art disclosed in publications."

b The examiner should not cite a disclosure that a person skilled in the art is able to recognize based on the descriptions in publications or equivalents to such descriptions as "prior art" where it falls into the following case (i) or (ii).

(i) Where it is not clear that a person skilled in the art is able to manufacture a product of the prior art based on the descriptions of the publications and the common general knowledge at the time of filing

(ii) Where it is not clear that a person skilled in the art is able to use the process of the prior art based on the descriptions of the publications and the common general knowledge at the time of filing

(2) Determining publication date

a Estimated publication date

Whether or not a publication date is indicated in the publication		Estimated publication date
Indicated	Where only a publication year is indicated	The last day of the year
	Where publication month and year are indicated	The last day of the month of the year
	Where publication day, month and year are indicated	The day, month and year
Not indicated	Where the date received in Japan is indicated in a foreign publication	The date which is several days before the date received in Japan by considering the period normally taken for shipping the publications from abroad to Japan
	Where there is a related publication which includes book review, excerpts or catalogs of the publication	The publication date estimated from the date of the related publication
	Where a reprinted publication indicates the initial print date	The indicated initial print date
	Where there is relevant information	The date estimated from the relevant information

(Note) If there is relevant information in addition to the publication date indicated in the publication, the examiner can use the publication date estimated from the relevant information.

b The case where a filing date and a publication date are the same date

Where a filing date and a publication date are the same date, the examiner should not deem the publication to be prior to the filing unless the publication is obviously before the filing.

3.1.2 Prior art made publicly available through an electric telecommunication line
(Article 29(1)(iii))

"Prior art made publicly available through an electric telecommunication line" means prior art published in webpages etc. (Note 3) which can be read by anyone

(Note 2) through an electric telecommunication line (Note 1).

(Note 1) A "line" means a two-way transmission line constituted by sending and receiving channels generally. Broadcasting, which is only capable of one-way transmission, does not fall under the "line." Cable TV etc. that is capable of two-way transmission falls under the "line."

(Note 2) The fact that someone has actually accessed the webpages etc. is not necessary. More specifically, the webpages etc. are publicly available (in other words, anyone can read the webpages etc.) where both of the following cases (i) and (ii) are satisfied.

- (i) Where a webpage can be reached through a link from another publicly known webpage, a webpage is registered with a search engine, or the address (URL) of a webpage appears in the mass media (e.g., a widely-known newspaper or magazine) on the Internet.
- (ii) Where public access to the webpage is not restricted.

(Note 3) "Webpages etc." means what provides information on the Internet etc. "Internet etc." means all means that provide information through electric telecommunication lines, including the Internet, commercial databases, and mailing lists.

(1) Prior art published in webpages etc.

"Prior art published in webpages etc." means prior art published in webpages etc. and prior art recognized from equivalents of such a publication.

The examiner specifies prior art published in webpages etc. according to the descriptions in 3.1.1. However, the examiner should not cite the content of the webpages etc. unless it was made available to the public as it is at the time of the publication.

The examiner determines whether or not webpages etc. are publicly available prior to the filing of the application based on the publication date indicated in the webpages etc. (Note 4).

(Note 4) Where the publication date is not indicate or only the publication year or month is indicated and thus it is unclear whether the publication date is prior to the filing of the application, the examiner can cite such information if he/she obtains a certificate on the publication date from a person with authority and responsibility for the publication, maintenance etc. of the published information and the publication date is prior to the filing of the application.

- (2) Counterargument by an applicant on the date and content of publication (whether or not the information on the webpages etc. is published as it is at the publication date)
- a The case where an applicant counter-argues that the indicated date and content of publication are unreliable just because the information disclosed on a webpage, and the counterargument is not supported by evidence.

In this case, the examiner rejects the counterargument due to lack of concrete evidence.

- b The case where an applicant's counterargument based on concrete evidence raises a doubt about the date or content of publication

The examiner checks with a person with the authority and responsibility for the publication, maintenance, etc. of the published information, and request him/her to issue a certificate on the date or content of publication on the webpages etc.

Where the doubt remains as a result of examining the counterargument etc. by the applicant, the examiner should not cite the prior art published on the webpages etc.

3.1.3 Publicly known prior art (Article 29(1)(i))

"Publicly known prior art" means prior art which has become known to anyone as an art without an obligation of secrecy (Note).

(Note) Prior art disclosed by a person on whom obligation of secrecy is imposed to another person who are not aware of its secrecy is "publicly known prior art" irrespective of the inventor's or applicant's intent to keep it secret.

Generally, an article of academic journal would not be put in public view even if it was just received. Therefore, prior art described in the article is not "publicly known prior art" until the article is published.

"Publicly known prior art" often become known in lecture, briefing session and so on generally. In this case, the examiner specifies the prior art on the basis of the matters explained in the lecture, briefing session and so on.

In interpreting the explained matters, the examiner may use the matters derived by a person skilled in the art as a base for specifying "publicly known prior art" by considering the common general knowledge at the time of the lecture, briefing session and so on.

3.1.4 Publicly worked prior art (Article 29(1)(ii))

"Publicly worked prior art" means prior art which has been worked in a situation where the prior art is or could be publicly known (Note).

(Note) Prior art that also become publicly known by working of the prior art also falls into "publicly known prior art" under Article 29(1)(i).

"Publicly worked prior art" is often worked by using machinery, device, system etc. generally. In this case, the examiner specifies the prior art based on how the machinery, device, system etc. operate.

In interpreting the fact that the machinery, device, system etc. operate, the examiner may use the matters derived by a person skilled in the art as a base for specifying "inventions that were publicly worked" by considering the common general knowledge at the time when the inventions were publicly worked.

3.2 Prior art disclosed as generic concepts or more specific concepts in an evidence

(1) The case where the evidence discloses prior art as generic concepts (Note 1)

In this case, the examiner should not specify the prior art as more specific concepts because the prior art as more specific concepts is not disclosed. However, the examiner may specify the prior art as more specific concepts where they are derived on the basis of the common general knowledge (Note 2).

(Note 1) The term "generic concept" means a comprehensive concept consisting of ideas belonging to the same family or type, or integrating a plurality of ideas sharing a common nature.

(Note 2) A prior art as a more specific concept is not considered to be derived from (disclosed in) a generic concept just because the more specific concept is merely included in the generic concept or the more specific concept could be picked up from the generic concept.

(2) The case where an evidence discloses prior art as more specific concepts

In this case, when the evidence disclosing the prior art describes prior art utilizing the same family or type of matters or common features as elements of the prior

art, the examiner may specify the prior art as the generic concepts. As a method for determining novelty, the examiner may determine the existence of novelty of the claimed inventions which is described as generic concepts without specifying the prior art as generic concepts (see 4. and 5.1, especially see 4.2)

3.3 Points to note

The examiner should take note of the avoidance of hindsight which brings about a misunderstanding of the evidence which discloses the prior art according to the contexts of the description, claims or drawings of the application subject to the examination after obtaining knowledge of the claimed inventions. The prior art should be understood based on the evidence disclosing the prior art (for publications, along the contexts of the publications).

4. Comparison between Claimed Invention and Prior Art

4.1 General methods of comparison

The examiner compares the claimed invention and the prior art which he/she has specified. Comparison between the claimed invention and the prior art is conducted by determining identical features and differences between the claimed elements and the elements which specifies the prior art (hereinafter referred to as "elements of the prior art" in this Chapter). The examiner should not compare a combination of two or more independent pieces of prior art with the claimed invention.

4.1.1 The case where the claim includes alternatives

The examiner may choose one of the alternatives (Note 1) as a claimed element, and compare the claimed invention and the prior art (Note 2).

(Note 1) "Alternatives" means both formal alternatives and substantial alternatives.

"Formal alternatives" means a description of the claim which is understood obviously as alternatives.

"Substantial alternatives" means a comprehensive expression which is intended to include a limited number of more specific matters substantially.

(Note 2) In order to determine whether the claimed invention has novelty and involves an inventive step, the examiner need to determine on all of the matters in the inventions identified based on the claim. Therefore, it should be noted that the determination on novelty and an inventive step of the claimed invention cannot be always achieved by partially comparing the claimed invention and the prior art.

4.2 Methods for comparing more specific concept of claimed invention with prior art

The examiner may compare a more specific concept of the claimed invention and the prior art and determine identical features and differences between them (Note).

The more specific concept of the claimed invention includes such as a mode for carrying out the claimed invention which is described in the description or drawings. Other than such a mode can be a subject of the comparison, so long as that is a more specific concept of the claimed invention.

This method of comparison is effective in determining novelty in the following claims, for example.

- (i) a claim including a description of functions or features specifying a product
- (ii) a claim including a description of numerical range

(Note) See 4.1.1 (Note 2)

4.3 Methods for considering the common general knowledge at the time of filing in comparing the prior art and the claimed invention

The examiner may consider the common general knowledge at the time of filing to interpret the description of the prior art documents when he/she compares the prior art and the claimed invention to specify identical features and differences between them. The results obtained by this method and the methods as mentioned above must be same.

5. Determination on Novelty and Inventive Step, and Procedure of Examination Pertaining to the Determination

5.1 Determination

The examiner determines whether the claimed invention is novel (see “Section 1 Novelty”) and involves an inventive step (see “Section 2 Inventive Step”) by comparing the claimed invention with the prior art.

5.1.1 Claimed elements including alternatives

The examiner determines that the claimed invention is not novel, in a case where there is no difference between the claimed invention in which an alternative is chosen as an element and the prior art as a result of comparison between the two.

The examiner determines that the claimed invention does not involve an inventive step in a case where he/she is able to reason the non-existence of an inventive step as a result of comparison between the claimed invention in which an alternative is chosen as an element and the prior art and attempt of the reasoning.

5.2 Procedure of examination pertaining to determination on novelty

The examiner issues the notice of reason for refusal to the effect that the claimed invention falls under any of items of Article 29 (1) and a patent shall not be granted for the claimed invention, when he/she is convinced that the claimed invention lacks novelty based on 2. in “Section 1 Novelty.”

As a response to the notice of reason for refusal on the novelty, the applicant may amend the claims by submitting a written amendment, or may make a rebuttal statement by submitting a written opinion or a certificate of experimental results, etc.

The notice of reason for refusal is cancelled where the examiner cannot be convinced that the claimed invention is not novel as a result of amendment, response or clarification. Otherwise, where the examiner's conviction remains unchanged, the examiner issues a decision of refusal based on the reason for refusal to the effect that the claimed invention falls under any of items of Article 29 (1) and a patent shall not be granted for the claimed invention.

5.3 Procedure of examination pertaining to determination on inventive step

(1) The examiner issues the notice of reason for refusal to the effect that a patent shall not be granted for the claimed invention under the provision of Article 29 (2), when he/she is convinced that the claimed invention does not involve an inventive step based on 2 and 3 in “Section 2 Inventive Step.” The examiner should prepare the notice of

reason for refusal so that the applicant can easily understand and respond to the notice.. In particular, he/she should describe the differences between the claimed invention and the primary prior art clearly and the reason that a person skilled in the art would easily arrive at the claimed invention from the primary prior art.

As a response to the notice of reason for refusal on an inventive step, the applicant may amend the claims by submitting a written amendment, or may make a rebuttal statement by submitting a written opinion or a certificate of experimental results, etc.

Facts in support of the existence of an inventive step (see 3.2 in “Section 2 Inventive Step”) are often argued in a written opinion, etc. The examiner should take such facts into consideration comprehensively in attempting the reasoning.

(2) The reason for refusal is cancelled where the examiner cannot be convinced that the claimed invention does not involve an inventive step as a result of amendment, response or clarification. The examiner issues a decision of refusal based on the reason for refusal to the effect that a patent shall not be granted for the claimed invention under the provision of Article 29 (2) where the examiner’s conviction that the claimed invention does not involve an inventive step remains unchanged.

Example: a case where the reason for refusal is not maintained

The examiner determines that the reason for refusal in the notice is not maintained when the reasoning cannot be conducted without citing new evidence additionally. As an exception, he/she can show additional evidence indicating well-known art or commonly used art to supplement the reasoning which has already been noticed.

(3) When the examiner cites well-known art or commonly used art for the reasoning in the notice of reason for refusal or decision of refusal, he/she should show their evidence except that no example is required. The above rule is applied regardless of citing well-known art or commonly used art as the prior art, as a basis for design modification or as evidence of the knowledge (Note 1) or ability (Note 2) of a person skilled in the art.

(Note 1) The knowledge of a person skilled in the art means the knowledge of state of the art including common general knowledge etc.

(Note 2) The ability of a person skilled in the art means the ability to use ordinary technical means for research and development, and normal creative ability.

6. Various Patent Applications

The relevant date (the time of filing) for determining on novelty and an inventive step is as shown in the below table.

Types of application	Time of filing
Divisional application, converted application or the patent application based on registration of utility model	The time of filing of the original application (Article 44(2), Article 46(6) or Article 46bis(2))
Application claiming internal priority	The time of filing of the earlier application (Article 41(2))
Application claiming priority under the Paris Convention (or priority claims recognized under the Paris Convention)	Filing date of the application filed in the first country (Article 4B of the Paris Convention) (Note)
International patent application	Filing date of international application (Article 184ter (1)) (Note) See the above column if the application claims priority.

(Note) Exceptionally, novelty and an inventive step are not determined based on "time of filing" but based on "filing date."

Note: When any ambiguity of interpretation is found in this provisional translation, the Japanese text shall prevail.

Part III Chapter 2 Section 4 Claims Including Specific Expressions

Section 4 Claims Including Specific Expressions

1. Overview

In this Section, the matters which the examiner should take into consideration in addition to the matters explained in the previous sections in examining novelty or an inventive step concerning claimed invention including the following expressions from (i) through (v), and concerning (vi) selection invention.

- (i) an expression specifying the product by its operation, function, characteristics or feature (See 2.)
- (ii) an expression specifying the product by its use (See 3.)
- (iii) an expression specifying the invention of subcombination by elements of other subcombination (See 4.)
- (iv) an expression specifying the product by a manufacturing process (See 5.)
- (v) an expression specifying the invention by numerical limitation (See 6.)
- (vi) selection invention (See 7.)

2. Expression Specifying the Product by Operation, Function, Characteristics or Feature

2.1 Specifying the claimed invention

In case that there is an expression specifying the product by operation, function, characteristics or feature (hereinafter referred to as "a function or characteristics, etc." in 2.) in a claim, the examiner interprets the claim as all products including such function or characteristics, etc. in principle. For example, concerning "wall materials with layers insulating heat", the examiner specifies wall materials with "products" that are "layers with heat insulation as their operation or function" (Note). However, the examiner should keep in mind that, in some cases, the meaning of the expression specifying the product by a function or characteristics, etc. is defined or explained in the description or drawings, and thus the expression should be understood as a meaning different from the regular meaning according to the definition or explanation.

The examiner should also keep in mind that, in some cases, the claimed invention is required to be specified according to the following 2.1.1.

(Note) In some cases, the expression is not interpreted as all products including such function in consideration of the common general knowledge at the time of filing. A claim which states "means for fixing the first wooden member to the second plastic member" is an example. This means obviously does not include a fixing means used for metals or the like, such as welding, in consideration of the common general knowledge at the time of filing even though such a fixing means is not excluded according to the claim's wording.

2.1.1 Cases where function or characteristics, etc. specific to the product is stated in a claim

In these cases, even if there is an expression attempting to specify the product by a function or characteristics, etc. in a claim, the examiner understands that the expression means the product itself. This is because such an expression is meaningless for specifying the product.

Example 1: Chemical compound X having anti-cancer effects

(Explanation)

If anti-cancer effects were inherent in a chemical compound X, the expression of "having anti-cancer effects" would be meaningless for specifying the product. Accordingly, the examiner understands that the expression of Example 1 means "chemical compound X" itself whether the fact that the chemical compound X has anti-cancer effects is known or not.

Example 2: RC integrator cutting high frequency signals and passing low frequency signals

(Explanation)

The feature of "cutting high frequency signals and passing low frequency signals" is the function inherent in "RC integrators." Accordingly, the examiner understands that the expression of Example 2 means general "RC integrators."

However, the claim of "RC integrator cutting high frequency signals with ...Hz or more and passing low frequency signals with ...Hz or less" is not the function inherent in general "RC integrators." In these cases, the examiner understands that such statement means "RC integrator with specific frequency characteristics" because the statement of the claim is meaningful for specifying the product,

2.2 Determination of novelty or inventive steps

If a product having a function or characteristics, etc. stated in a claim is

publicly known, the examiner determines that the product specified by a function or characteristics, etc. in a claim lacks novelty. For example, if wall materials are publicly known which are equipped with such "product" as "layers having a function of heat insulating," the examiner determines that "wall materials with layers insulating heat" lacks novelty. However, the examiner should keep in mind that, in some cases, the claimed invention should be determined as described in 2.2.1.

2.2.1 Cases where function or characteristics, etc. inherent in the product is stated in a claim

In these cases, if the product is publicly known, the examiner determines that the product lacks novelty. This is because a function or characteristics, etc. stated in a claim is meaningless for specifying the product.

Example 1: Chemical compound X having anti-cancer effects (same as Example 1 of 2.1.1)
(Explanation)

The claimed invention is interpreted as "Chemical compound X" itself. Accordingly, if the chemical compound X is publicly known, the claimed invention lacks novelty.

Example 2: RC integrator cutting high frequency signals and passing low frequency signals (same as Example 2 of 2.1.1)

(Explanation)

The claimed invention is interpreted as a general "RC integrator." Accordingly, because general "RC integrators" are publicly known, the claimed invention lacks novelty.

However, as for the claim of "RC integrator cutting high frequency signals with ...Hz or more and passing low frequency signals with ...Hz or less," the claimed invention is interpreted as a "RC integrator with specific frequency characteristics." Therefore, a general RC integrator does not deny the novelty of the claimed invention.

2.2.2 Cases where comparison with prior art is difficult and strict comparison is impossible due to the expression of a function or characteristics, etc.

In these cases, the examiner issues a notice of reason for refusal on novelty or an inventive step only where he/she has a certain degree of reasonable doubt that the claimed invention lacks novelty or an inventive step. The examiner should explain the reasonable doubt in the notice of reason for refusal.

3. Expression Specifying the Product by its Use Application (Limitation of Use)

3.1 Specifying claimed invention

If there is an expression specifying the product by use application such as "for use in ..." (the limitation of use application) in a claim, the examiner should take into consideration the description and drawings as well as the common general knowledge at the time of filing in interpreting what the limitation of use means as a claimed element.

3.1.1 Basic ideas in cases where there is limitation of use application

If the product with limitation of use means the product specifically suitable for its use, the examiner recognizes that the product has a shape, structure or composition, etc. (hereinafter simply referred to as "structure, etc." in 3.) that the limitation of use means (See Examples 1 and 2). The case where "the product with limitation of use means the product specifically suitable for the use application" is the case where the meaning of the limitation of use application is interpreted as the structure, etc. specifically suitable for the use application in consideration of the description and drawings as well as the common general knowledge at the time of filing.

On the other hand, if the product with limitation of use application does not mean the product specifically suitable for the use application, except for the use application of 3.1.2, the examiner should not interpret the limitation of use application to specify the product.

Example 1: Crane hook with a shape of ...

(Explanation)

In some cases, the meaning of the expression "crane" is interpreted as "hook" having a structure specifically suitable for use in crane from the aspect of its size or intensity or the like. In these cases, the examiner recognizes the claimed invention as the "hook" with such a structure. Accordingly, "a crane hook with a shape of ..." is different in structure, etc. from "a fishing hook (fishhook)" with a similar shape.

Example 2: Fe based alloy for a piano string of composition A

(Explanation)

In some cases, the meaning of the expression "for a piano string" is interpreted as a fine-layered structure for giving high-tension specifically suitable for a piano string. In these cases, the examiner recognizes the claimed invention as "Fe based alloy" with such a structure. Accordingly, "Fe based alloy for a piano string of composition A" is different in structures, etc. from Fe based alloy which does not have such a structure (for example, "Fe based alloy for use in gear wheel of composition A").

3.1.2 Cases where an invention of a product with limitation of use application should be interpreted as a use invention

A use invention is defined as the invention based on (i) discovering an unknown attribute of a product and (ii) finding out that the product is suitable for a novel use application because of such an attribute. The following ideas on the use invention are generally applied to the technical fields (Example: a technical field for use of a composition including chemical substances) where it is relatively difficult to know how to use the product based on the structure or name of the product.

(1) Cases where claimed invention is considered to be a use invention

In these cases, the examiner recognizes that the limitation of use application has a role in specifying the claimed invention, and specifies the claimed invention in consideration of the limitation of use application.

Example 1: Composition for use in anti-fouling ship bottoms comprising a specific quaternary ammonium salt.

(Explanation)

This composition and "the composition for use in undercoating for electrodeposition comprising certain quaternary ammonium salt" is not different except for their limitation of use. However, the use application such as "use in undercoating for electrodeposition" is, in some cases, derived from an attribute that enables electrodeposition on materials and that improves adherence of overcoat layers. In these cases, the examiner specifies the claimed invention, in consideration of the limitation of use application such as "use in anti-fouling ship bottoms" where both of the following conditions (i) and (ii) are satisfied. (Accordingly, these inventions are different from each other.) That is because this limitation of use application has a role in specifying the "composition."

- (i) "The use in anti-fouling ship bottoms" is derived from discovery of an unknown attribute that prevents shells from sticking to ship bottoms.

(ii) The use application which is derived from the attribute is different from any known uses and novel.

Example 2:

[Claim 1] A food composition for use in preventing a hangover containing an ingredient A as an active ingredient.

[Claim 2] A food composition for use in preventing a hangover according to claim 1, wherein the food composition is a fermented milk product.

[Claim 3] A food composition for use in preventing a hangover according to claim 2, wherein the fermented milk product is yogurt.

(Explanation)

The claimed invention "A food composition for use in preventing a hangover containing an ingredient A as an active ingredient" and the cited invention "a food composition containing an ingredient A" are not different except a limitation of use application. In this case, the examiner specifies the claimed invention in consideration of the limitation of use application such as "for use in preventing a hangover" provided that both of the following conditions (i) and (ii) are satisfied. (Accordingly, these inventions are different from each other.) That is because this limitation of use application has a role in specifying "a food composition."

(i) "The use in preventing a hangover" is derived from discovering of an unknown attribute that promotes alcohol metabolism by an ingredient A.

(ii) The use application which is derived from the attribute is different from any known uses and novel.

The same way of specifying the claimed invention also applies to a fermented milk product and yogurt which are more specific concept of a food composition.

(2) Cases where claimed invention is not considered to be use invention though there is a limitation of use application in a claim

Where the claimed invention is not considered to provide a novel use as the use of the product in consideration of the common general knowledge in the field at the time of filing, the invention does not fall under the category of use invention even if an unknown attribute was discovered. The examiner specifies the claimed invention with the understanding that the limitation of use does not have a role in specifying the claimed invention. The same applies to the case where the use of the claimed invention and prior art are not distinguishable from each other in consideration of the common general knowledge in the field at the time of filing even if they are different in their wordings.

Example 3: Cosmetic product containing ingredient A as an active ingredient for use in preventing wrinkle.

(Explanation)

"Cosmetic product containing ingredient A as an active ingredient for use in moisture retention of the skin" are derived from an attribute that adjusts the skin by softening the stratum corneum and helping the skin to absorb water. On the other hand, "cosmetic product containing ingredient A as an active ingredient for wrinkle defense" are derived from an unknown attribute that improves the skin condition by promoting the production of substance X in the body. However, both products are used externally for skin as skin-care cosmetics. In addition, if it is common knowledge in the field that the cosmetics with a moisturizing effect improve skin condition by preventing skin wrinkles, etc. with moisture retention and are also used for prevention of skin wrinkles, the use of these two products cannot be distinguished. Therefore, the examiner specifies the claimed invention with the understanding that the limitation of use, the expression "for use in preventing wrinkle," does not have a role in specifying the claimed invention.

(3) Points to note

A claim of use invention can be expressed in the form of drug (example: "cancer treatment drug containing ... as an active ingredient") and the form of method of use as well as the form of limitation of use application. What is described in the above items (1) and (2) is also applicable to use invention expressed in these forms other than limitation of use application only if there is an expression meaning a use application in the claim. (For example, "catalyst comprising ...," "ornamental material composed of alloy ...," "method of killing insects using")

3.1.3 Cases where ideas described in 3.1.1 or 3.1.2 are not applied or generally not applied

(1) Compounds, Microorganisms Animals or Plants

The ideas described in 3.1.1 and 3.1.2 are not applied to a compound with the limitation of use such as an expression "for use in ..." (compound Z for use in Y). The examiner interprets such a compound as the compound itself without limitation of use application (compound Z) (Example). That is because such a limitation of use only indicates the utility of compounds in general. The same also applies to microorganisms, animals and plants.

Example: Compound Z for use in killing insects.

(Explanation)

The examiner interprets "compound Z for use in killing insects" as "compound Z" itself without limitation of use because the expression "for use in killing insects" only indicates the utility of the compounds in consideration of the statements of the description and drawings as well as the common general knowledge at the time of filing. However, the examiner does not interpret "insecticide comprising compound Z as a main ingredient" in the same way as described above.

(2) Machines, apparatuses, articles and instruments, etc.

The ideas on use invention described in 3.1.2 are generally not applied to machines, apparatuses, articles and instruments, etc., because the product and its use are inseparably connected with each other in general.

3.2 Determination of novelty

3.2.1 Cases where the product of the invention stated in a claim has limitation of use application and the limitation means the product specifically suitable for its use application

In these cases, where there are differences in structure, etc. that the limitation of use means, the examiner determines that the claimed invention is different from the cited prior art even if all the claimed elements correspond to all the elements of the cited prior art except for the limitation of use. Therefore, the examiner determines that the claimed invention involves novelty.

Example 1: Crane hook with a shape of ... (same as Example 1 of 3.1.1)

(Explanation)

Where the statement of a claim is interpreted to specify the "hook" having structure specifically suitable for use in crane from the aspect of its size or intensity or the like, the claimed invention involves novelty even if "a fishing hook (fishhook)" with a similar shape is publicly known.

3.2.2 Cases where the product of the invention stated in a claim has limitation of use application, but the use application does not mean the product specifically suitable for its use and the claimed invention does not fall under the use

invention of 3.1.2

In these cases, where all the claimed elements correspond to all the elements of the cited prior art except for the limitation of use, the examiner does not determine that the claimed invention is different from the cited prior art. Therefore, the examiner determines that the claimed invention lacks novelty.

3.2.3 Cases where the claimed invention falls under the use invention of 3.1.2

In these cases, even if the product itself of the claimed invention is publicly known, the claimed invention involves novelty over the product (Note).

(Note) The use invention which involves novelty does not involve an inventive step where it is considered that a person skilled in the art would have easily arrived at such use application based on known attributes or structures of the product.

4. Expression Specifying the Invention of Sub-combination by Elements of "Another Sub-combination"

In cases where an invention of overall apparatuses or an invention of method of manufacturing a product (hereinafter referred to as "combination") is formed by combining two or more apparatuses or processes, sub-combination is defined as an invention of each apparatus or each process of the combination.

4.1 Specifying the claimed invention

The examiner should consider elements relevant to "another sub-combination" stated in the claim and not ignore them in specifying the claimed invention. The examiner should also understand the role which the elements have in specifying the sub-combination invention from the aspect of its shape, structure, constituent element, composition, operation, function, property, characteristic, method (an act or action), use, etc. (hereinafter referred to as "a structure, function, etc." in 4.) when he/she specifies the claimed sub-combination invention. In this regard, the examiner takes into account the statements of the description and drawings as well as the common general knowledge at the time of filing.

4.1.1 Cases where an element relevant to "another sub-combination" has a role in specifying a structure, function, etc. of the claimed sub-combination invention

In these cases, the examiner understands that the claimed sub-combination invention has such a structure, function, etc.

Example 1:

A client system which transmits a search word to a search server, receives return information from the search server, decodes the return information by a decoding means, and displays a search result on display means, wherein the search server transmits the return information after encrypting it by means of an encryption scheme A.

(Explanation)

Taking the common general knowledge at the time of filing into consideration, the client system cannot display the search result without using a decoding means compatible with the encryption scheme A. Therefore, the statement that the search server transmits the return information after encrypting it by means of the encryption scheme A specifies the client system in that the decoding means of the client system performs a decoding process corresponding to the encryption scheme A. Consequently, the claimed invention is found on the premise that the client system which is the invention of the sub-combination is specified as such.

Example 2:

A portable phone having a power charge terminal capable of being recharged with a charger which has a power feed terminal on one of four interior side surfaces of an accommodation indentation and which has light-receiving means on a side surface opposite to the side surface with the power feed terminal, wherein the charger ceases charging upon detection of a color of a lamp showing completion of charging of the portable phone by using the light-receiving means.

(Explanation)

A positional relationship between the power feed terminal and the light-receiving means of the charger specifies a positional relationship on the portable phone between its charge terminal and the lamp provided on the side surface opposite to the side surface with the charge terminal. Therefore, in connection with the portable phone that is the invention of the sub-combination, the claimed invention is found to be specified as such.

4.1.2 Cases where an element relevant to "another sub-combination" specifies only

"another sub-combination" and does not specify a structure, function, etc. of the claimed sub-combination invention at all .

In these cases, the examiner specifies the invention on the premise that the element relevant to "another sub-combination" does not have a role in specifying the claimed sub-combination invention.

Example 1:

A client server capable of transmitting a search word to a search server, receiving return information, and displaying a search result on display means, wherein the search server changes a search method on the basis of a frequency in search of the search word.

(Explanation)

The statement that the search server changes the search method on the basis of a frequency in search of a search word specifies what the search sever is. In the meantime, the statement does not specify at all a structure, function, etc. of the client system. Therefore, the claimed invention is found on the premise that the search server changing the search method on the basis of the frequency in search of the search word does not have a role in specifying the client system that is the invention of the sub-combination.

Example 2:

A liquid ink storage container capable of being attached to an image forming apparatus with a humidity sensor, wherein pressure with which the image forming apparatus squirts ink toward a sheet member is controlled according to humidity detected by the humidity sensor.

(Explanation)

The statement that the image forming apparatus controlling pressure for squirting ink in accordance with detected humidity specifies what the image forming apparatus is. In the meantime, the statement does not specify at all a structure, function, etc. of the liquid ink storage container. Therefore, the claimed invention is found on the premise that the image forming apparatus has a humidity sensor and controls the pressure for squirting ink in accordance with humidity detected by the humidity sensor do not have a role in specifying the liquid ink storage container that is the invention of the sub-combination.

Example 3:

A key with a hole formed so as to enable the key to be suspended on a holder ring of a key ring, wherein a security buzzer which emits an alarm sound when actuated is attached to the key ring.

(Explanation)

The statement that the security buzzer is attached to the key ring specifies what the key ring is. In the meantime, the statement does not specify at all a structure, function, etc. of the key. Therefore, the claimed invention is found on the premise that the security buzzer attached to the key ring does not have a role in specifying the key which is an invention of the sub-combination.

However, the examiner should make it a point to avoid focusing only on the fact that the sub-combination and another one are different from each other and misunderstanding that the "element relevant to another sub-combination" does not have a role in specifying the sub-combination invention.

4.2 Determination of novelty or an inventive step

4.2.1 Cases where an element relevant to "another sub-combination" stated in a claim has a role in specifying a structure, function, etc. of the claimed sub-combination invention

Where there is a difference between a sub-combination invention and a cited prior art, the examiner determines that the sub-combination invention involves novelty. However, in case that the difference relates to an operation, function, property, characteristic, method (an act or action), use, etc., see Clauses 2., 3., and 5. as to an determination of novelty.

Example 1:

A client system which transmits a search word to a search server, receives return information from the search server, decodes the return information by a decoding means, and displays a search result on display means, wherein the search server transmits the return information after encrypting it by means of an encryption scheme A. (identical to Example 1 of 4.1.1)

(Explanation)

In relation to the client system that transmits a search word to the search server, receives return information, and displays a search result on the display means, the claimed invention has novelty unless the client system with decoding means compatible with the encryption scheme A is well known.

Example 2:

Portable phone capable having a power charge terminal of being recharged with a charger which has a power feed terminal on one of four interior side surfaces of an accommodation indentation and which has light-receiving means on a side surface opposite the side surface with the power feed terminal, wherein the charger ceases charging upon detection of a color of a lamp showing completion of charging of the portable phone by using the light-receiving means. (identical to Example 2 of 4.1.1)

(Explanation)

In relation to the portable phone with the charge terminal and the lamp showing completion of recharging operation, the claimed invention has novelty unless a portable phone with a lamp on a side surface opposite a side surface with the charge terminal is well known.

4.2.2 Cases where an element relevant to "another sub-combination" stated in a claim does not at all specify a structure, function, etc. of the claimed sub-combination invention

In these cases, if no differences exist except for a difference between elements relevant to "another sub-combination" and elements specifying a cited prior art in view of a description or an expression, there are no differences between the claimed sub-combination invention and the cited prior art in terms of a structure, function, etc.

Therefore, the examiner determines that the sub-combination invention does not involve novelty.

Example 1:

A client server capable of transmitting a search word to a search server, receiving return information, and displaying a search result on display means, wherein the search server changes a search method on the basis of a frequency in search of the search word. (identical to Example 1 of 4.1.2)

(Explanation)

If the client system capable of transmitting a search word to the search server, receiving return information, and displaying a search result on display means is well known, the claimed invention lacks novelty. In that the search server changes the search method according to the frequency in search of a search word, the well-known client systems and the client system of the claimed invention differ from each other in view of a description and an expression but have no difference in terms of a structure, function, etc.

Example 2:

A liquid ink storage container capable of being attached to an image forming apparatus with a humidity sensor, wherein pressure with which the image forming apparatus squirts ink toward a sheet member is controlled according to humidity detected by the humidity sensor. (identical to Example 2 of 4.1.2)

(Explanation)

If a liquid ink storage device capable of being attached to an image forming apparatus is well known, the claimed invention lacks novelty. In that the image forming apparatus has a humidity sensor and controls pressure for squirting ink in accordance with the humidity detected by the humidity sensor, the well-known liquid ink storage device and the liquid ink storage device of the claimed invention are different from each other in view of a description and an expression but have no differences in terms of a structure, function, etc.

Example 3:

A key with a hole formed so as to enable the key to be suspended on a holder ring of a key ring, wherein a security buzzer which emits an alarm sound when actuated is attached to the key ring. (identical to Example 3 of 4.1.2)

(Explanation)

If a key with a hole formed so as to enable the key to be suspended on a holder ring of a key ring is well known, the claimed invention lacks novelty. In that the security buzzer which emits an alarm sound when actuated is attached to the key ring, the well-known keys and the key of the claimed invention are different from each other in view of a description and an expression but have no differences in terms of a structure, function, etc.

4.2.3 Cases where it is difficult to compare a claimed invention and a cited prior art, and the examiner is not able to compare them strictly due to an element relevant to "another sub-combination" in a claim

In these cases, the examiner may issue a notice of reasons for refusal on novelty or an inventive step only if he/she conceived a reasonable *prima facie* doubt that the claimed invention does not involve novelty or an inventive step. However, the examiner should explain about the reasonable doubt in the notice of reasons for refusal.

5. Expression Specifying a Product by a Manufacturing Process

5.1 Specifying the claimed invention

Where a claim includes a statement which specifies a product by a manufacturing process, the examiner construes the statement as a finally-obtained product itself. Therefore, even when the applicant obviously attempts to limit the invention solely to a substance manufactured by a specific process with his/her own will, such as "Z manufactured solely by a process A," the examiner construes the statement as the product itself (Z) and specifies the claimed invention.

5.2 Determination of novelty or an inventive step

5.2.1 Cases where a product manufactured by a manufacturing process stated in a claim is identical with a product of a cited prior art

In these cases, a claimed invention lacks novelty caused by the matters of manufacturing process regardless of whether or not the manufacturing process stated in a claim has novelty.

Example 1: Protein manufactured by a manufacturing process P (processes p1, p2, ... and pn)
(Explanation)

When protein manufactured by a manufacturing process P is identical with well-known specific protein Z manufactured by a manufacturing process Q , the claimed invention lacks novelty regardless of whether or not the process P has novelty.

5.2.2 Cases where a comparison and a strict contradistinction between a claimed invention and a cited prior art cannot be made because it is extremely difficult to structurally determine what a product itself is.

In these cases, the examiner issues a notice of reasons for refusal on novelty or an inventive step only when having a reasonable *prima facie* doubt that novelty or an inventive step of the claimed invention is negated. However, the examiner must provide explanations about the reasonable doubt in the notice of reasons for refusal.

6. Expression Specifying the Invention by Numerical Limitation

6.1 Specifying the claimed invention

Even when there is a statement about specifying an invention by use of a numerical limitation in a claim, a claimed invention is found in the same manner as in a usual case (see 2 in “Section 3 Procedure of Determining Novelty and Inventive Step”)

6.2 Determination of an inventive step

Where there is a statement about specifying an invention by use of a numerical limitation in a claim, the claimed invention usually has no inventive step when a point of difference between a main cited prior art and the claimed invention lies solely in the numerical limitation. The reason for this is that experimentally optimizing a range of numerals or making the same appropriate can be said to be exercise of ordinary creative activity of a person skilled in the art.

However, when the claimed invention yields an effect of comparison with the cited prior art fulfilling all requirements (i) to (iii) provided below, the examiner determines that such an invention for limiting numerical values has an inventive step.

- (i) The effect is advantageous within a limited range of numerical values although it is not disclosed in evidence of the prior art.
- (ii) The effect is different in nature from an effect yielded by the prior art, or remarkably superior although it is the same as the effect of the prior art (namely, the advantageous effect exhibits prominence).
- (iii) The effect is not one which can be predicted by a person skilled in the art from the state of the art as of filing.

In order to say that an advantageous effect exhibits prominence, prominence must be said to exist in an overall range of numerical values.

In addition, where a difference between the claimed invention and the main cited prior art lies only in presence/absence of a numerical limitation and where a common problem exists, a remarkable quantitative difference of the effect must exist outside and inside the boundary of numerical limitations in order that the distinctiveness of the advantageous effect shall be admitted as critical significance of numerical limitations. On the other hand, where a difference between the claimed invention and the primary cited prior art lies only in presence/absence of a numerical limitation, and where a problem is not common and an advantageous effect is different in nature, it is not required that numerical limitations have the critical significance.

7. Selection Invention

7.1 Specifying the claimed invention

A selection invention is an invention that belongs to a technical field where an effect, which would be yielded by a structure of an article, is difficult to predict and fulfills the following items (i) or (ii).

- (i) An invention (b) which is selected from invention (a) expressed in a broader concept in publications, etc. and which is expressed in a narrower concept embraced within the broader concept, wherein novelty of the invention (b) is not denied by the invention (a) expressed in the broader concept in publications, etc.
- (ii) An invention (b) which is selected from invention (a) expressed by multiple choices (Note) in publications, etc. and which has a part of the choices as invention elements, wherein novelty of the invention (b) is not denied by the invention (a) expressed by the multiple choices in publications, etc.

Therefore, an invention which cannot be said to be stated in prior art documents can be a selection invention.

Even in connection with a selection invention, a claimed invention is specified in the same manner as in an ordinary case (see 2 in "Section 3 Procedure of Determining Novelty and Inventive Step".)

(Note) see 4.1.1(note1) in "Section 3 Procedure of Determining Novelty and Inventive Step" for "choices."

7.2 Determination of an inventive step

When effects of a selection invention fulfill all of the following items (i) to (iii), the examiner determines that the selection invention involves an inventive step.

- (i) The effect of the selection invention is an advantageous effect which is not stated in prior art documents, etc.
- (ii) The selection invention yields an effect which is different from, or identical but prominently superior to an effect yielded by an invention expressed in a broader concept or multiple choices.

(iii) The effect of the selection invention cannot be predicted by a person skilled in the art from the state of the art.

Example:

Compounds expressed by a certain general formula have been known to have insecticidal property. A claimed invention is included in the general formula.

However, the claimed invention is based on a finding that a certain specific compound, which is not specifically well-known about its insecticidal property, is remarkably less poisonous to human beings than the other compounds expressed by the general formula, and is conceived by selecting the specific compound as an active ingredient of an insecticide. There is no evidence from which the compound is predictable.

In this case, the claimed invention involves an inventive step as a selection invention.

Note: When any ambiguity of interpretation is found in this provisional translation, the Japanese text shall prevail.

Part III Chapter 2 Section 5 Exceptions to Lack of Novelty of Invention

Section 5 Exceptions to Lack of Novelty of Invention (Patent Act Article 30)

1. Overview

Article 29 of the Patent Act provides that an invention which has fallen under any of the items of Article 29(1) prior to the patent application (in this section, hereinafter, referred to as "disclosed invention") shall not be patented in principle. However, even if the inventor files a patent application for his/her own invention after disclosure of the invention, if there is no possibility of the grant of a patent, this may be severe for the inventor. In addition, if a patent is not granted without any exception in this way, this does not match the purpose of Patent Act, which is contribution to industrial progress. Therefore, the Patent Act includes a provision that, in the case where a person having the right to obtain a patent for an invention (in this section, such "a person having the right to obtain a patent" is hereinafter referred to as "right holder") files a patent application after the invention is disclosed under specific conditions, the novelty of the invention shall not be lost for the reason of the disclosure prior to the patent application; that is, a provision of so-called exceptions to lack of novelty of invention (Article 30).

The "disclosed invention" to which the provision of exceptions to lack of novelty of invention is applicable is any of the following inventions, and is an invention for which a patent application was filed within six months from the disclosure of the invention.

- (i) An invention which was disclosed against the will of the right holder (Article 30(1))
- (ii) An invention which was disclosed resulting from an action of the right holder (Article 30(2))

In order to seek the application of the provision of Article 30(2), a document must be submitted within 30 days (Note) from the filing date proving the fact that the "disclosed invention" is an invention to which the provision of Article 30(2) may be applicable (in this section, hereinafter, referred to as "proving document") (Article 30(3)).

(Note) Where, due to reasons beyond the control of the person submitting "proving document," the person is unable to submit "proving document" within 30 days from the date of filing of the patent application, the person may submit "proving document" to the Commissioner of Patent Office within 14 days (where overseas resident, within two months) from the date on

which the reasons cease, but not later than six months following the expiration of the said time limit (Article 30(4)).

Article 30(1) or (2) is a provision about the case where an invention is disclosed against the will of the right holder or resulting from his/her action and where the right holder then files a patent application for the invention. Also in the case where a successor to the right to obtain a patent files a patent application for the invention within six months from the disclosure of the invention, the provision of Article 30(1) or (2) shall be applied.

If the provision of exceptions to lack of novelty of invention is applied to the "disclosed invention," the "disclosed invention" shall not become a cited invention at the time of making a determination on the requirements of novelty and inventive step of an invention claimed in a patent application.

2. Determination on Application of Provision of Article 30(2)

2.1 Application requirements

At the time of making a determination on the application of the provision of Article 30(2), the examiner shall determine whether it is proved that the following two requirements are satisfied, based on the "proving document" submitted in accordance with the provision of Article 30(3) or (4) (in this section, hereinafter, simply referred to as "proving document").

(Requirement 1) A patent application was filed within six months from the date of disclosure of the invention.

(Requirement 2) The invention was disclosed resulting from an action of the right holder, and the right holder filed a patent application.

2.2 Determination timing

The "disclosed invention" for which the applicant has tried to prove that the provision of Article 30(2) is applicable can become evidence for denying novelty and inventive step of the claimed invention, if the provision of Article 30(2) is not applicable to the "disclosed invention." Therefore, the examiner shall determine

whether this provision is applicable, at the time of undertaking an examination.

2.3 Determination procedures for the application of the provision of Article 30(2) based on the "proving document"

2.3.1 The case where the "proving document" which is compliant with the following form has been submitted

In principle, the examiner shall determine that it is proved that the Requirements 1 and 2 are satisfied, and shall admit the application of the provision of Article 30(2).

However, if the examiner finds evidence which casts any doubt on the fact that the provision of Article 30(2) is applicable to the invention, the examiner shall not admit the application of the provision.

Form of "Proving Document"

Proving Document for seeking Application of Provision of Exceptions to Lack of Novelty of Invention

1. Facts of Disclosure

- 1) Disclosure date
- 2) Disclosure site
- 3) Discloser
- 4) Contents of disclosed invention (the subject to be proved needs to be stated in an identifiable manner)

2. Facts of Succession to Right to Obtain Patent, etc.

- 1) Inventor of disclosed invention
- 2) Person having right to obtain patent as of action leading to disclosure of invention (the right holder as of the action)
- 3) Patent applicant (the person stated in the application form)
- 4) Discloser
- 5) About succession to right to obtain patent (succession to the right from the person in 1) to the person in 3) through the person in 2))
- 6) About relation, etc. between right holder as of action and discloser (for example, the fact that the person in 4) disclosed the invention resulting from the action of the person in 2) needs to be stated)

I hereby certify that the above statements are true.

YYYY/MM/DD

Applicant Name (Signature)

In this section, the facts corresponding to the contents of "1. Facts of Disclosure" and "2. Facts of Succession to Right to Obtain Patent, etc." are hereinafter referred to as "facts of disclosure" and "facts of succession to right to obtain patent, etc., " respectively.

2.3.2 The case where the "proving document" which is not compliant with the form mentioned in 2.3.1 has been submitted

The examiner shall determine whether it is proved that the Requirements 1 and 2 is satisfied on the basis of the submitted "proving document."

For example, if contents equivalent to the "proving document" compliant with the form mentioned in 2.3.1 are stated in the submitted document, in principle, the examiner shall determine that it is proved that Requirements 1 and 2 are satisfied, and shall admit the application of the provision of Article 30(2).

However, even if the "proving document" compliant with the form mentioned in 2.3.1 has been submitted, in the case where the examiner finds evidence which casts any doubt on the fact that the "disclosed invention" is an invention to which the provision of Article 30(2) is applicable, the examiner shall not admit the application of the provision of Article 30(2).

2.4 Determination procedures after a notice of reasons for refusal is issued without admission of the application of the provision of Article 30(2)

With regard to an "disclosed invention" for which "facts of disclosure" are explicitly stated in the "proving document", after the examiner issues a notice of reasons for refusal without admitting the application of the provision of Article 30(2), the applicant may assert that the application of the provision of Article 30(2) should be admitted through a written opinion, a written statement, or other such documents. In this case, the examiner shall determine again whether it is proved that Requirements 1 and 2 are satisfied, in consideration of the assertion of the applicant together with the matters stated in the "proving document".

3. Determination on Application of Provision of Article 30(1)

3.1 Application requirements

The examiner shall determine whether it is reasonably explained that the following two requirements are satisfied through a written opinion, a written statement, or other such documents submitted by the applicant.

(Requirement 1) A patent application was filed within six months from the date of disclosure of the invention.

(Requirement 2) The invention was disclosed against the will of the right holder.

· The expression that "(Requirement 2) the invention was disclosed against the will of the right holder" is "reasonably explained" means that specific situations are explained in the following cases, for example.

- (i) The case where the discloser disclosed the invention in spite of a non-disclosure obligation by an agreement made between the right holder and the discloser
- (ii) The case where someone other than the right holder disclosed the invention through theft, fraud, a threat, or other unjust measure

4. Points to Note Regarding Determination on Application of Provision of Article 30(1) and (2)

4.1 Points to note at the time of issuing a notice of reasons for refusal and a decision of refusal

In the case where the application of the provision of exceptions to lack of novelty of invention which is sought is not admitted, the examiner shall clearly state the reasons why the application of the provision is not admitted in a notice of reasons for refusal or a decision of refusal.

4.2 With regard to an invention to which the provision of Article 30(2) is applicable even if the "proving document" has not been submitted in the case where the number of inventions disclosed resulting from an action of the right holder is more than one

In the case where the number of inventions disclosed resulting from an action

of the right holder is more than one; for example, in the case where the right holder has published an invention in different magazines, in order to seek the application of the provision of Article 30(2), in principle, the "proving document" for each "disclosed invention" must be submitted within thirty days from the filing date. However, in the case where the applicant proves that each "disclosed invention" satisfies all the following conditions (i) to (iii), even if the "proving document" has not been submitted, the application of the provision of Article 30(2) shall be admitted.

- (i) The "disclosed invention" is the same or can be regarded as the same as an invention for which the application of the provision of Article 30(2) has been admitted based on the "proving document" (in this section, hereinafter, simply referred to as "the invention for which the application of the provision of Article 30(2) has been admitted").
- (ii) The "disclosed invention" is an invention disclosed through a disclosure action closely related to a disclosure action of "the invention for which the application of the provision of Article 30(2) has been admitted," or the "disclosed invention" is an invention disclosed by a person who is neither the right holder nor a person who was requested by the right holder to disclose the invention.
- (iii) The "disclosed invention" is an invention disclosed after the disclosure of "the invention for which the application of the provision of Article 30(2) has been admitted."

The examiner may use inventions other than "disclosed inventions" for which "facts of disclosure" are explicitly stated in the "proving document," as cited inventions in a notice of reasons for refusal. Then, in the case where it is proved that the "disclosed invention" satisfies all the conditions (i) to (iii) in consideration of the assertion of the applicant in a written opinion, a written statement, or other such documents, the examiner shall admit the application of the provision of Article 30(2) to the cited invention.

For example, in the case where a precedingly disclosed "invention for which the application of the provision of Article 30(2) has been admitted" and an invention disclosed resulting from an action of the right holder after the disclosure of the precedingly disclosed invention have any of the following relations, even if the "proving document" concerning the invention disclosed after the disclosure of the precedingly disclosed invention has not been submitted, the application of the provision of Article

30(2) shall be admitted.

Example 1: In the case where the right holder delivers cyclic lectures having the same contents in the same academic conference several times, the invention disclosed in the first lecture and the inventions disclosed in the second and subsequent lectures

Example 2: In the case where an article is precedingly published on a website of a publishing company and where the article is then published in a magazine issued by the publishing company, the invention published on the website and the invention published in the magazine

Example 3: The invention disclosed in an academic conference presentation and the invention disclosed thereafter by issuing the proceedings in which the contents of the academic conference presentation are summarized (Note)

(Note) In the case of the relation between the invention disclosed by issuing the proceedings in which the contents of an academic conference presentation are summarized and the invention disclosed thereafter in the academic conference presentation, condition (a) "the 'disclosed invention' is the same or can be regarded as the same" is not satisfied in many cases. Therefore, even if the application of the provision of Article 30(2) is admitted for the invention disclosed by issuing the proceedings, usually, the application of the provision of Article 30(2) shall not be admitted for the invention disclosed thereafter in the academic conference presentation unless the "proving document" concerning the latter invention has not been submitted within thirty days from the filing date.

Example 4: In the case where the right holder delivers the same products to the same customer several times, the invention disclosed in the first delivery and the invention disclosed in the second and subsequent deliveries

Example 5: The invention disclosed in television or radio broadcasting and the invention disclosed in rebroadcasting of the same contents

Example 6: The invention disclosed by selling a product by the right holder and the invention disclosed by publishing the product on a website by a third party who procures the product

Example 7: The invention disclosed at a press conference by the right holder and the invention disclosed by publishing the contents of the press conference in a journal

4.3 Points to note in various patent applications

For determining whether "(Requirement 1) a patent application was filed within six months from the date of disclosure of the invention" is satisfied, the date "on which the patent application was filed" of each of various patent applications shall be handled as follows.

4.3.1 Patent application with a claim of internal priority

In the case where an invention claimed in a patent application with a claim of internal priority is stated in the originally filed description, claims or drawings (in this section, hereinafter, referred to as "originally attached description, etc.") of an earlier patent application, the date "on which the patent application was filed" shall be the priority date (the filing date of the earlier patent application on which the claim of internal priority is based.)

However, in the case where the "proving document" has not been submitted, the date "on which the patent application was filed" shall be the filing date of the patent application with the claim of internal priority.

Also in the case where the invention claimed in the patent application with the claim of internal priority is not stated in the originally attached description, etc. of the earlier patent application, the date "on which the patent application was filed" shall be the filing date of the patent application with the claim of internal priority.

4.3.2 Patent application with a claim of priority under the Paris Convention

In the case of a patent application with a claim of priority under the Paris Convention, the date "on which the patent application was filed" shall be the filing date in Japan.

4.3.3 International patent application under the Patent Cooperation Treaty (in this section, hereinafter, referred to as "international patent application")

In the case where an invention claimed in an international patent application with a claim of internal priority is stated in the originally attached description, etc. of an earlier patent application, the date "on which the patent application was filed" shall be

the priority date.

However, in the case where the "proving document" has not been submitted, the date "on which the patent application was filed" shall be the international filing date of the international patent application with the claim of internal priority.

Also in the case where the invention claimed in the international patent application with the claim of internal priority is not stated in the originally attached description, etc. of the earlier patent application, the date "on which the patent application was filed" shall be the international filing date.

In the case of an international patent application with a claim of priority under the Paris Convention, the date "on which the patent application was filed" shall be the international filing date.

In the case of an international patent application without a claim of priority under the Paris Convention, the date "on which the patent application was filed" shall be the international filing date.

4.3.4 Divisional application, converted application, patent application based on utility model registration

In the case of a divisional application, a converted application, a patent application based on utility model registration, the date "on which the patent application was filed" shall be the filing date of the original application.

However, in the case where the "proving document" has not been submitted for the original application, the date "on which the patent application was filed" shall be the actual filing date.

Chapter 3 Secret Prior Art (Patent Act Article 29bis)

1. Overview

Patent Act Article 29bis provides that a patent application (hereinafter referred to as an "application" in this chapter) to be examined shall be unpatentable when fulfilling all (i) to (iv) given below:

- (i) Where an invention claimed in the application concerned is identical with an invention or a device (the invention or the device is hereinafter referred to as "an/the invention, etc." in this chapter) stated in the originally-filed description, the claims or an application for a utility model registration, or drawings (hereinafter referred to as "originally-filed description, etc." in this chapter) of another patent application or an application for a utility model registration which was filed earlier than the patent application concerned (another patent application or an application for utility model registration is hereinafter referred to as "another application" in this chapter).
- (ii) Where issuance of a gazette containing the patent, laying-open of an unexamined application (Article 64), or issuance of a Utility Model Bulletin (Article 14(3) of the Utility Model Act) (hereinafter referred to as "laying-open or the like" in this chapter) was conducted in connection with the other application after filing of the application concerned.
- (iii) The person who made the invention claimed in the other application (hereinafter referred to as "inventor of the other application" in this chapter) is not identical with the invention claimed in application concerned.
- (iv) The applicant of the application concerned is not identical with the applicant of the other application at the time at which the application concerned was filed.

In this chapter, among applications filed on different dates, applications filed earlier are hereinafter referred to as "earlier applications," and applications filed later are hereinafter referred to as "later applications."

Even when a later application was filed before laying-open of the earlier application, if the invention claimed in the later application is identical with the invention stated in the originally-filed description, etc., of the earlier application, new techniques are not laid open in the later application which is laid open. The reason why this article provides the above is that granting the patent right to the invention

claimed in such a later application is not reasonable in view of the spirit of the patent system which protects an invention in indemnification for laying a new invention open.

When this article is compared with Article 39 (see "Chapter 4 Prior Application") with regard to a range where the earlier application can preclude the later application, the range is an invention, etc., stated in (i) mentioned above in this article. However, in Article 39, the range is limited to an invention, etc., claimed in the claims of the patent or utility model registration. In this regard, the range where the earlier application can preclude the later application is broader in this article than that provided in Article 39. For this reason, the earlier application of this article is what is called "secret prior art."

2. Requirements for Article 29bis

The followings are requirements for yielding an effect of refusing the application concerned as a result of applying Article 29bis to the application concerned.

(1) Formal requirements to be fulfilled by another application

- (i) Another application is filed on the day earlier than the filing date of application concerned.
- (ii) The laying-open or the like of another application was made after the filing date of the application concerned. (Note)
- (iii) The inventor of another application was not identical with the inventor of the invention claimed in the application concerned.
- (iv) The applicant of the other application is not identical with the applicant of application concerned as of the filing date of the application concerned.

(Note) When the laying-open or the like of the other application was made before filing of application concerned, Article 29bis shall not apply to the other application. The invention laid open by the official gazette pertaining to the laying-open or the like of application concerned is taken as an invention falling under Article 29(1)(iii), and Article 29(1) or (2) shall apply to application concerned.

(2) The invention of the application shall be identical with the invention stated in the originally-filed description, etc. of another application (a substantive requirement).

The invention of the application concerned herein means an invention

claimed in the application concerned.

3. Interpretation on Requirements for Article 29bis

An invention to be interpreted as to the requirements for Article 29bis is a claimed invention.

The examiner shall interpret whether or not the other application fulfills the formal requirements (see 2.(1)) for Article 29bis.

Further, the examiner shall interpret whether or not the substantive requirements (see 2.(2)) for Article 29bis are fulfilled, on the basis of whether or not the invention claimed in the application concerned and the invention, etc. claimed in the originally-filed description of the other application fulfilling the formal requirements for Article 29bis (hereinafter referred to as the "cited invention" in this chapter) are identical by contradistinction therebetween. When interpreting that the claimed invention and the cited invention are identical with each other, the examiner shall interpret that the claimed invention shall not be granted a patent under the provision of Article 29bis.

When two or more claims are included in the claims of the application concerned, the examiner shall make an interpretation on the requirements for Article 29bis on a per-claim basis.

3.1 Interpretation on whether or not another application fulfills the formal requirements provided in Article 29bis

The examiner shall interpret whether or not another application fulfills all of the requirements (i) to (iv) stated in 2.(1). When any one of the requirements is not fulfilled, the examiner cannot apply the provision of Article 29bis to application concerned on the basis of the other application.

3.1.1 Inventor of another application is not identical with the inventor of the invention claimed in the application concerned (2.(1)(iii))

(1) When neither (i) nor (ii) provided below applies to the other application, the examiner shall interpret that the inventor of the other application is not identical (hereinafter referred to as "inventor is not same" in this chapter) with the inventor of the

invention of the claim of the application concerned.

- (i) Where all inventors stated in respective requests are completely the same in writing.
 - (ii) Where all inventors are completely the same as a result of being substantially interpreted even when all of the inventors stated in the respective requests are not completely the same in writing (example: when a discrepancy between the inventors in writing is attributable to the alteration of the inventor's family name, and the inventors are interpreted to be the same).
- (2) In principle, the examiner shall presume the inventor stated in request to be the inventor of the invention claimed in the application concerned. The examiner shall also make a like presumption for the inventors of the other applications. However, for instance, in such a case where another inventor is stated in a description, the examiner presumes that a person other than the inventor stated in the request is an inventor.
- (3) The examiner should note that the presumption that the inventor is not the same may be overturned if the applicant submits evidence (an oath of an inventor of the other application, etc.) for proving that the inventor is the same.

3.1.2 Inventor of another application is not identical with the applicant of the application concerned at the time at which application concerned was filed (2.(1)(iv))

- (1) The examiner shall interpret whether or not the applicant of another application and the applicant of application concerned are the same (hereinafter referred to as "applicant is same" in this chapter) at the filing date of application concerned.
- (2) The examiner shall interpret that the applicant is not the same when neither the case (i) nor (ii) provided below is applicable.
 - (i) Where all applicants stated in respective requests are completely the same in writing.
 - (ii) Where all applicants are completely the same as a result of being substantially interpreted even when all of the applicants stated in the respective requests are not completely the same in writing (example: when the applicant of the application does not match in writing the applicant of another application as a result of the applicant having undergone alteration of the applicant's name, inheritance (succession), or merger & acquisition).

3.2 Interpretation on whether or not the invention claimed in the application concerned and the cited invention are identical.

The examiner shall interpret that the invention claimed in the application concerned and the cited invention are the "same" in this chapter when the inventions fall under (i) or (ii) provided below as a result of contradistinction therebetween.

- (i) **Where the invention claimed in the application concerned and the cited invention have no difference.**
- (ii) **Where the invention claimed in the application concerned and the cited invention are different but share substantial identity.**

Substantial identity referred to herein means a case where a difference between the invention claimed in the application concerned and the cited invention is a very minor difference (an addition, deletion, conversion, etc., of common general knowledge or commonly used art (note), which does not yield any new effect) in embodying means for resolving a problem.

(Note) For "common general knowledge" and "commonly used art," see 2 (Note1) in "Capter2 Section2 Inventive Step."

4. Procedures of Examination under Article 29bis

4.1 Finding of Invention claimed in application concerned

The examiner shall find an invention claimed in the application concerned. The finding technique is similar to that referred to in 2. in "Chapter 2, Section 3 Procedure of Determining Novelty and Inventive Step."

4.2 Finding of Cited Invention

The examiner shall find a cited invention on the basis of the originally-filed description, etc. of another application fulfilling the formal requirements of 2.(1). The examiner shall find an invention stated in the originally-filed description, etc., in accordance with the finding of the invention stated in a publication defined in 3.1.1(1)

in "Chapter 2 Section 3 Procedure of Determining Novelty and Inventive Step." However, the "publication" shall read "originally-filed description, etc., " and "the time at which the application concerned was filed" shall read "the time at which another application was filed."

The examiner shall handle an invention in accordance with 3.2 in "Chapter 2, Section 3 Procedure of Determining Novelty and Inventive Step" when the invention is expressed in a generic or specific concept in the originally-filed description, etc. of another application. Further, the examiner must pay attention to hind-sight, etc., in accordance with 3.3 in "Chapter 2, Section 3 Procedure of Determining Novelty and Inventive Step."

Incidentally, even when a matter stated in the originally-filed description, etc., of the other application is deleted by a subsequent amendment, the deletion of the matter shall not affect application of the provision of Article 29bis.

4.3 Contradistinction between invention claimed in application concerned and cited invention

The examiner shall compare an invention claimed in the found application with the found cited invention. The examiner performs the comparison ("the time at which the application concerned was filed" shall read "the time at which another application was filed") in accordance with the technique referred to 4. in "Chapter 2 Section 3 Procedure of Determining Novelty and Inventive Step."

4.4 Interpretation on whether or not the invention claimed in the application concerned is unpatentable under the provision of Article 29bis and procedures of an examination pertaining to the interpretation

4.4.1 Interpretation on whether or not the invention claimed in the application concerned is unpatentable under the provision of Article 29bis

The examiner shall compare the invention claimed in application concerned with the cited invention and interprets that the invention claimed in application concerned is unpatentable under the provision of Article 29bis when interpreting that two inventions are the same, on the basis of an interpretation on 3.2.

In a case where a matter specifying a claimed invention has alternatives,

when the claimed invention, which is obtained on the assumption that only one of the alternatives is a matter specifying the invention, and the cited invention are "the same" in this chapter when compared with each other, the examiner shall interpret that the invention claimed in the application concerned is unpatentable under the provision of Article 29bis.

4.4.2 Procedures of examination pertaining to interpretation on whether or not the invention claimed in application concerned is unpatentable over the provision of article 29bis.

When gaining a belief that the invention shall be unpatentable under the provision of Article 29bis on the basis of 4.4.1, the examiner shall issue a notice of reasons for refusal under Article 29bis. In particular, when interpreting that the claimed invention and the cited invention share substantial identity (see 3.2(ii)), the notice of reasons for refusal must be one such that the applicant can grasp reasons why the examiner made such an interpretation and that the applicant can offer a refutation or elucidation.

In response to the notice of reasons for refusal to the effect that the claimed invention is unpatentable under the provision of Article 29bis, the applicant can make amendments on the claims or offer a refutation or elucidation by means of a written argument, certified experiment results, etc.

When amendments, a refutation, or an elucidation makes the examiner unable to maintain the belief that the claimed invention shall be unpatentable under the provision of Article 29bis, the reasons for refusal are dissolved. When holding on to the belief, the examiner shall issue a decision of refusal on the grounds of the reasons for refusal that the claimed invention should be unpatentable under the provision of Article 29bis.

5. Dealing of Claims, etc. including Certain Expressions

When the claim of application concerned includes a specific expression falling under (i) to (vi) provided below, the finding of the claimed invention is handled in accordance with "Chapter 2, Section 4 Claims Including Specific Expressions."

- (i) an expression specifying the product by operation, function, characteristics or features
- (ii) an expression specifying the product by its use application (limitation of use)
- (iii) an expression specifying the invention of sub-combination by elements of "another sub-combination"
- (iv) an expression specifying a product by a manufacturing process
- (v) an expression specifying the invention by numerical limitation
- (vi) selection invention

6. Dealing of Various Applications

6.1 Where another application is a divisional application, an application claiming priority, etc.

6.1.1 A divisional application, a converted application, or a patent application based on a utility model registration

As to 2(1)(i), the filing date of another application shall be an actual filing date without retroacting (the proviso to Article 44(2), Article 46(6) and Article 46bis (2)).

6.1.2 Application claiming priority under the Paris Convention (or priority declared as governed by the Paris Convention)

With regard to an application claiming priority under the Paris Convention (or priority declared as governed by the Paris Convention), an invention stated commonly in (i) and (ii) provided below shall be handled as one filed to Japan on the filing date of the first foreign application.

- (i) Entire filing documents of the first foreign application.
- (ii) Originally-filed description, etc., of an application to Japan

6.1.3 Application on which a claim of internal priority is based (earlier application) or application claiming internal priority (later application)

(1) With regard to inventions stated in originally-filed descriptions, etc., of the earlier

application and the later application(hereinafter referred to as "inventions stated in both" in this chapter) (Invention B in the following drawing), the provision of Article 29bis shall apply to the application concerned while the earlier application is taken as another application (Article 41(3), and the filing date of the other application is a filing date of the earlier application) (Note).

(Note) In the case of (i) provided below, the examiner shall not apply the provision of Article 29bis to the invention of (ii) provided below while taking the earlier application as another application (Article 41(3)). The reason for this is to prevent a substantial extension of a priority period on the grounds that a cumulative effect of priority claim shall not be permitted.

- (i) Where the earlier application claims priority (including priority under the Paris Convention and priority declared as governed by the Paris Convention)
- (ii) An invention stated in the originally-filed description, etc., of an application (the earlier application before last) on the basis of which priority was claimed for the earlier application among the inventions stated in both (Invention A in the following drawings).

(2) With regard to an invention stated in only the originally-filed description, etc., of the later application but not stated in the originally-filed description, etc., of the earlier application. (Invention C in the following drawing) s

The provision of Article 29bis shall apply to the application concerned (Article 41(2) and (3), the filing date of another application is an application of the later application) while the later application is taken as another application.

(3) With regard to an invention stated in only the originally-filed description, etc., of the earlier application but not in the originally-filed description, etc., of the later application (Invention D in the following drawing).

The examiner shall not apply the provision of Article 29bis to the invention while taking the earlier application or the later application as another application. This is because the invention shall not be deemed as being laid open or the like. (Article 41(3))

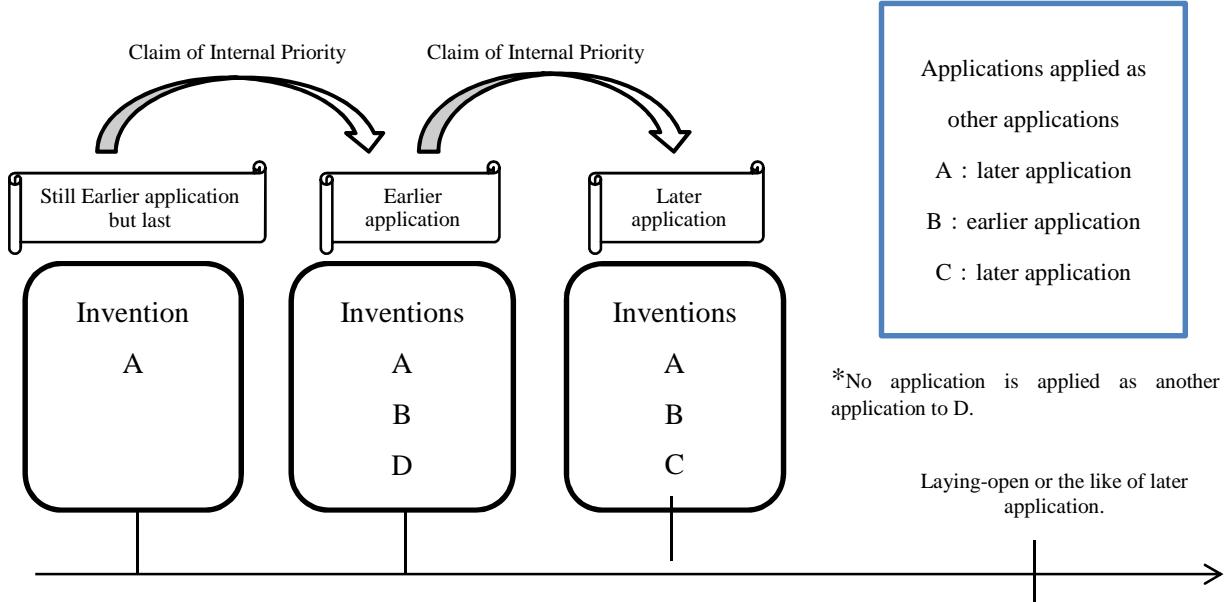


Figure Relationship between Internal Priority and Other applications under Article 29bis

6.1.4 Foreign language written application, international patent application, or international application for utility model registration

(1) Interchange of Wording

a "Another Application"

In the case of a patent application in foreign language or an utility model registration application in foreign language, "another application" shall read "another application (except an application withdrawn because a translation is not submitted)" (Article 184terdecies (184-13) and Article 184quater (3), and Article 48quater (3) of the Utility Model Act).

b "Laying-open or the like of Application"

In the case of an international patent application or an international application for a utility model registration, "laying-open or the like of an application" shall read "international publication, etc." (Article 184terdecies (184-13) and Article 184quindecies (184-15)(3) and (4)).

c "Originally-filed Description etc."

In the case of a foreign language written application, "originally-filed description, etc." shall read "document written in foreign language (original text)"

(the parenthesized provisions Article 29bis and the parenthesized provision of Article 41(3)).

In the case of an international patent application or an international application for a utility model registration, "originally-filed description, etc." shall read "description, claims, or drawings (original text) of an international application on an international filing date" (Article 184terdecies (184-13), Article 184quindecies (184-15)(3) and (4)).

(2) Points to consider in cases where an application (earlier application) on which internal priority is claimed is a foreign language written application, a patent application in foreign language or an utility model registration application in foreign language (hereinafter referred to as a "foreign language written application, etc." in this chapter.)

Handling pertinent to 6.1.3 in this case remains the same when a translation of the earlier application has already been submitted and when the translation has not been submitted (the parenthesized provision of Article 41(3), and the provisions of Article 184quindecies (3) (184-15(3) and (4)).

(3) Points to consider pertaining to the scope of search for another application

When a foreign language written application, etc. is another application, an effect of secret prior art of the other application stems from an original text. Hence, it is finally required to be able to point out statements in the original text of the other cited application. However, since there is extremely high probability that a match exists between the original text and the translation, it is usually considered that examination of only the statements translated into Japanese will suffice.

(4) Points to consider pertaining to a method for writing a notice of reasons for refusal when a foreign language written application etc. is cited as another application

It is usually sufficient to point out a statement in a translation and write a comment to the effect that a corresponding statement in an original text is a reason for refusal. However, if a portion of the statement in original text is known, portions of the statements in both the translation and the original text shall be pointed out.

(5) Response to applicant's argument when another application is a foreign language written application, etc.

a Where a notice of reasons for refusal is issued while a foreign language written

application, etc. is taken as another application, when the examiner becomes unable to gain a belief that a matter pointed out by the examiner is stated in the original text as a result of the applicant alleging, in a written argument, etc., that a matter pointed out by the examiner is not stated in the original text of another application concerned, the reasons for refusal shall be dissolved. Holding on to the belief, the examiner shall issue a decision of refusal.

- b Where a new matter beyond the original text (See 2 in “Part VII Chapter 2 Examination of Foreign Language Written Application” and 5.2 in “Part VIII International Patent Application”) is found in the original in rebuttal by the applicant in connection with another application which has not yet finished being examined, a notice of reasons for refusal of the new matter in the original shall be issued by the examiner for the other application.

6.2 Case where an application is a divisional application, an application claiming priority, etc.

A filing date of an application provided in 2.(1)(i) (a date to be compared with a filing date of another application) is handled as in the following table.

Application Type	Filing Date of Application
A patent application based on a divisional application, a converted application, or an application for a utility model registration	Filing date of an original application (Article 44(2), Article 46(6) or Article 46bis(2))
Application claiming internal priority	Filing date of an earlier application (Article 41(2))
Application claiming priority under the Paris Convention (or priority declared as governed by the Paris Convention)	Filing date of the first foreign application (Article 4B of the Paris Convention)
International patent application	International filing date (Article 184ter (1)). However, when priority is claimed, it is the same as above in the upper columns.

A standard time (a time when the application concerned was filed) when an interpretation is made as to whether or not filing of application concerned is followed by laying-open or the like of another application under 2.(1)(ii) is handled as stated in the following table.

Application Type	Filing Time of Application
A patent application based on a divisional	Filing time of an original application

application, a converted application, or an application for a utility model registration	(Article 44(2), Article 46(6) or Article 46bis(2))
Application claiming internal priority	Filing time of an earlier application (Article 41(2))
Application claiming priority under the Paris Convention (or priority declared as governed by the Paris Convention)	Filing date of the first foreign application (Article 4B of the Paris Convention) (Note)
International patent application	International filing date (Article 184ter(1)) (Note). However, when priority is claimed, it is the same as above in the upper columns.

(Note) "Filing date" rather than "filing time" is exceptionally taken as a standard.

Filing time of application concerned stated in 3.1.2 (a time when an applicant of another application and the applicant of the application concerned are interpreted to have the identity) is handled as follows:

Application Type	Filing Time of Application
A patent application based on a divisional application, a converted application, or an application for a utility model registration	Filing time of an original application (Article 44(2), Article 46(6) or Article 46bis(2))
Application claiming internal priority	Filing time of a later application (Article 41(2))
Application claiming priority under the Paris Convention (or priority declared as governed by the Paris Convention)	Time at which an application is filed to Japan
International patent application	International filing date (Article 184ter(1)) (Note)

(Note) "Filing date" rather than "filing time" is exceptionally taken as a standard.

Chapter 4 Prior Application (Patent Act Article 39)

1. Overview

Article 39 of the Patent Act is a provision elucidating the principle of one patent for one invention and also a system (the first-to-file system) in which only the first applicant is granted a patent when a plurality of applications are filed for one invention.

A patent system grants an exclusive right to a patentee for a given period in indemnification for laying open an invention that is creativity of a technical idea. Therefore, two or more rights should not be granted for one invention. This article is provided on the basis of such a purpose to eliminate a double patenting.

Under this article;,, where two or more patent applications relating to the same invention are filed on different days, only the first patent applicant may be granted a patent for the invention (Article 39(1)).

Where an invention claimed in the patent application is identical with a device claimed in an application for a utility model registration and where the applications are filed on different days, the patent applicant may be granted a patent for an invention only if the applicant filed the application earlier than the applicant of the application for the utility model registration (Article 39(3)).

Where two or more patent applications relating to the same invention are filed on the same date, only one applicant, agreed upon through consideration between the applicants, can be granted a patent (the first sentence of Article 39(2)). If an agreement fails to be reached through consultation or if consultation was impossible, none of the applicants can be granted a patent for the invention (the second sentence of Article 39(2)).

Where two or more patent applications relating to the same invention are filed on the same date, the Director-General of the Patent Office shall order the applicants to hold consultations for an agreement and to report the result thereof, within a designated time limit (Article 39(6)). Where the report is not made, the Director-General of the Patent Office may deem that no agreement has been reached (Article 39(7)).

The same shall apply to the case where an invention relating to a patent application is identical with a device relating to an application for a utility model

registration and where the applications are filed on the same date (Article 39(4), (6), and (7)).

In this chapter, a patent application to be examined is hereinafter referred to as an "application concerned." In relation to application of Article 39(1) to (4), an application other than the application concerned is hereinafter referred to as "another application" or "other application." Further, with regard to Article 39(1) or (3), an earlier filed application, among a plurality of applications filed on different days, is referred to as an "earlier application," and applications filed later than the earlier application are hereinafter referred to as "later applications." With regard to Article 39(2) or (4), the other applications filed on the same date when the application concerned was filed are hereinafter referred to as "co-pending applications filed on the same date." Moreover, an invention or device is hereinafter referred to as "an/the invention, etc."

2. Requirements for Article 39

Requirements for yielding an effect of refusal of the application concerned after application of Article 39 to the application concerned are as follows:

- (1) Formal requirements to be fulfilled by the other applications.
 - (i) The other application shall be filed earlier than or on the same date as the application concerned is filed.
 - (ii) The other application shall not be one deemed not to exist from the beginning under the provision of Article 39(1) to (4) (Article 39(5)).
- (2) An invention relating to the application concerned and an invention, etc. relating to the other application shall be the same (substantial requirements).

The invention relating to the application concerned herein means an invention claimed in claims of the application concerned (hereinafter referred to as "claimed invention" in this chapter). Further, an invention, etc. relating to the other application shall be an invention, etc. claimed in a claim of the other application.

3. Interpretation on Requirements for Article 39

The examiner shall interpret whether or not the other application fulfills

the formal requirements of Article 39 (see 2.(1)).

The examiner shall interpret whether or not the substantial requirements of Article 39 (see 2.(2)) are fulfilled, on the basis of whether or not both inventions are the same, as a result of a comparison between the claimed invention with the invention, etc. claimed in a claim of the other application fulfilling the formal requirements of Article 39.

When two or more claims are in the claims of the application concerned, the examiner shall make an interpretation for each claim.

3.1 Interpretation on whether or not the other application fulfills the formal requirements provided in Article 39

The examiner shall interpret whether or not the other application fulfills both requirements (i) and (ii) of 2.(1). When the other application fails to fulfill even one of the requirements, the examiner shall not be able to refuse the application concerned by applying the provision of Article 39 to the application concerned on the basis of the other application.

3.1.1 The other application shall not be one deemed not to exist from the beginning under the provision of Article 39(5) (2.(1)(ii))

In the case of (i) or (ii) provided below, the other application shall be deemed not to exist from the beginning under the provision of Article 39(1) to (4). Therefore, when the other application does not fall under either of (i) and (ii) provided below, the examiner shall interpret that the other application fulfills the requirement referred to in 2.(1)(ii).

- (i) When the other application is abandoned, withdrawn, or dismissed.
- (ii) When a decision of refusal or a trial decision of refusal is determined (excluding the case where the decision of refusal or a trial decision of refusal becomes final and conclusive because other co-pending applications filed on the same date are present in connection with the other application (the second sentence of Article 39(2) or the second sentence of Article 39(4).)

3.2 Interpretation on whether or not the claimed invention and the invention claimed in the claim of the other application, etc., are the same

3.2.1 Where the other application is an earlier application

When considering that (i) or (ii) provided below is applicable as a result of a comparison between the claimed invention and an invention, etc. claimed in the claim of the earlier application (hereinafter referred to as "prior invention" in 3.), the examiner shall interpret that the two inventions are the same.

- (i) Where no difference exists between the claimed invention and the prior invention.**
- (ii) Where the claimed invention and the prior invention share the substantial identity even when a difference exists there.**

"Substantial identity" herein means a case where any one of (i) to (iii) provided below is applicable.

- (ii-1) Where the difference is a very minor difference (an addition, deletion, conversion, etc., of common general knowledge or commonly-used art (Note 1), which does not yield any new effect) in embodying means for resolving a problem.
- (ii-2) Where the difference is caused as a result of the matter specifying the prior invention being expressed by a generic concept (Note 2) in the claimed invention.
- (ii-3) Where the difference is a mere difference in categorical expressions (for example, a difference between expression forms, or an invention of "product" or an invention of "method")

(Note 1) For "Common general knowledge" and "Commonly-used art," see 2. (Note1) in "Chapter 2 Section 2 Inventive Step."

(Note 2) For a generic concept, see 3.2 (Note1) in "Chapter 2 Section 3 Procedure of Determining Novelty and Inventive Step."

3.2.2 Where the other application is a co-pending

When an invention A and an invention B are applied on the same day and are the same (means "same" referred to in 3.2.1. This shall apply to corresponding counterparts in this paragraph hereunder) in the both cases of (i) and (ii) provided below, the examiner shall identify that the claimed invention and inventions claimed in the claims of the co-pending applications filed on the same

date (hereinafter referred to as "co-pending inventions" in this chapter).

- (i) Where the invention A is presumed to be an earlier application and where the invention B is presumed to be a later application**
- (ii) Where the invention B is presumed to be an earlier application and where the invention A is presumed to be a later application**

In the meantime, even in a case where the invention B of the later application and the invention A of the earlier application are the same provided that the invention A is taken as an earlier application and that the invention B is taken as a later application, when the invention A of the later application and the invention B of the earlier application are not the same provided that the invention B is taken as an earlier application and that the invention A is taken as a later application, the examiner shall interpret that the claimed invention and the co-pending inventions are not the "same" (e.g., the invention A is a "spring," and the invention B is an "elastic member").

4. Procedures of Examination under Article 39

Article 39 shall apply to a case where the claimed invention and the prior invention or the co-pending invention are the same. There is a possibility that details of the prior invention or details of the co-pending invention will be changed by an amendment to the claims of the other application. On the other hand, a cited invention employed when Article 29 (novelty and inventive step) applies to the application concerned is not subjected to such a possible change. The scope where the application concerned can be eliminated under Article 29bis (secret prior art) corresponds to the description, the claims, or the drawings originally attached to the earlier application and is broader than the scope referred in Article 39 and not changed by the amendment. Therefore, as in the case of (1) or (2) provided below, when the provision of Article 29 or the provision of Article 29bis can be applied to the application concerned, the examiner shall apply these provisions to the application concerned without applying the provision of Article 39 to the application concerned.

- (1) Where an unexamined patent application, a gazette containing the patent, or a gazette containing the utility models, which are relevant to laying-open of the earlier application, has been published before filing of the application concerned, the inventions stated or included in the gazettes correspond to the invention stipulated in Article 29(1)(iii). Hence, the examiner applies the provision of Article 29 to the application concerned without applying the provision of Article 39.

- (2) Where the provision of Article 29bis is applied to the application concerned, the examiner shall apply the provision of Article 29bis to the application concerned without applying the provision of Article 39 to the application concerned.

Where the filing date of the other application and the filing date of the application concerned are the same, where the applicants are the same, or where the inventors (creators of devices) are the same, Article 29bisrfr shall not apply to the application concerned. Therefore, the examiner shall make deliberations on application of Article 39 to the application concerned.

In this chapter, the followings are based on the presumption that an unexamined patent application, a gazette containing the patent, or a gazette containing the utility models, which are relevant to laying-open of the earlier application, has not been published before filing of the application concerned.

4.1 Finding of the claimed invention and the prior invention or the co-pending invention

The examiner shall find the claimed invention.

Also, the examiner shall find a prior invention or a co-pending invention (Notes 1, 2) claimed in another application fulfilling the formal requirements of 2.(1). The finding technique is the same as the technique referred to in 2. in “Chapter 2 Section 3 Procedure of Determining Novelty and Inventive Step.”

(Note 1) Where the prior invention or the co-pending invention comes to include a matter (new matter) not falling within the scope of the matters stated in the originally-filed description, the claims, or the drawings, as a result of amendments, the examiner shall not find the invention as the prior invention nor the co-pending invention. The reason for this is that imparting an effect of excluding a later application or co-pending applications filed on the same date to the invention claimed in the claim including a new matter goes against the principle of the first-to-file system.

Further, on the basis of the same principle, where the prior invention or the co-pending invention includes a new matter as to the original text in a foreign language written application, a patent application in foreign language or an utility model registration application in foreign language, the examiner shall not find the invention as a prior invention or as a co-pending invention. However, even when the application includes a new matter as to the translation but not a new matter as to the original text, the examiner shall find the invention as a prior

invention or a co-pending invention.

(Note 2) When the prior invention or the co-pending invention cannot be taken as a cited invention in accordance with 3.1.1(1)b in "Chapter 2, Section 3 Procedure of Determining Novelty and Inventive Step", the examiner shall not find the invention as the prior invention or the co-pending invention. However, in 3.1.1(1)b in "Chapter 2 Section 3 Procedure of Determining Novelty and Inventive Step", "an invention which a person skilled in the art can grasp from matters stated in publications and matters nearly stated" shall read "an invention claimed in the claim of another application"; "stated in the publications" shall read "stated in the description and drawings of another application"; and "common general knowledge as of filing" shall read "common general knowledge at the time of filing of another application."

4.2 Contradistinction between the claimed invention and the prior invention or the co-pending invention

The examiner shall compare the found claimed invention with the found prior invention or co-pending invention.

The examiner shall perform a comparison in accordance with the technique referred to in 4 in "Chapter 2, Section 3 Procedure of Determining Novelty and Inventive Step" (one of "claimed invention" and "cited invention" shall read "claimed invention," and the other shall read "prior invention or co-pending invention").

4.3 Interpretation on whether or not the claimed invention is unpatentable under Article 39

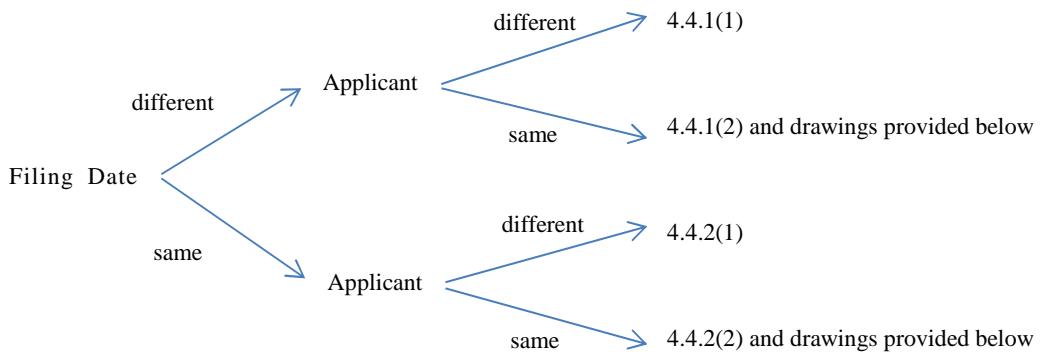
The examiner shall compare the claimed invention with the prior invention or the co-pending invention. When interpreting that the two inventions are the same in accordance with 3.2, the examiner shall interpret that the claimed invention is unpatentable under Article 39.

When a matter specifying the invention of the claim of the application has alternatives, the invention of the claim of the application which would be obtained when only one of the alternatives is taken as a matter specifying the invention shall be compared with the invention claimed in the claim of the other application. When a comparison result shows that the two inventions are the "same" in this chapter, the examiner shall interpret that the claimed invention is unpatentable under Article 39.

4.4 Procedures of examination pertaining to whether or not the claimed invention is unpatentable under Article 39

When gaining a belief that the claimed invention is unpatentable under Article 39(1) to (4) on the basis of 4.3, the examiner shall proceed with examination in accordance with handling of the respective cases which will be hereinafter referred to in 4.4.1 and 4.4.2 (See drawings provided at the end of this chapter for a case of a plurality of patent applications related to one applicant, which often causes problems in actual practice. An interpretation on whether or not applicants are the same is performed in relation to an applicant at a point in time of each examination. The interpretation technique is the same as that referred to in 3.1.2(2) in “Chapter 3 Secret Prior Art”).

Moreover, the examiner shall comply with 4.4.3 in relation to handling performed after issuing a notice of reasons for refusal under Article 39.



4.4.1 Where another application is an earlier application

(1) Where an applicant of the application concerned is different from an applicant of another application

Where an inventor of the application concerned is different from an inventor of another application, the examiner shall apply Article 29bis to the case (see “Chapter 3 Secret Prior Art”)

On the other hand, when the two inventors are the same, the examiner shall issue a notice of reasons for refusal to the application concerned under the provision of Article 39(1) or (3). However, when issuing a decision of refusal on the basis of

the reasons for refusal, the examiner shall not proceed with examination until the earlier application becomes final and conclusive.

- (2) Where an applicant of the application concerned and an applicant of another application are the same

The examiner shall proceed with examination by issuing a notice of reasons for refusal to the application concerned under Article 39(1) or (3) regardless of whether or not the earlier application becomes final and conclusive. When issuing a notice of reasons for refusal to the application concerned under Article 39(1) or (3) on the basis of the earlier application which is not yet final or conclusive (including an application for which a request for examination is not yet filed), the examiner shall append, to the notice of reasons for refusal, a comment to the effect that a decision of refusal will be issued unless the reasons for refusal are dissolved even when the earlier application is not yet final or conclusive.

There is a case where examination of the earlier application has not yet commenced at the time of a response to the notice of reasons for refusal to the application concerned, although a request for examination of the earlier application has already been filed. In this case, if a proposal to the effect that the applicant is willing to make an amendment to the earlier application is offered in response to the notice of reasons for refusal to the application concerned, the examiner shall handle the case as follows.

- a Where the earlier application includes reasons for refusal

The examiner shall issue a notice of reasons for refusal to the earlier application and shall not proceed with examination, after lapse of a designated period, until confirming whether or not an amendment is made to the earlier application and details of the amendment.

- b Where the earlier application does not include reasons for refusal

The examiner shall not proceed with examination until a decision to grant a patent is issued for the earlier application.

4.4.2 Where another application is a co-pending application filed on the same date

- (1) Where the applicant of the claimed application is different from the applicant of another application

- a Where respective applications are pending in the Patent Office

The examiner shall handle the case as follows depending on whether or not a

request for examination has been filed for all of the co-pending applications.

- (a) Where a request for examination has been filed for all of the co-pending applications

The examiner shall invite the applicants of all the applications to have consultation under the name of the Director-General of the Patent Office. When the application concerned includes reasons for refusal other than those based on Article 39(2) or (4), the examiner shall send a notice of the reasons for refusal when inviting the applicant of the application to have consultation. The reason for this is that, as a result of the notice of reasons for refusal other than those based on Article 39(2) or (4) being issued at the time of inviting the applicants to have the consultations, the applicant shall be able to know substantially all the reasons for refusal at the same time and take an appropriate response.

Where a result of consultation is submitted within a designated period and when the application concerned is the application of the applicant designated by the consultations, the examiner shall issue a decision to grant a patent unless there are other reasons for refusal. If the application is not the application of the applicant specified by the consultations, the examiner shall issue a notice of reasons for refusal under Article 39(2) or (4).

Where a result of consultation is not submitted within the designated period, the consultations are deemed to have failed (Article 39(7)). The examiner shall issue a notice of reasons for refusal under Article 39(2) or (4). However, when interpreting that the provision of Article 39(2) or (4) shall not be applicable to the application concerned for reasons other than submission of the consultation result, the examiner shall not issue the notice of reasons for refusal. Cases corresponding to this are mentioned as follows: a case where the reasons based on Article 39(2) or (4) are resolved by an amendment to the claims of the application concerned, and a case where the examiner taking into account an assertion in a written opinion interprets that there are no reasons for refusal under Article 39(2) or (4).

- (b) Where a request for examination is not filed for some of the co-pending applications

Where there are also reasons for refusal based on a provision other than Article 39(2) or (4), the examiner can proceed with examination based on the reasons for refusal. However, a decision of refusal based on the reasons for

refusal shall be made only when the reasons for refusal based on Article 39(2) or (4) are resolved; for instance, a case where the claimed invention and the co-pending invention become not identical with each other as a result of an amendment, etc. Where the reasons for refusal based on Article 39(2) or (4) are not resolved, the examiner shall not issue a decision of refusal based on a provision other than Article 39(2) or (4).

(Explanation)

The application for which the decision of refusal has become final and conclusive is in principle deemed to be one originally nonexistent from the beginning (an application not having so-called "status of prior application") with regard to application of the provisions of Article 39(1) to (4). However, when a decision of refusal based on Article 39(2) or (4) has become final and conclusive, the application has a prior-art effect. Therefore, where a decision of refusal based on another provision is issued when there is a possibility that a decision of refusal will be issued under Article 39(2) or (4), the prior-art effect of the application will be lost. The application will be rejected, whereas the co-pending applications will not be rejected under Article 39(2) or (4). This would go against the aim of Article 39(2) or (4) to the effect that an application, agreed upon the consultation, can be granted a patent or a utility model registration and, hence, inappropriate. Accordingly, the examiner shall handle the case as above.

In the case of (i) or (ii), the examiner shall issue, to the applicant of the application for which the request for examination has already been filed, a notice to the effect that the examiner cannot proceed with examination under Article 39(2) or (4) because a request for examination is not filed for the other applications. The reason for this is that it has not yet come to a state of being able to invite the applicant to have consultation because a request for examination has not been filed for some of the co-pending applications.

- (i) Where a decision of refusal is not issued because the reasons for refusal based on Article 39(2) or (4) are not resolved, although there are reasons for refusal based on a provision other than Article 39(2) or (4) as above.
- (ii) Where there are only reasons for refusal based on Article 39(2) or (4).

After issuance of the notice, the examiner shall not proceed with examination until a request for examination is issued for the other applications so that it becomes possible to invite the applicant to have consultation, or until the other applications are withdrawn (including elapse of a period of a request for

examination) or dismissed.

- b Where a patent or utility model is registered for at least one of the co-pending applications
 - (a) This case corresponds to a case where consultations are impossible (Article 39(2) or (4)). The examiner shall not invite consultation under the name of the Director-General of the Patent Office for the applications for which a patent or utility model is not registered but shall issue a notice of reasons for refusal under Article 39(2) or (4).
 - (b) When issuing a notice of reasons for refusal under Article 39(2) or (4), the examiner shall notify the patentee or the owner of a utility model right of the fact.

(Explanation) Where a patent or utility model is registered for at least one of the applications, the consultation cannot be performed. However, holding an opportunity to have a substantial consultation between the patent applicant and the patentee/the owner of a utility model is conceived to be useful in order to avoid reasons for refusal or invalidation and obtain appropriate protection for invention or device. Therefore, the examiner shall handle the case as above.

- (2) Where an applicant of the application concerned and the applicant of the other application are identical with each other

- a Where the applications are pending in the Patent Office

Even when the applicants are the same, the examiner shall apply the provision of Article 39(2) or (4) in conformity with the case where the applicants are different, handling as referred to in 4.4.2(1)a. The aim of Article 39(2) and (4) resides in providing one right per one invention. Therefore, even when the applicants are the same, the provision shall be applied.

However, where handling the case as referred to in 4.4.2(1)a, the examiner shall notify all reasons for refusal simultaneously with issuing invitation to consult. The reason for this is that, where the applicants are the same, a time for consultation shall be unnecessary.

- b Where a patent or an utility model is registered for at least one of the co-pending applications

The examiner shall handle the case in the same way as referred to in 4.4.2(1)b(a). The reason for this is that, when the applicants are the same, the

applicant can take an appropriate response upon receipt of a notice of reasons for refusal. The examiner shall not issue a notice referred to in 4.4.2(1)b(b).

4.4.3 Handling after notification of reasons for refusal under Article 39

When gaining a belief that the claimed invention is unpatentable under the provision of Article 39(1) to (4) on the basis of 4.3, the examiner shall issue a notice of reasons for refusal based on the provision of Article 39 in light of 4.4.1 or 4.4.2. In particular, when the examiner interprets that the claimed invention and the prior invention or the co-pending invention share substantial identity (see 3.2.1(ii)), the notice of reasons for refusal must be those that make it possible for the applicant to grasp reasons so as to be able to offer a refutation or elucidation.

In response to the notice of reasons for refusal to the effect that the claimed invention is unpatentable under the provision of Article 39(1) to (4), the applicant can make an amendment to the claims by submitting an amendment or offer a refutation or elucidation by means of a written opinion, a certificate of experimental results, etc.

When the examiner has become unable to hold a belief that the claimed invention is unpatentable under the provision of Article 39(1) to (4), because of the amendment, refutation, or elucidation, the reasons for refusal are dissolved. When the belief remains unchanged, the examiner shall issue a decision of refusal on the basis of the reasons for refusal to the effect that the claimed invention is unpatentable under the provision of Article 39(1) to (4) (excluding a case where examination is not carried on as referred to in 4.4.1(1), 4.4.1(2)a and b, or 4.4.2(2)a which applies 4.4.2(1)a or 4.4.2(1)a(b) mutatis mutandis).

5. Dealing of Claims, etc. Including Certain Expressions

With regard to finding the claimed invention, the Examiner proceeds according to "Chapter 2, Section 4 Claims Including Specific Expressions" concerning a case that the claims of a present application have a specific expression falling under the following (i) to (vi).

- (i) an expression specifying the product by operation, function, characteristics or features
- (ii) an expression specifying the product by its use application (limitation of use)

- (iii) an expression specifying the invention of sub-combination by elements of “another sub-combination”
- (iv) an expression specifying a product by a manufacturing process
- (v) an expression specifying the invention by numerical limitation
- (vi) selection invention

6. Dealing of Various Applications

(1) Reference date for whether other application is an earlier patent application or patent application filed on the same date (the filing dates of the present application and the other application) is treated per the following table.

Kinds of application	Reference date
Divisional application, converted application or patent application based on Utility Model Registration	Filing date of the original application (Articles 44(2), 46(6) or 46bis(2))
Application claiming internal priority right (Concerning the invention stated in Description, Claims or Drawing originally attached to a request of a prior application on which a claim of the internal priority right is based)	Filing date of an application among the application(s) on which the claim of the internal priority right is based, in which the invention according to claim(s) to be determined is stated (Article 41(2))
Application with a claim of a priority under the Paris Convention (Concerning the invention stated in complete filing documents of the application on which the claim of the priority right under the Paris Convention is based (Description, Claims or Drawing))	Filing date of an application among the application(s) on which the claim of the priority right under the Paris Convention is based, in which the invention according to claim(s) to be determined is stated (Article 4(B) of the Paris Convention)
International Patent Application or International Utility Model Registration Application	International filing date (Article 184ter(1)). Provided, the above-mentioned matters are applied when the application claims the priority right.

(2) Points to note

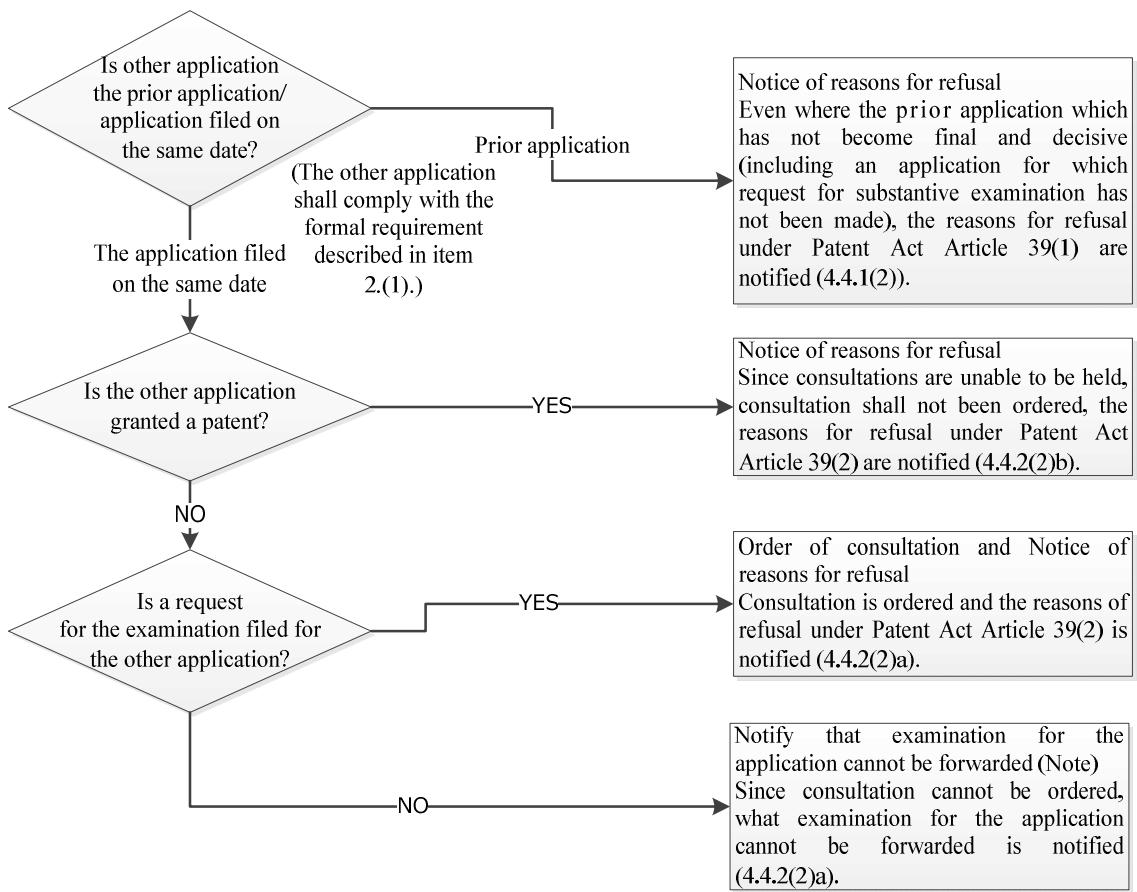
a A case in which the present application is a converted application

Since where an application is converted, the original application shall be deemed to have been withdrawn (Patent Act Article 46(4) and Utility Model Act Article 10(5)), the original application shall, for the purpose of Article 39(1) to (4), be deemed

never to have been filed (Patent Act Article 39(5)).

b A case in which the present application is a patent application based on utility model registration

Even where the invention of the patent application based on utility model registration and the device of the utility model registration are the same, the provisions of Article 39 are not applied therefor (parenthesized provision of Patent Act Article 39(4)).



(Note) In the case where the reasons of refusal other than under Article 39 exist, the examination can be proceeded in principle (see 4.4.2(2)a)

Figure Outline of treatment of violating Patent Act Article 39 in a case where several patent applications for the same invention filed by the same applicant are filed

Chapter 5 Category of Unpatentable Invention (Patent Act Article 32)

1. Overview

Article 32 of the Patent Act provides that any invention that is liable to injure public order, morality or public health (hereinafter, referred to as "public order, morality, etc." in this chapter) shall not be patented even if the invention is industrially applicable. Article 32 provides a category of unpatentable invention for the purposes of public interests.

Whether the public order, morality, etc. is injured is related to general profits of the nation and society and senses of morality and ethics (hereinafter, referred to as "morality, etc." in this chapter). Such senses of morality and ethics can change with time, and can be different for each person. Therefore, if a decision of refusal is made to an invention due to violation of Article 32, an adverse disposition is imposed based on only morality, etc., normative sense of values which can change with time and can be different for each person, regardless of technological evaluations of the invention. Considering this, the examiner shall suppressively make a determination that the claimed invention falls under the category of unpatentable invention, as explained in 2. (2).

In addition, Article 27(2) of the Agreement on Trade-Related Aspects of Intellectual Property Rights (hereinafter, referred to as "TRIPS agreement") allows contracting parties to exclude from patentability inventions, the prevention within their territory of the commercial exploitation of which is necessary to protect public order or morality, including to protect human, animal or plant life or health or to avoid serious prejudice to the environment. Meanwhile, Article 27(2) includes the proviso "provided that such exclusion is not made merely because the exploitation is prohibited by their law."

Therefore, as explained in 2. (3), the examiner shall not interpret that an invention falls under the category of unpatentable invention, and shall not issue a notice of reasons for refusal, a decision of refusal, etc. to the effect that the invention falls under the category of unpatentable invention, merely because the exploitation of the invention is prohibited by Japanese law.

2. Determination on whether Invention falls under Category of Unpatentable Invention

- (1) Inventions subjected to a determination on whether the invention falls under the category of unpatentable invention are claimed inventions. In the case where there are two or more claims in the claims, the examiner shall make, for each claim, a determination on whether the invention falls under the category of unpatentable invention.
- (2) The examiner shall determine that the claimed invention falls under the category of unpatentable invention, only in the case where the claimed invention obviously injures the public order, morality, etc.
The examiner shall not determine that the claimed invention falls under the category of unpatentable invention merely because the claimed invention can be carried out in such a manner that may injure the public order, morality, etc.

a Examples of inventions which fall under the category of unpatentable invention

Example 1: Humans themselves produced through genetic manipulation

Example 2: Methods solely used to brutally massacre humans

b Examples of inventions which do not fall under the category of unpatentable invention

Example 1: Poisons

Example 2: Explosives

Example 3: Anticancer drugs with side effects

Example 4: Apparatuses for punching holes in bank bills

(Such apparatuses are not necessarily used for crimes such as forgeries of genuine bank bills.)

- (3) The examiner shall not determine that the claimed invention falls under the category of unpatentable invention merely because the exploitation is prohibited by Japanese law (the proviso to Article 27(2) of the TRIPS Agreement).

Example 1:

[Claims]

A positional information transmitting apparatus which emits radio waves for improving positioning accuracy.

(Explanation)

Even in the case where the use of the radio waves is prohibited in principle by Japanese regulations concerning radio waves, the examiner shall not determine that the claimed invention falls under the category of unpatentable invention merely because of this reason.

Example 2:

[Claims]

An air conditioning method of: measuring the level of stress of people in a building, using a predetermined sensor; performing an operation such that the room temperature in the building exceeds 28 degrees Celsius when the level of stress is equal to or less than a given value; thus saving electricity.

(Explanation)

Even in the case where such room temperature conditioning violates Japanese regulations concerning room temperature, the examiner shall not determine that the claimed invention falls under the category of unpatentable invention merely because of this reason.

3. Procedures of Examination concerning Determination on whether Invention falls under Category of Unpatentable Invention

In the case where the examiner is convinced that the claimed invention obviously injures the public order, morality, etc., the examiner shall issue a notice of reasons for refusal to the effect that the claimed invention does not fulfill the requirements of Article 32.

In response to this, the applicant may submit a written amendment to amend the claims, and may present an argument or clarification through a written opinion.

In the case where the amendment and the argument or clarification make the examiner unconvinced that the claimed invention obviously injures the public order, morality, etc., the examiner shall determine that the reason for refusal has been resolved. In the case where the examiner remains convinced, the examiner shall issues a decision of refusal based on the reason for refusal under Article 32.

<Relevant Provisions>

Patent Act

(Requirements for Patentability)

Article 29(1)

Any person who has made an invention which is industrially applicable may obtain a patent for said invention, except in the case of the following inventions:

(i) inventions that were publicly known in Japan or a foreign country, prior to the filing of the patent application;

(ii) inventions that were publicly worked in Japan or a foreign country, prior to the filing of the patent application; or

(iii) inventions that were described in a distributed publication, or inventions that were made publicly available through an electric telecommunication line in Japan or a foreign country, prior to the filing of the patent applications.

(2) Where an invention could easily have been made, prior to the filing of the patent application, by a person with ordinary skill in the art to which the invention pertains, on the basis of an invention or inventions referred to in any of the paragraphs of subsection (1), a patent shall not be granted for such an invention notwithstanding subsection (1).

Article 29-2

Where an invention claimed in a patent application is identical with an invention or device (excluding an invention or device made by the same person as the inventor of the invention claimed in the patent application) stated in the description, the scope of claims or drawings (in the case of the foreign language written application under Article 36-2(2), foreign language documents as provided in Article 36-2(1)) originally attached to the request of another patent application or application for a registration of a utility model which was filed earlier than the filing date and for which the patent gazette containing a matter provided by the provision of Article 66(3) (hereinafter referred to as "gazette containing the patent") was issued or laid open for public inspection, or a utility model gazette (hereinafter referred to as "gazette containing the utility model") containing a matter provided in Article 14(3) of the Utility Model Act (Act No. 123 of 1959) under the provision of the same was published after filing of the patent application, shall not be granted a patent notwithstanding Article 29(1). However, this provision shall not apply where, at the time of filing of the patent application, the applicant of the patent application and the applicant of the other application for a patent or the application for a utility model registration are the same person.

(Exceptions to Lack of Novelty of Invention)

Article 30

In the case of an invention which has fallen under any of the items of Article 29(1) against the will of the person having the right to obtain a patent, such invention shall be deemed not have fallen under any of the items of Article 29(1) for the purposes of

Article 29(1) and (2) in relation to the invention claimed in the patent application which has been filed by said person within six months from the date on which the invention first fell under any of those paragraphs.

2 In the case of an invention which has fallen under any of the items of Article 29(1) resulting from an action of the person having the right to obtain a patent (excluding inventions which have been published in official gazettes concerning inventions, utility models, designs or trademarks and thus have fallen under any of the items of Article 29(1)), the preceding paragraph shall also apply for the purposes of Article 29(1) and (2) to the invention claimed in the patent application which has been filed by said person within six months from the date on which the invention first fell under any of those paragraphs.

3 Any person seeking the application of the preceding paragraph shall submit to the Commissioner of the Patent Office, at the time of filing of the patent application, a document stating the same and, within thirty days from the filing date of the patent application, a document proving the fact that the invention which has otherwise fallen under any of the items of Article 29(1) is an invention to which the preceding paragraph may be applicable (referred to as "proving document" in the following paragraph).

4 (Omitted)

(Unpatentable inventions)

Article 32

Notwithstanding Article 29, any invention that is liable to injure public order, morality or public health shall not be patented.

(Priority Claim based on Patent Application, etc.)

(Prior application)

Article 39(1)

Where two or more patent applications claiming identical inventions have been filed on different dates, only the applicant who filed the patent application on the earliest date shall be entitled to obtain a patent for the invention claimed.

(2) Where two or more patent applications claiming identical inventions have been filed on the same date, only one applicant, who has been selected by consultations between the applicants who filed said applications, shall be entitled to obtain a patent for the invention claimed. Where no agreement is reached by consultations or consultations are unable to be held, none of the applicants shall be entitled to obtain a patent for the invention claimed.

(3) Where an invention and a device claimed in applications for a patent and a utility model registration are identical and the applications for a patent and a utility model registration are filed on different dates, the applicant for a patent may obtain a patent for the invention claimed therein, only if the application for a patent is filed prior to the application for a utility model registration.

- (4) Where an invention and a device claimed in applications for a patent and a utility model registration are identical (excluding the case where an invention claimed in a patent application based on a utility model registration under Article 46-2(1) (including a patent application that is deemed to have been filed at the time of filing of said patent application under Article 44(2) (including its mutatis mutandis application under Article 46(6)) and a device relating to said utility model registration are identical) and the applications for a patent and a utility model registration are filed on the same date, only one of the applicants, selected by consultations between the applicants, shall be entitled to obtain a patent or a utility model registration. Where no agreement is reached by consultations or no consultations are able to be held, the applicant for a patent shall not be entitled to obtain a patent for the invention claimed therein.
- (5) Where an application for a patent or a utility model registration has been waived, withdrawn or dismissed, or where the examiner's decision or trial decision to the effect that a patent application is to be refused has become final and binding, the application for a patent or a utility model registration shall, for the purpose of paragraphs (1) to (4), be deemed never to have been filed; provided, however, that this shall not apply to the case where the examiner's decision or trial decision to the effect that the patent application is to be refused has become final and binding on the basis that the latter sentence of paragraph (2) or (4) is applicable to said patent application.
- (6) The Commissioner of the Patent Office shall, in the case of paragraph (2) or (4), order the applicant to hold consultations as specified under paragraph (2) or (4) and to report the result thereof, while designating an adequate time limit.
- (7) Where no report under the preceding paragraph is submitted within the time limited designated under said paragraph, the Commissioner of the Patent Office may deem that no agreement under paragraph (2) or (4) has been reached.

Article 41

(omitted)

2 With regard to application of the provision of ... the main clause of Article 29-2 ... of the Patent Act to, among the inventions claimed in the patent application with the priority claim provided by the provision of Article 41(1) of the Patent Act, the invention (excluding an invention stated in a document (limited to one equivalent to the description, the scope of claims or the scope of application for a registration of a utility model, or the drawings) used at the time of filing of the application on which the priority claim of an earlier application was based when the earlier application was one claiming priority under the provision of Article 41(2) of the Patent Act or Article 8(1) of the Utility Model Act or priority under the provision Article 43(1) or Article 43-2(1) or (2) of the Patent Act (including the case where Article 11(1) of the Utility Model Act shall apply mutatis mutandis)) stated in the description, scope of claims or the scope of application for a registration of a utility model, or the drawings

originally attached to the request of the earlier application on which the priority claim is based (a document written in foreign language when the earlier application is a foreign application), the patent application is deemed to be filed at the time of the earlier application.

3 Among the inventions stated in the description, scope of claims, or drawings originally attached to the request of a patent application claiming priority under Article 41(1) of the Patent Act (a document written in foreign language in the case of a foreign application), an invention (excluding an invention stated in a document limited to one equivalent to the description, scope of claims or the scope of application for a registration of a utility model, or drawings) used at the time of filing of an application on which an earlier application claimed priority is based, when the earlier application is one claiming priority under Article 41(1) of the Patent Act or Article 8(1) of the Utility Model Act or priority under Article 43(1) or Article 43-2(1) or (2) of the Patent Act (including a case where Article 11(1) of the Utility Model Act shall apply mutatis mutandis) stated in the description, the scope of claims or the scope of application for a registration of a utility model, or the drawings originally attached to the request of the earlier application on which the priority claim is based (a document written in foreign language when the earlier application is a foreign application) shall be subject to application of the provision of the main clause of Article 29-2 of the Patent Act or the main clause of Article 3-2 of the Utility Model Act while the earlier application is deemed to be laid open or a utility model registration for the earlier application is deemed to be published when the patent application was laid open or the gazette containing the patent was published for the patent application.

4 (omitted)

(Division of Patent Applications)

Article 44

(omitted)

2 In the case referred to in the preceding paragraph, the new patent application shall be deemed to have been filed at the time of filing of the original application. However, where the new patent application is either another patent application as referred to in Article 29-2 of the Patent Act or a patent application as referred to in Article 3-2 of the Utility Model Act, this provision and the provision of Article 30(3), 41(4) and 43(1) of the Patent Act (including the case where Article 44(3) of the Patent Act shall apply mutatis mutandis) shall not apply.

3 to 6 (omitted)

(Special Provision for Patentability Requirements)

Article 184-13

With regard to application of the provision of Article 29-2 of the Patent Act performed when another patent application provided in Article 29-2 or an application

for a utility model registration is an international patent application or an international application for a utility model registration under Article 48-3(2) of the Utility Model Act, "another patent application or an application for a utility model registration" referred to in Article 29-2 shall read "another patent application or an application for a utility model registration (excluding a foreign patent application referred to in Article 184-4(1) of the Patent Act regarded to have been withdrawn under the provision of Article 184-4(3) of the Patent Act or Article 48-4(3) of the Utility Model Act, or a foreign application for a utility model registration referred to in Article 48-4(1) of the Utility Model Act)"; "laid-open or" shall read "laid-open"; "issued" shall read "issuance or the international publication referred to in Article 21 of the Patent Corporation Treaty ratified at Washington DC on June 19, 1970"; and "the description, the scope of claims or the request for a utility model registration, or drawings originally attached to the request" shall read "the description, the scope of claims, or the drawings of the international application on the international filing date referred to in Article 184-4(1) of the Patent Act or Article 48-4(1) of the Utility Model Act."

Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS agreement)

Article 27 Patentable Subject Matter

(1) (Omitted)

(2) Members may exclude from patentability inventions, for which it is necessary to prevent commercial exploitation within their territory in order to protect public order or morality, including to protect human, animal or plant life or health or to avoid serious prejudice to the environment, provided that such exclusion is not made merely because the exploitation is prohibited by their law.

(3) (Omitted)

Paris Convention for the Protection of Industrial Property

Article 4quater

Patents: Patentability in Case of Restrictions of Sale by Law

The grant of a patent shall not be refused and a patent shall not be invalidated on the ground that the sale of the patented product or of a product obtained by means of a patented process is subject to restrictions or limitations resulting from the domestic law.

Part IV

Amendments of Description, Claims or Drawings

Note: When any ambiguity of interpretation is found in this provisional translation, the Japanese text shall prevail.

Part IV Amendments of Description, Claims or Drawings

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Part IV Amendments of Description, Claims or Drawings

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<Relevant Provisions>

Chapter 1 Requirements for Amendments (Patent Act Article 17bis)

1. Overview

Article 17bis of the Patent Act provides the timing and the scope within which the description, claims or drawings (In this part, hereinafter, referred to as "description, etc.") may be amended.

In order to smoothly and promptly proceed with the procedures, it is desirable for the applicant to submit documents having perfect contents from the beginning. However, due to the need for haste in a patent application under the first-to-file principle or other reasons, such perfect documents may not be possible in actuality. In addition, for example, in the case where any reason for refusal is found as a result of the examination, the description, etc. may need to be modified. Under the circumstances, Article 17bis provides that the description, etc. may be amended. However, if the description, etc. may be freely amended at any time, the procedures will be confused, and a delay in processing of patent application would occur. Therefore, Article 17bis provides the timing at which the description, etc. may be amended (time requirements). In addition, in order to guarantee a prompt grant of right and ensure the fairness of patent application handling and the balance between the applicant and third parties, Article 17bis provides the scope within which the description, etc. may be amended (substantive requirements).

Requirements for amendment made to the description, etc. are summarized in this chapter, and specific determination standards for the substantive requirements are explained in " Chapters 2 Amendment Adding New Matter" to "Chapter 4 Amendment for other than the Prescribed Purposes".

2. Time Requirements of Amendment

The applicant may amend the description, etc. in any of the following timing (i) to (v) (Article 17bis(1)).

- (i) After the application before the transmittal of a certified copy of an examiner's decision that a patent is to be granted (except after the applicant receives the first notice of reasons for refusal) (Article 17bis(1)) (Note 1)
- (ii) Within the designated time limit of a non-final notice of reasons for refusal (Article

17bis(1)(i))

- (iii) Within the designated time limit of a notice under Article 48septies (Note 2) after receiving a notice of reasons for refusal (Article 17bis(1)(ii))
- (iv) Within the designated time limit of a final notice of reasons for refusal (Article 17bis(1)(iii))
- (v) At the same time when a request is made for an appeal against an examiner's decision of refusal (Article 17bis(1)(iv))

(Note 1) For an international patent application, see 4.2 in "Part VIII International Patent Application."

(Note 2) For a notice under Article 48septies, see "Part II Chapter 1 Section 3 Requirements for Disclosure of Information on Prior Art Documents."

3. Substantive Requirements of Amendment

The applicant may amend the description, etc. within the scope in which the substantive requirements are satisfied (Article 17bis(3) to (6)). The substantive requirements are defined in the following manner in accordance with the timing of amendment. The scope within which the description, etc. may be amended shall be gradually limited with progression of the examination.

3.1 Before the first notification is sent to the applicant

Amendment shall not add a new matter (Patent Act Article 17bis(3). See "Chapter 2 Amendment Adding New Matter.")

3.2 After the non-final notice of reasons for refusal is noted

- (1) In the case where any amendment is made in any of the following timing (i) or (ii), the amendment shall satisfy both of the following substantive requirements (i) and (ii).

Timing of Amendment

- (i) Within the time limit designated in a non-final notice of reasons for refusal (2. (ii)) (excluding the cases where the amendment is made within the time limit designated in a notice of reasons for refusal with the notice under Article 50bis

(Note))

- (ii) Within the time limit designated in the notice under Article 48septies after reception of the notice of reasons for refusal (2. (iii))

Substantive requirements

- (i) Amendment does not add new matter (Patent Act Article 17bis(3). See “Chapter 2 Amendment Adding New Matter.”)
- (ii) Amendment does not change the special technical feature of invention (Patent Act Article 17bis(4). See “Chapter 3 Amendment Changing Special Technical Feature of Invention”)

(Note) For the notice under Article 50bis, see "Part VI Chapter 1 Section 2 Notice under Article 50bis."

(2) In the case where any amendment is made in any of the following timing (i) to (iii), the amendment shall satisfy all of the following substantive requirements (i) to (iii).

Timing of Amendment

- (i) Within the time limit designated in the final notice of reasons for refusal (2. (iv))
- (ii) Within the time limit designated in a notice of reasons for refusal accompanied by the notice under Article 50bis (Note) (2. (ii) or 2. (iv))
- (iii) At the same time when a request is made for an appeal against an examiner's decision of refusal (2. (v))

Substantive requirements

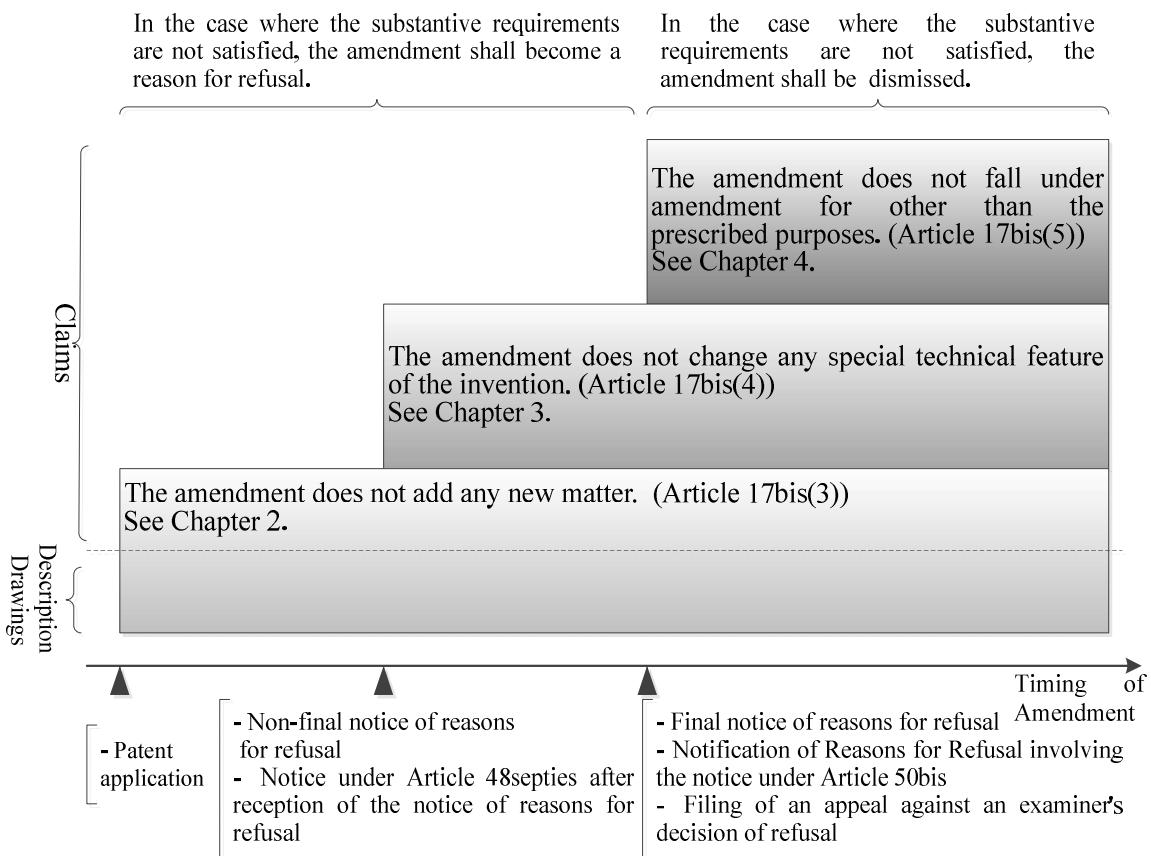
- (i) Amendment does not add new matter (Patent Act Article 17bis(3). See “Chapter 2 Amendment Adding New Matter.”)
- (ii) Amendment does not change the special technical feature of invention (Patent Act Article 17bis(4). See “Chapter 3 Amendment Changing Special Technical Feature of Invention”)
- (iii) An amendment made to the claims is intended for the following purposes (the amendment should not be made for other than the prescribed purposes) (Article 17bis(5). See “Chapter 4 Amendment for other than the Prescribed Purposes”)
 - (a) Deletion of claims (Article 17bis(5)(i))
 - (b) Restriction of claims in a limited way (Article 17bis(5)(ii))
 - (c) Correction of errors (Article 17bis(5)(iii))

(d) Clarification of an ambiguous statement (Article 17bis(5)(iv))

Further, with regard to an amendment made for the purpose (b) listed above, the invention identified by the matters stated in the claims after the amendment shall be independently patentable (requirements for independent patentability) (Article 17bis(6) and Article 126(7)).

In addition, the handling of an amendment which does not satisfy the substantive requirements shall also differ in accordance with the timing of amendment. In the case where an amendment does not satisfy the substantive requirements at the timing 3.1 or 3.2(1), the amendment shall become a reason for refusal. In the case where an amendment does not satisfy the substantive requirements at the timing 3.2(2), the amendment shall be dismissed.

The relation between the timing of amendment and the substantive requirements and the handling of an amendment which does not satisfy the substantive requirements are as shown in the following figure.

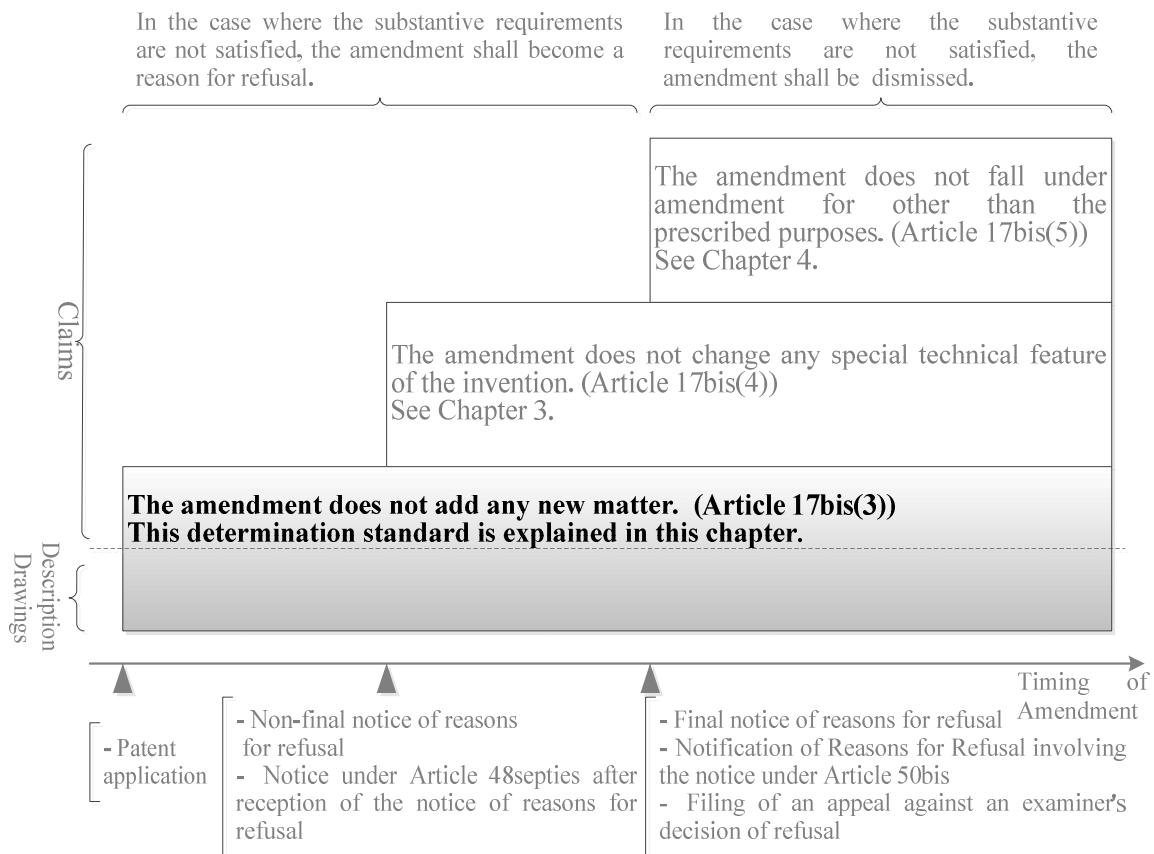


4. Procedures of Examination concerning Determination on Amendment
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The procedures of examination concerning a determination on an amendment which are common to "Chapters 2 Amendment Adding New Matter" to "Chapter 4 Amendment for other than the Prescribed Purposes" shall be as follows. At the time of proceeding with the examination, also see "Chapters 2 Amendment Adding New Matter" to "Chapter 4 Amendment for other than the Prescribed Purposes" and "Part I Outline of Examination."

- (1) In the case where the examiner determines that an amendment satisfies the substantive requirements in light of the determination standards in "Chapters 2 Amendment Adding New Matter" to "Chapter 4 Amendment for other than the Prescribed Purposes", the examiner shall perform an examination based on the description, etc. after the amendment.
- (2) In the case of 3.1 or 3.2 (1), in the case where the examiner determines that an amendment does not satisfy the substantive requirements in light of the determination standards in "Chapter 2 Amendment Adding New Matter" and "Chapter 3 Amendment Changing Special Technical Feature of Invention", the examiner shall perform an examination based on the description, etc. after the amendment, and issue a notice of reasons for refusal to the effect that the amendment does not satisfy the substantive requirements.
- (3) In the case of 3.2 (2), in the case where the examiner determines that an amendment does not satisfy the substantive requirements in light of the determination standards in "Chapters 2 Amendment Adding New Matter" to "Chapter 4 Amendment for other than the Prescribed Purposes", the examiner shall dismiss the amendment, and then perform an examination based on the description, etc. before submission of the written amendment.
- (4) At the time of issuing the notice of reasons for refusal, decision to dismiss the amendment to the effect that the amendment does not satisfy the substantive requirements, the examiner shall point out an amended matter which is determined not to satisfy the substantive requirements, and specifically explain the reasons therefor.

Chapter 2 Amendment Adding New Matter (Patent Act Article 17bis(3))



1. Overview

The Patent Act allows amendment of the description, etc. (see 1. in "Chapter 1 Requirements for Amendments"). However, because the amendment exerts retroactive effects with respect to the filing of the patent application, allowing an amendment having contents beyond the scope of the matters stated in the description, etc. at the time of filing (In this part, hereinafter, referred to as "originally attached description, etc.") after the filing of the patent application would violate the first-to-file principle.

In view of the above, in order to substantially secure the first-to-file principle and balance conflicting interests between the applicant and third parties while allowing amendments for the applicant, Article 17bis(3) of the Patent Act provides that any amendment of the description, etc. shall be made within the scope of the matters stated in the originally attached description, etc. That is, Article 17bis(3) of the Patent Act provides that any new matter shall not be added.

Such a provision shall fulfill the functions of:

- (i) securing sufficient disclosure of the invention as of the filing and guaranteeing a prompt grant of right;
- (ii) ensuring fairness of handling between a patent application which sufficiently discloses the invention as of the filing and a patent application which does not sufficiently disclose the invention as of the filing; and
- (iii) preventing a third party who acted based on the scope of the invention disclosed as of the filing from suffering unexpected disadvantages and reducing a monitoring burden on the third party.

The determination standards on whether an amendment adds any new matter are explained in this chapter.

2. Basic Way of Thinking about Determination on New Matter

The examiner shall determine whether an amendment is an amendment which adds any new matter by determining whether the amendment introduces any new technical matter in connection with "the matters stated in the originally attached description, etc." "The matters stated in the originally attached description, etc." shall refer to technical matter derived by totalizing the whole statement in the originally attached description, etc. by a person skilled in the art.

If an amendment does not introduce any new technical matter in connection with "the matters stated in the originally attached description, etc.,," the amendment shall not add a new matter. On the other hand, if an amendment introduces any new technical matter in connection therewith, the amendment shall be an amendment which adds any new matter.

(Reference) A request for reverse of trial decision, Decision by the Intellectual Property High Court, Grand Panel, May 30, 2008 [Heisei 18 (Gyo Ke) No. 10563] "Solder Resist"

"The "matters stated in the description or drawings" are disclosed to third parties by the applicant as a prerequisite for gaining a monopoly based on a patent right for an invention, the highly advanced creation of technical ideas, and such "matters" must be technical matters concerning the invention disclosed in the description or drawings. And the "matters stated in the description or drawings" mean technical matters that a person skilled in the art can understand, taking into account all statements in the description or drawings. Where an amendment does not add any new technical matters to the technical matters that can be understood in this manner, the amendment can be deemed to be made within the "scope of the matters stated in the description or drawings."

... the matters stated in the description or drawings are usually related to the technical idea disclosed in the description or drawings. Thus, for example, where a correction to add limitations on the claims is to be made for the restriction the claims, if the matters of correction to be added are explicitly stated in the description or drawings, or if they are obvious from such statements, unless there are special circumstances, such correction shall be found to have not added any new technical matters and can be deemed to be made within the "scope of matters stated in the description or drawings." In practice, this method of determination appears to be appropriate for many cases. "

3. Specific Determination on New Matter

The examiner shall determine whether an amendment is an amendment which adds any new matter, according to a determining method based on each of the following amendment examples 3.1 to 3.3.

3.1 Amendment made to matters explicitly stated in the originally attached description, etc.

In the case where an amended matter is a "matter explicitly stated in the originally attached description, etc.," because the amendment shall not introduce any new technical matter, the amendment shall be permitted. Therefore, the examiner shall determine that, in such cases, the amendment does not add any new matter.

3.2 Amendment made to matters obvious from the statement in the originally attached description, etc.

In the case where an amended matter is a "matter obvious from the statement in the originally attached description, etc.," even if the amended matter is not explicitly stated in the originally attached description, etc., because the amendment shall not introduce any new technical matter, the amendment shall be permitted. Therefore, the examiner shall determine that, in such cases, the amendment does not add any new matter.

In order to find that amended matters are "matters obvious from the statement in the originally attached description, etc.," it is required that a person skilled in the art who contacts the originally attached description, etc. understands the amended matters

as if the amended matters were stated in the originally attached description, etc., in light of the common general knowledge as of the filing. The examiner shall take note of the following (i) and (ii) for determining whether the amended matters are "matters obvious from the statement in the originally attached description, etc."

- (i) The technology concerning an amended matter cannot sufficiently be considered as a "matter obvious from the statement in the originally attached description, etc." just because the technology itself is well-known art or commonly used art.
- (ii) In some cases, a person skilled in the art may understand that an amended matter is obvious from several statements in the originally attached description, etc. in light of the common general knowledge as of the filing. The several statements in the originally attached description, etc. are, for example, a statement of the problem to be solved by the invention and a statement of examples of the invention, or a statement of the description and a statement of the drawing.

Example: The originally attached description, etc. only states a device with an elastic support, and does not disclose a specific elastic support. However, in the case where a person skilled in the art understands that the "elastic support" obviously means a "helical spring" in light of the statement in the originally attached drawings as well as the common general knowledge as of the filing, an amendment which changes the term "elastic support" to a "helical spring" shall be permitted.

3.3 Various amendments

Even in the case where an amended matter does not fall under any of the amendments 3.1 and 3.2 described above, if the amendment does not introduce any new technical matter in view of the "matters stated in the originally attached description, etc.," the amendment shall be permitted. The examiner shall determine whether an amendment adds any new matter, also in consideration of the cases where the amendment is permitted and the cases where the amendment is not permitted as explained below for each of various amendments.

3.3.1 Amendment of the claims

- (1) In the case of an amendment which converts the matters specifying the invention

into generic concepts or deletes or changes them

- a In the case where an amendment which converts the matters specifying the invention in a claim into generic concepts or deletes or changes them introduces any new technical matter, such an amendment shall not be permitted.
- b On the other hand, even in the case of an amendment which converts the matters specifying the invention in a claim into generic concepts or deletes or changes them, particularly, in the case of an amendment which deletes part of the matters specifying the invention in a claim, if it is obvious that the amendment does not add any new technical significance, the amendment does not introduce any new technical matter. Therefore, such an amendment shall be permitted (Example 1).

For example, in the case where a matter to be deleted is not related to a problem to be solved by the invention and is obviously an optional additional matter from the statement in the originally attached description, etc., the amendment does not add any new technical significance in many cases.

(Amendment for deleting part of the matters specifying the invention (Example of paragraph b above))

Example 1: Amendment for changing "an impurity diffusion region that constitutes a source and a drain" to "an impurity region that constitutes a source and a drain" in claims of the invention relating to a compound semiconductor device with a double-hetero structure.

(Explanation)

In this example, the invention claimed in the patent application relates to a semiconductor layer in an active region consisting of a specific structure and material. The original claim unintentionally states that a source and a drain consist of "an impurity dispersion area" in a limited manner. However, the source and the drain are not limited to using dispersion. Any impurity area is sufficient, which is obvious from the statement in the originally attached description, etc., and the amendment does not change the technical significance of the invention at all.

(2) In the case of an amendment which converts the matters specifying the invention into more specific concepts or adds them

- a In the case of an amendment which restricts part of the matters specifying

the invention in a claim and converts it into more specific concepts up to the matters explicitly stated in the originally attached description, etc. or the matters obvious from the statement in the originally attached description, etc., the amendment does not introduce any new technical matter. Therefore, such an amendment shall be permitted.

- b Even in the case where an amendment which converts the matters specifying the invention in a claim into more specific concepts is not made up to the matters explicitly stated in the originally attached description, etc. or the matters obvious from the statement in the originally attached description, etc., if it is obvious that the amendment does not add any new technical significance, the amendment does not introduce any new technical matter. Therefore, such an amendment shall be permitted (Examples 2 and 3).
- c On the other hand, even in the case of an amendment which converts the matters specifying the invention in a claim into more specific concepts, if matters other than those stated in the originally attached description, etc. are individuated by the amendment, the amendment introduces any new technical matter. Therefore, such an amendment **shall not be permitted**.

Note that (a) to (c) described above also apply to an amendment which adds the matters specifying the invention in series.

(Amendment for restricting part of the matters specifying the invention (Example of paragraph b above))

Example 2: Amendment for changing "a recording or reproducing apparatus" of claims into "a disc recording or reproducing apparatus."

(Explanation)

In this example, what is stated in the originally attached description, etc. as a specific example is a reproducing apparatus intended for CD-ROMs. Meanwhile, according to another statement in the originally attached description, etc., the present invention is an invention having an object to reduce battery power consumption by adjusting the power supply when the recording and/or reproducing apparatus receives no operation command. Therefore, it is extremely clear that the present invention may be applied to not only a reproducing apparatus intended for CD-ROMs but also any disk recording and/or reproducing apparatus, in light of the content of the another statement in the originally attached description, etc.

Example 3: Amendment for changing the term "work piece" of claims into the term "rectangular work piece."

(Explanation)

In this example, the originally attached description, etc. explicitly states that the subject to be applied by a coating device of the claimed invention is "the work piece" such as glass substrate or wafer. What is stated as a specific example is only an approximately quadrate work piece, but the "rectangular shape" is obviously a typical shape of a typical glass substrate. Therefore, an amendment which changes "the work piece" to "the rectangular work piece" is made within the scope of the matters stated in the originally attached description, etc.

(3) In the case of an amendment which adds or changes numerical limitation

- a In the case of an amendment which adds numerical limitation, if the added numerical limitation does not introduce any new technical matter, such an amendment shall be permitted.

For example, if the numerical limitation "preferably 24 to 25 degrees" is explicitly stated in the detailed description of the invention, an amendment for adding said numerical limitation to claims is permitted.

If examples of 24 degrees Celsius and 25 degrees Celsius are stated, this cannot be a direct basis for permitting an amendment which adds the numerical limitation of "24 to 25 degrees Celsius", but it may be perceived, in some cases, that a specific scope of 24 to 25 degrees Celsius is referred to in light of the whole statement in the originally attached description, etc. Examples of such cases include the case where 24 degrees Celsius and 25 degrees Celsius are perceived to be stated as border values of upper limit, lower limit, etc. of a certain consecutive numerical scope in light of the statement of the problem, effect, etc. In this case, unlike cases of absence of an example, it can be evaluated that the numerical limitation was stated originally, and any new technical matter is not introduced. Therefore, such an amendment shall be permitted.

- b In the case of an amendment which changes border values of upper limit, lower limit, etc. of a numerical scope stated in a claim to set a new numerical scope, if the following conditions (i) and (ii) are both satisfied, the amendment does not introduce any new technical matter. Therefore, such an amendment shall be permitted.

- (i) The border values of the new numerical scope are stated in the

originally attached description, etc.

- (ii) The new numerical scope is included in the numerical scope stated in the originally attached description, etc.

(4) In the case of an amendment which provides a disclaimer

"Disclaimer" refers to claims explicitly stating exclusion of only part of matters included in the claimed inventions from matters stated in said claims, while leaving the expression of the statement of matters stated in the claims.

"Disclaimer," which excludes matters stated in the originally attached description, etc. through amendment while leaving the expression of the statement of matters stated in claims before amendment, is permitted if the "disclaimer" after exclusion does not introduce any new technical matter.

The amendment to provide a "disclaimer" in the following (i) and (ii) does not introduce any new technical matter, and the amendment is permitted.

- (i) The amendment to exclude only the overlap in cases where the claimed invention overlaps the cited invention and is thus likely to lose novelty, etc. (Article 29(1)(iii), Article 29bis or Article 39)

(Explanation)

The "disclaimer" in (i) described above refers to a claim explicitly stating exclusion of only matters stated in publications, etc. or the description, etc. of earlier patent applications (including matters which are deemed as being stated therein) as the cited invention relating to Article 29(1)(iii), Article 29bis or Article 39.

The amendment to provide the "disclaimer" in the above-mentioned (i) does not change technical matter introduced from the description, etc. before the amendment at all by excluding specific matters that are contained in the cited invention. It is thus evident that such amendment does not introduce any new technical matter.

In addition, amending claims to provide the "disclaimer" makes them patentable if the invention is remarkably different from the cited invention as the technical idea, and inherently involves an inventive step but the invention accidentally overlaps the cited invention. It is considered that if the invention is not remarkably different from the cited invention as the technical idea, amending claims to provide the "disclaimer" rarely eliminates a reason for refusal for lack of

inventive step.

Moreover, if parts of "disclaim" occupy a major portion of the claimed invention or extend to many portions, the examiner shall note that an invention may not be clearly identified from one claim. (See 2.1(1) of "Part II Chapter 2 Section 3 Clarity Requirement").

Example 4:

[Claims before the amendment]

An iron plate washing agent mainly consisting of an inorganic salt containing Na ion as a cation

[Cited Invention]

An iron plate washing agent mainly consisting of an inorganic salt containing CO₃ ion as an anion

(Specific example: A cation is Na ion)

(Explanation)

In this case, an amendment which changes the claims to "... an inorganic salt containing Na ion as a cation (excluding cases where an anion is CO₃ ion)" for the purpose of excluding the overlapping matters with the cited invention from the claims shall be permitted.

- (ii) In the case where the claimed invention includes the term "human being" and thus does not fulfill the requirement of the main paragraph of Article 29(1) or falls under the category of unpatentable invention under Article 32, an amendment which excludes only the term "human being"

(Explanation)

The amendment to provide the "disclaimer" in the above-mentioned (ii) to exclude "human being" from the subject of invention to eliminate said reason for refusal does not change the technical matter introduced from the description, etc. before amendment at all. It is thus evident that such amendment does not introduce any new technical matter.

Example 5:

[Claims before the amendment]

A mammal characterized in that a polynucleotide having DNA Sequence No. 1 is introduced into the somatic chromosomes and that the polynucleotide

is expressed in its somatic cells

(Explanation)

In this case, "a mammal" includes human beings unless the detailed description of the invention makes it clear that "a mammal" does not include human beings. However, an invention that includes human beings themselves as its subject falls under an invention that is likely to harm public order and morality, and it breaches Article 32.

In this case, an amendment for changing the claim to "mammals excluding human beings ..." in order to exclude human beings from the claim is permitted even if the original description, etc. did not state that human beings can be excluded from the subject of the invention.

(5) In the case of an amendment made to a claim in an alternative form such as a Markush form

- a In a claim written in an alternative form such as the Markush-Form, an amendment for removing part of the alternatives is permitted if the remaining matters used to specify the invention do not introduce any new technical matter.
- b In the case where the originally attached description, etc. includes combinations of many alternatives for stating a chemical substance, it may not be perceived that a combination of specific alternatives added or left by the following amendment (i) or (ii) does not introduce any new technical matter.
 - (i) An amendment which adds a combination of specific alternatives to a claim within the scope of the many alternatives stated in the originally attached description, etc.
 - (ii) An amendment which leaves a combination of specific alternatives in a claim as a result of the deletion of alternatives

For example, if a substituted group that had several alternatives as of the filing has only one alternative as a result of the amendment and has no room for change, the amendment is not permitted except when employing a combination of such specific alternatives has been stated in the originally attached description, etc. (see an example of (c) below). This is because the original statement as alternatives would not mean employing a specific alternative.

- c On the other hand, if an alternative has been removed so that an alternative

accompanied by an example statement is all that remains, it may be found that the remaining alternative does not introduce any new technical matter in view of the whole statement of the originally attached description, etc. including the example.

For example, if a group of chemical substances in a form of a combination of substituted groups with several alternatives is stated in the originally attached description, etc., an amendment for leaving only the statement of the (group of) chemical substances consisting of the combination of specific alternatives corresponding to "a single chemical substance" that was stated in an example, etc. in the originally attached description is permitted.

3.3.2 Amendment of the description

(1) In the case of an amendment which adds contents of a prior art document

a Pursuant to Article 36(4)(ii), the prior art document information (the name of a publication in which the relevant invention is stated and the location of other information concerning the invention known to the public through the publication) is required to be stated (see 2.2.1 and 2.3.1 in "Part II Chapter 1 Section3 Requirements for Disclosure of Information on Prior Art Documents"). An amendment which falls under any of the following amendments (i) and (ii) does not introduce any new technical matter. Therefore, such an amendment shall be permitted.

(i) An amendment which adds the prior art document information to the detailed description of the invention

(ii) An amendment which adds contents stated in the document to "Background Art" of the detailed description of the invention

b However, an amendment which falls under any of the following amendments (i) and (ii) introduces any new technical matter. Therefore, such an amendment shall not be permitted.

(i) An amendment which adds information on evaluation of the invention, such as comparison with the invention claimed in the patent application, or information on implementation of the invention

(ii) An amendment which adds contents stated in the prior art document to eliminate violation of Article 36(4)(i)

(2) In the case of an amendment which adds effects of the invention

- a In general, an amendment which adds effects of the invention introduces any new technical matter. Therefore, such an amendment shall not be permitted.
- b However, in the case where the originally attached description, etc. explicitly states the structure, operation, or function of the invention and where effects of the invention are obvious from this statement, an amendment which adds the effects of the invention does not introduce any new technical matter. Therefore, such an amendment shall be permitted.

(3) In the case of an amendment which resolves a mismatch statement

If two or more kinds of inconsistent statements are present in the description, etc. and it is evident to a person skilled in the art from the statement of the originally attached description, etc., which of them is correct, an amendment for matching it with the correct statement is permitted, since the amendment does not introduce any new technical matter.

(4) In the case of an amendment which clarifies an unclear statement

If the statement is not in itself unclear but its original meaning is evident to a person skilled in the art from the statement of the originally attached description, etc., an amendment for making it clear is permitted since the amendment does not introduce any new technical matter.

(5) In the case of an amendment which adds a specific example

In general, an amendment which adds a specific example of the invention introduces any new technical matter. Therefore, such an amendment shall not be permitted.

For example, in a patent application for a rubber composition consisting of several ingredients, an amendment for adding information that "a specific ingredient may be added" is not permitted in general.

Similarly, an amendment for adding information that "a helical spring may be used as an elastic support" is not permitted when the originally attached description, etc. describes a device that has an elastic support without disclosing a specified elastic support in general.

(6) In the case of an amendment which adds an irrelevant or inconsistent matter

An amendment which adds a matter irrelevant to or inconsistent with the matters stated in the originally attached description, etc. introduces any new technical matter. Therefore, such an amendment shall not be permitted.

Example 6: An amendment which adds the statement "In general, in order to freely insert a fishing line into a hole, it is preferable to secure a large region for the hole. If a hole which is long in the width direction of a rod pipe is provided to a portion of the rod pipe, the strength of this portion significantly decreases. Meanwhile, if a long hole which is long in the axial direction of the rod pipe is provided and this enables the hole to be larger, the decrease in strength can be prevented." to the detailed description of the invention

(Explanation)

In this example, the originally attached description, etc. states that a long hole which is long in the axial direction of a rod pipe is provided to the rod pipe on the premise that a tubular guide for inserting a fishing line into the rod pipe is fitted in the rod pipe. Since there is no room for the adoption of a long hole which is long in the width direction as a long hole for fitting the tubular guide in the first place, the comparison in strength with the long hole which is long in the width direction is irrelevant to the matters stated in the originally attached description, etc. Therefore, the amended matter is irrelevant to the technology stated in the originally attached description, etc., and this amendment adds a new matter.

4. Procedures of Examination concerning Determination on New Matter

The procedures of examination concerning a determination on a new matter shall be as follows. At the time of proceeding with the examination, also see 4. in "Chapter 1 Requirements for Amendments" , " Part I Chapter 2 Section 4 Handling of Written Opinion, Written Amendment, etc." and " Part I Chapter 2 Section 6 Decision of Dismissal of Amendment ."

- (1) In the case where the examiner is convinced that an amendment does not introduce any new technical matter with reference to 3. , the examiner shall proceed with the examination on the premise that the amendment does not add any new matter.
- (2) In the case where the examiner is convinced that an amendment introduces any new

technical matter with reference to 3. , the examiner shall issue a notice of reasons for refusal or a decision to dismiss the amendment to the effect that the amendment adds any new matter. At the time of issuing the notice of reasons for refusal or the decision to dismiss the amendment, the examiner shall point out an amended matter which is determined to introduce any new technical matter, and specifically explain the reasons therefor.

(3) Even in the case where an amendment does not fall under any of the following cases (1) and (2) but falls under either (i) or (ii), the examiner shall determine that the amendment adds any new matter and issue a notice of reasons for refusal or a decision to dismiss the amendment.

(i) The case where the amendment does not fall under any of the situations where the amendment is permitted as explained in 3. .

(ii) The case where there is no explanation from the applicant and accordingly where the correspondence relation between the content of the amendment and the matters stated in the originally attached description, etc. is not known

At the time of issuing the notice of reasons for refusal or the decision to dismiss the amendment, the examiner shall specifically explain the reasons why the amendment falls under any of the cases (i) and (ii) described above.

In response to the notice of reasons for refusal, the applicant may make a specific argument or clarification on the fact that the amendment does not introduce any new technical matter, for example, the fact that the amendment falls under any of the situations where the amendment is permitted as explained in 3. . As a result, in the case where the examiner becomes convinced that the amendment does not introduce any new technical matter, the reasons for refusal shall be resolved. In the case where the examiner does not become convinced that the amendment does not introduce any new technical matter, the examiner shall issue a decision of refusal based on the reason for refusal to the effect that the amendment adds any new matter.

5. Points to note

(1) Even an amendment of the drawings shall be permitted unless the amendment introduces any new technical matter. However, the examiner should note that any new technical matter is generally introduced into the drawings after the amendment

in many cases. In particular, in the case where photographs attached to the application, etc. instead of drawings are replaced after filing of the patent application, such an amendment may introduce any new technical matter, and hence the examiner should note such a case. An examiner shall notice that drawings do not always reflect the actual dimension.

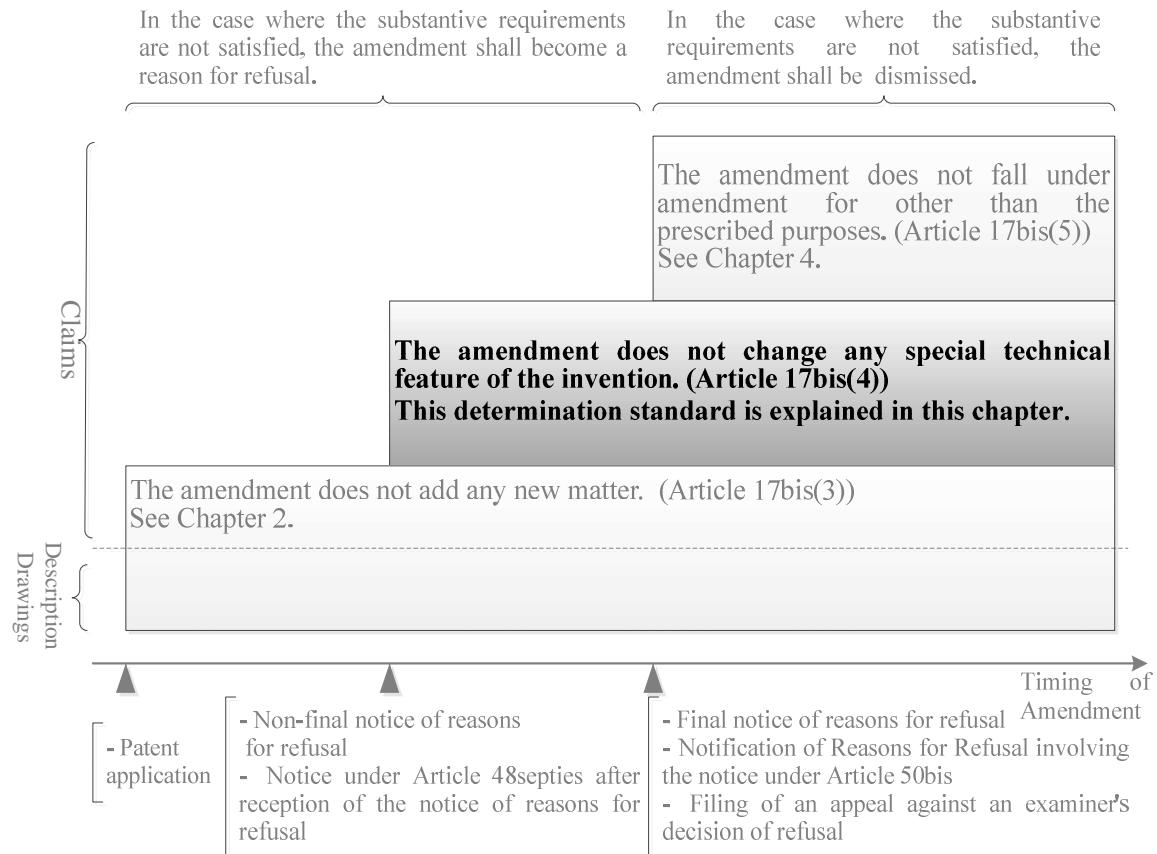
- (2) A priority certificate (Note) is not included in the description, etc. Therefore, the examiner cannot make determination on whether the amendment adds any new matter based on the priority certificate.

(Note) A priority certificate in cases of priority under the Paris Convention, etc. provided in Article 43(2), 43bis(1) and 43ter, or filing documents of an earlier application in case of an internal priority provided in Article 41.

Note: When any ambiguity of interpretation is found in this provisional translation, the Japanese text shall prevail.

Part IV Chapter 3 Amendment Changing Special Technical Feature of Invention

Chapter 3 Amendment Changing Special Technical Feature of Invention (Patent Act Article 17bis(4))



1. Overview

Article 17bis(4) of the Patent Act is a provision for prohibiting an amendment which changes a special technical feature of an invention. The amendment which changes the special technical feature of the invention is an amendment after which the requirements of unity of invention are not fulfilled between the following inventions (i) and (ii), and Article 17bis(4) extends the requirements of unity of invention under Article 37 to between the inventions stated in the claims before and after the amendment.

- (i) All the inventions for which it is determined whether the invention is unpatentable in a notice of reasons for refusal, among the inventions stated in the claims before the amendment

- (ii) All the inventions identified by the matters stated in the claims after the amendment

If an amendment which changes a special technical feature of an invention is made, it may become impossible for the examiner to effectively utilize results of prior art searches and examinations which have been conducted until then. In this case, the examiner needs to conduct the prior art searches and examinations again, and hence a prompt and accurate grant of right is hindered. In addition, fairness of handling between patent applications cannot be sufficiently ensured. In light of these points, Article 17bis(4) is established in the Patent Act.

Meanwhile, even if an amendment which changes a special technical feature of an invention is made, as long as there is no substantive deficiency in the invention, there is a mere formal deficiency that the applicant should have divided the application into two or more patent applications in order for it to be examined. Accordingly, it does not directly inflict serious damages on the interests of third parties, even if the patent application to which the amendment which changes the special technical feature of the invention is made is patented. Therefore, failure to fulfill the requirements of Article 17bis(4) constitutes a reason for refusal, but does not constitute a reason for invalidation.

Considering these circumstances, the examiner shall not make an unnecessarily strict determination on whether an amendment is an amendment which changes a special technical feature of an invention.

2. Determination on Amendment Which Changes Special Technical Feature of Invention

For determining whether an amendment is an amendment which changes a special technical feature of an invention, the examiner shall determine whether a patent application fulfills the requirements of Article 37 assuming that the following inventions (i) and (ii) were filed with the same request.

In the case where the patent application does not fulfill the requirements of Article 37, the examiner shall determine that the amendment is an amendment which changes a special technical feature of an invention.

- (i) All the inventions for which it is determined whether the invention is unpatentable in a notice of reasons for refusal (Note)

- (ii) All the inventions identified by the matters stated in the claims after the amendment

(Note) In this chapter, "the inventions for which a determination on patentability is shown in a notification of reasons for refusal" refer to inventions for which the requirements of novelty (Article 29(1)), inventive step (Article 29(2)), secret prior art (Article 29bis), and prior application (Article 39) have been examined. Since the purpose of Article 17bis(4) is to effectively utilize prior art searches and examinations which have been conducted before the amendment, the examiner shall make a determination based on inventions for which the requirements of the above-mentioned clauses which require prior art searches have been examined, among the inventions before the amendment.

Note that inventions for which reasons for refusal such as lack of novelty, inventive step, secret prior art, prior application, etc. have not been found as a result of the examination are also "the inventions for which a determination on patentability is shown in a notification of reasons for refusal."

(Explanation)

In view of the fact that Article 17bis(4) extends the requirements of unity of invention under Article 37 to between the inventions stated in the claims before and after the amendment, the examiner shall make a determination on whether an amendment is an amendment which changes a special technical feature of an invention pursuant to a determination on whether the requirements of Article 37 are fulfilled.

3. Specific Procedures for Determining Whether Amendment is Amendment Which Changes Special Technical Feature of Invention

3.1 Specific determination procedures

According to the following procedures (1) to (3), the examiner shall determine whether an amendment is an amendment which changes a special technical feature of an invention.

- (1) It is assumed that all the inventions identified by the matters stated in the claims after the amendment are stated subsequently to all the inventions for which it is determined whether the invention is unpatentable in a notice of reasons for refusal.

- (2) On this assumption, it is determined whether the inventions after the amendment become the subject of the examination on requirements other than the requirements of Article 37, in light of 2. in "Part II Chapter 3 Unity of Invention."
- (3) In the case where any of the inventions does not become the subject of the examination as a result of the determination in (2), it is determined that the amendment is an amendment which changes a special technical feature of an invention.

In addition, inventions which become the subject of the examination as a result of the determination in (2) shall be the subject of the examination (Note) on requirements other than the requirements of Article 17bis(4).

(Note) In this chapter, hereinafter the simple expression "subject of the examination" means the subject of the examination on requirements other than the requirements of Article 17bis(4).

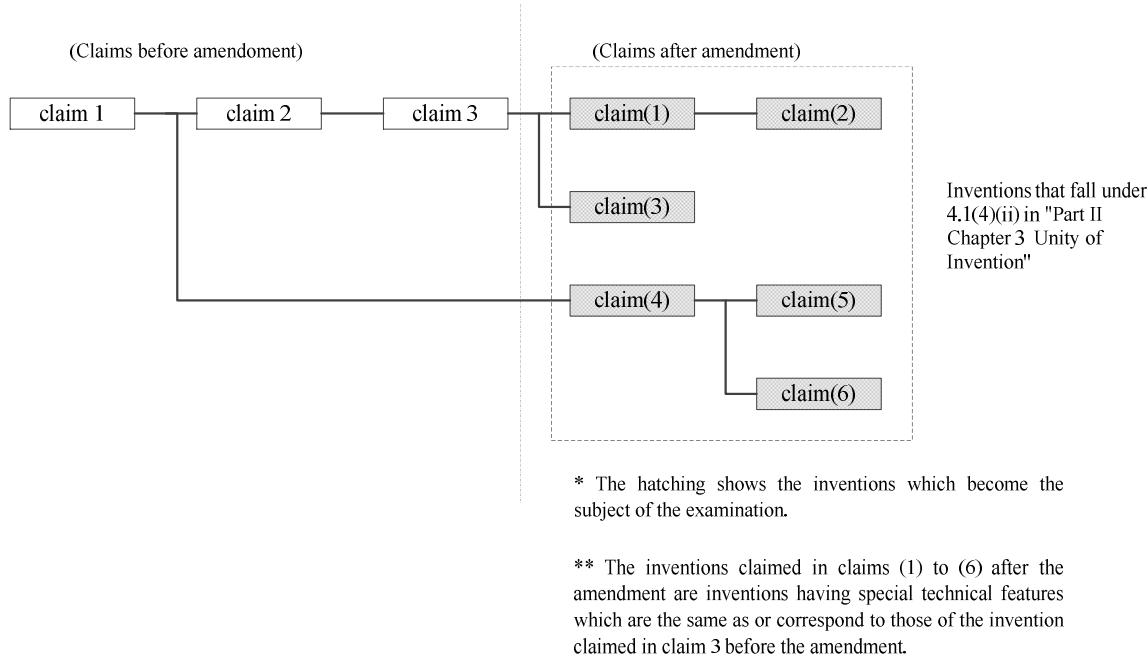
At the time of determining whether an amendment is an amendment which changes a special technical feature of an invention, the examiner shall understand the special technical feature of the invention based on the statement in the description, claims and drawings, the common general knowledge as of the filing and the prior art cited in the notice of reasons for refusal before the amendment.

For example, at the time of determining whether an amendment is an amendment which changes a special technical feature of an invention, the examiner shall not refer to the special technical feature of the invention based on the prior art newly found in the examination after the notice of reasons for refusal.

Example 1:

The inventions of Claims 2, 3 before the amendment are in the same category that includes all matters to specify the inventions of Claims 1, 2 before the amendment, respectively. The inventions of Claims 1, 2 did not have any special technical features, while a special technical feature was found in the invention of Claim 3. Regarding this application, the examiner issued the first notice of reasons for refusal due to lack of novelty to the inventions of Claims 1, 2 and lack of inventive step to the inventions of Claim 3. After said notice of reasons for refusal, the applicant amended the claims regarding Claims (1) to (3) in the same category including all matters to specify the invention of Claim 3 and Claims (4) to (6) including a

special technical feature same as or corresponding to the one found in the invention of Claim 3.



(Explanation)

The examiner assumes that the inventions claimed in claims (1) to (6) after the amendment are stated subsequently to the inventions claimed in claims 1 to 3 before the amendment, that is, assumes that the inventions claimed in claims (1) to (6) after the amendment are the inventions claimed in claims 4 to 9 before the amendment. Then, the examiner determines whether the inventions claimed in claims (1) to (6) become the subject of the examination on requirements other than the requirements of Article 37.

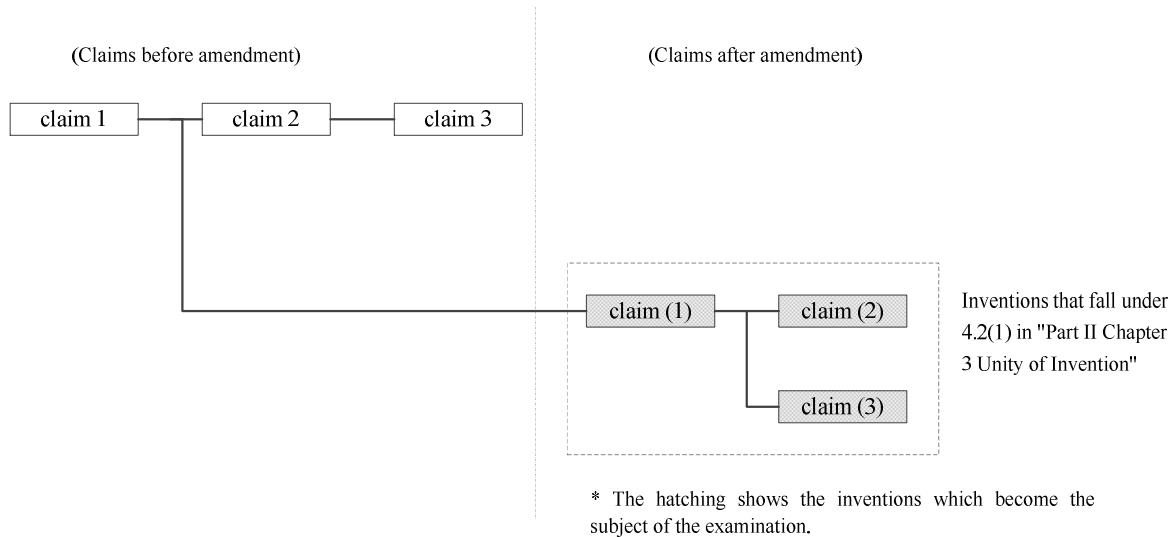
In the case of Example 1, the inventions of Claims (1) to (6) have special technical features same as or corresponding to the one found in the invention of Claim 3. Accordingly, the inventions claimed in claims (1) to (6) become the subject of the examination on requirements other than the requirements of Article 37.

Therefore, this amendment is not an amendment which changes a special technical feature of an invention.

Example 2:

The inventions of Claims 2, 3 before the amendment are in the same category that includes all matters to specify the inventions of Claims 1, 2 before the amendment, respectively. The inventions of Claims 1 to 3 before the amendment did not have any special technical feature and the examiner issued the first notice of reasons for refusal due to lack of novelty of the inventions of Claims 1 to 3 for this application. After said notice of reasons for refusal was issued, the

applicant amended the claims regarding Claims (1) to (3) in the same category including all matters to specify the invention of Claim 1.



(Explanation)

The examiner assumes that the inventions claimed in claims (1) to (3) after the amendment are stated subsequently to the inventions claimed in claims 1 to 3 before the amendment, that is, assumes that the inventions claimed in claims (1) to (3) after the amendment are the inventions claimed in claims 4 to 6 before the amendment. Then, the examiner determines whether the inventions claimed in claims (1) to (3) become the subject of the examination on requirements other than the requirements of Article 37.

In Example 2, the inventions claimed in claims (1) to (3) are inventions in the same category that include all matters specifying the invention of the invention claimed in claim 1. In this case, the inventions claimed in claims (1) to (3) shall be, in principle, the subject of the examination on requirements other than the requirements of Article 37, as inventions on which it is efficient to make an examination together.

Therefore, this amendment is not an amendment which changes a special technical feature of an invention.

However, in the case where the inventions claimed in claims (1) to (3) are inventions which fall under the following case (i) or (ii) and where there is no other reason for considering that it is efficient to make an examination together with the invention claimed in claim 1, the examiner may exclude the inventions claimed in claims (1) to (3) from the subject of the examination on requirements other than the

requirements of Article 37.

In this case, this amendment is an amendment which changes a special technical feature of an invention.

- (i) The case where a problem to be solved by the invention claimed in claim 1 and a specific problem to be solved understood by technical features added to said invention have low relevance
- (ii) The case where technical features of the invention claimed in claim 1 and technical features added to said invention have low technical relevance

3.2 Determination procedures in the case where a notice of reasons for refusal has been issued several times before the amendment

In the case where a notice of reasons for refusal has been issued several times before the amendment, the examiner shall assume that the amendment is made in response to each notice of reasons for refusal, and shall determine, on each of the assumptions, whether the amendment is an amendment which changes a special technical feature of an invention with reference to 3.1.

In the case where it is determined for any of the assumptions that the amendment is an amendment which changes a special technical feature of an invention, the examiner shall determine that the amendment is an amendment which changes a special technical feature of an invention.

In addition, the examiner shall decide inventions which become the subject of the examination on all of the assumptions as a result of the above determination, as the subject of the examination on requirements other than the requirements of Article 17bis(4).

4. Procedures of Examination Concerning Determination on Amendment Which Changes Special Technical Feature

In the case where the examiner determines that an amendment is an amendment which changes a special technical feature of an invention with reference to 3, the examiner shall issue a notice of reasons for refusal or a decision to dismiss the amendment to that effect.

At the time of issuing a notice of reasons for refusal or a decision to dismiss the amendment, the examiner shall specifically explain the reasons why it is determined

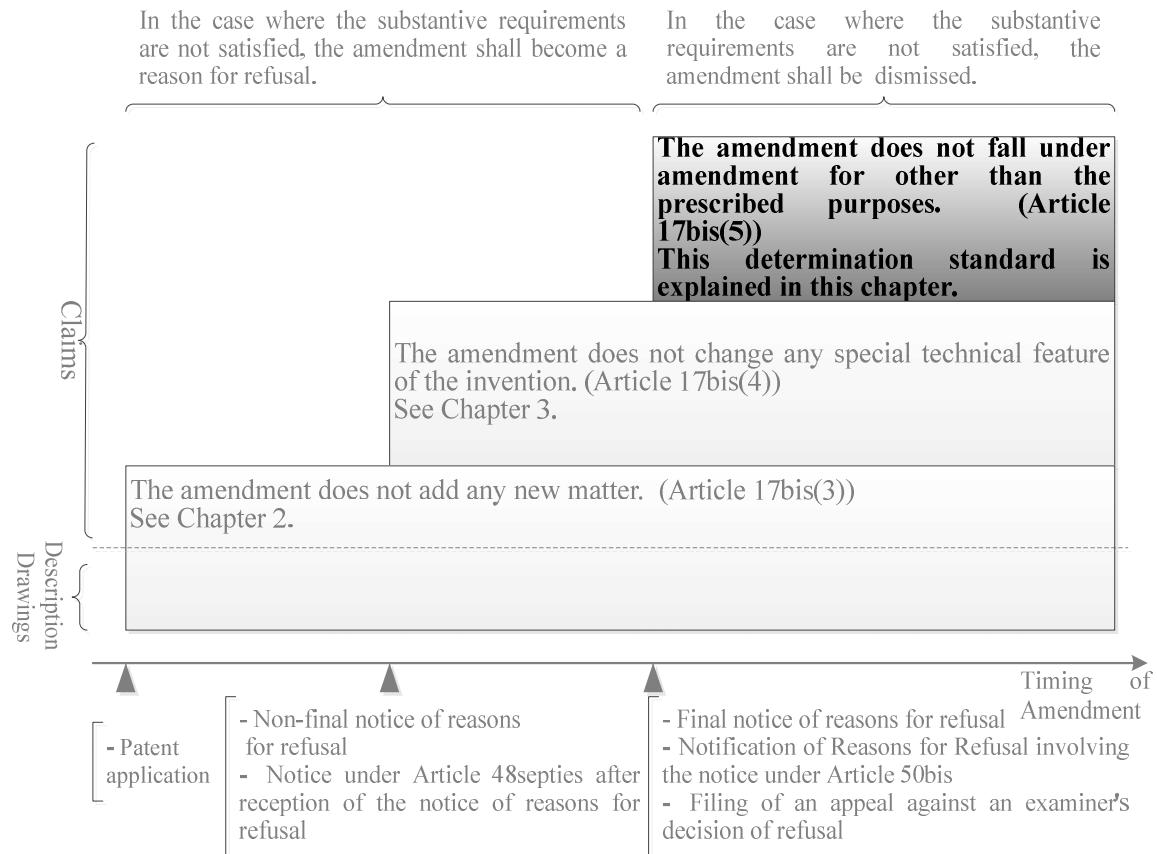
that the amendment is an amendment which changes a special technical feature of an invention, and shall clarify inventions which do not become the subject of the examination.

At the time of proceeding with the examination, also see 4. in "Chapter 1 Requirements for Amendments," "Part I Chapter 2 Section 4 Handling of Written Opinion, Written Amendment, etc." and "Part I Chapter 2 Section 6 Decision of Dismissal of Amendment."

Note: When any ambiguity of interpretation is found in this provisional translation, the Japanese text shall prevail.

Part IV Chapter 4 Amendment for other than the Prescribed Purposes

Chapter 4 Amendment for other than the Prescribed Purposes
(Patent Act Article 17bis(5))



1. Overview

1.1 Patent Act Article 17bis(5)

Article 17bis(5) stipulates that amendments of the claims made at any of the points in time set forth in the time for amendment (i) to (iii) below must be limited to any of the purposes set forth in (a) to (d) below. Amendment in breach of the provision is referred to as “amendment for other than the prescribed purposes.”

Timing of amendment

- (i) Within the period specified in the final notice of reasons for refusal
- (ii) Within the period specified in a notice of reasons for refusal accompanied by notification pursuant to the provision of Article 50bis
- (iii) Simultaneously with an appeal against the examiner's decision of refusal

Purposes

- (a) Deletion of a claim (Article 17bis(5)(i))
- (b) Restriction in a limited way of the claims (Article 17bis(5)(ii))
- (c) Correction of errors (Article 17bis(5)(iii))
- (d) Clarification of an ambiguous statement (Article 17bis(5)(iv))

This provision was established to limit amendments following the issuance of the final notice of reasons for refusal to the scope within which effective use can be made of the examinations already performed, so as to establish examination procedures that help to secure the prompt and proper granting of rights, while paying attention to the basic objective of the patent system; that is, to provide sufficient protection for inventions. The same limitations apply to amendments in response to notification pursuant to the provision of Article 50bis in order to prevent abuse of the divisional application system.

Unlike amendments that add a new matter, amendments in breach of the provision of Article 17bis(5) do not entail substantive deficiencies pertaining to the contents of the invention, and thus does not constitute the ground for invalidation. In applying the provision thereof, therefore, the examiner shall ensure, giving due consideration to the original objective thereof, that it will not be applied more strictly than necessary if the inventions at issue are found to be subject of protection and the examiner believes that the examination already performed can be used effectively to complete the examination process promptly.

1.2 Patent Act Article 17bis(6)

With respect to amendments for restriction in a limited way of the claims (Article 17bis(5)(ii)), Article 17bis(6), applying mutatis mutandis of the provision of Article 126(7), further stipulates that the invention specified by the matters stated in the claims as amended must be independently patentable (requirement of independent patentability).

Amendments for restriction in a limited way of the claims may involve new prior art searches, unlike amendments for other purposes. Should the rule be that new reasons for refusal be notified only after such new prior art searches have revealed the lack of patentability of the amended invention, then a further amendment might be filed, making a further examination necessary; the Patent Act thus stipulates that if the requirement of independent patentability is not satisfied by the amendment for restriction in a limited way of the claims, the amendment shall be dismissed (Article

53(1)), in order to avoid repeated examinations and ensure fair treatment among patent applications.

This requirement is not applicable to amendments of claims not intended for restriction in a limited way of the claims.

1.3 Composition of this Chapter

This Chapter provides explanations of determination standards for those of the requirements applicable to amendments made at such points in time as set forth in any of (i) to (iii) of 1.1 above (paragraphs 3 to 6 of Article 17bis) which are stipulated in paragraphs 5 and 6 of Article 17bis as well as examination procedures, as follows.

Judgment criteria	· Restriction in a limited way of the claims and requirement of independent patentability	See 2
	· Deletion of a claim	See 3
	· Correction of errors	See 4
	· Clarification of an ambiguous statement	See 5
Procedure of examination		See 6

2. Determination on Restriction in a Limited Way of the Claims and the Requirement of Independent Patentability (Articles 17bis(5)(ii) and 17bis(6))

2.1 Restriction in a limited way of the claims (Article 17bis(5)(ii))

The examiner shall determine whether the amendment at issue is intended for restriction in a limited way as prescribed in Article 17bis(5)(ii) if it meets all of the requirements (i) to (iii) below.

- (i) The amendment is intended to restrict the claims (see 2.1.1).
- (ii) The amendment is intended to limit matters necessary for specifying the invention (in this part, herein after referred to as "matters specifying the invention") described in the claims as they stand before the amendment (in this part, herein after referred to as "pre-amendment invention") (see 2.1.2).
- (iii) The pre-amendment invention and the invention as amended (in this part, herein after referred to as "post-amendment invention") are identical to each other in

terms of the field of industrial application and the problems to be solved (see 2.1.3).

2.1.1 The amendment is intended to restrict the claims

The examiner shall make a judgment on "scope restriction" for each claim, in principle; the claims provides a description of the invention for which a patent is sought, on a claim-to-claim basis.

For the avoidance of doubt, the examiner does not need to examine amendments not intended for restriction of the claims in terms of whether they meet the requirements (ii) and (iii) above.

(1) Examples of amendment not intended to restrict the claims

- (i) Amendment that deletes part of the matters specifying the invention laid out in series
- (ii) Amendment that adds an element to alternative statements
- (iii) Amendment that increases the number of claims (except for amendments set forth in (2)(v) and (vi) below)

(2) Examples of amendment intended to restrict the claims

- (i) Amendment that deletes an element from alternative statements
- (ii) Amendment that adds a matter specifying the invention in series
- (iii) Amendment that turns a generic concept into a more specific one
- (iv) Amendment that reduces the cited claims in multiple dependent form claims

Example 1: Amendment that replaces "air conditioner equipment with a mechanism A as described in any one of claims 1 to 3" by "air conditioner equipment with a mechanism A as described in either of claims 1 and 2"

- (v) Amendment that replaces dependent form claims by a lesser number of non-dependent claims

Example 2: Amendment that replaces "air conditioner equipment with a mechanism A as described in any one of claims 1 to 3" (claim dependent on three claims) by "air conditioner equipment with mechanism A as described in claim 1" and "air conditioner equipment with mechanism A as described in claim 2" (two claims)

- (vi) Amendment that changes one claim into plurality of claims by restricting each of matters specifying the invention alternatively stated in said one claim.

2.1.2 The amendment is intended to limit the matters specifying the pre-amendment invention

(1) Recognition of the "matters specifying the invention"

The examiner shall recognize the matters specifying the invention in terms of their operation (such as their workings and roles), based on the statement of the claims and taking the statements of the description and drawings into consideration.

The operation of the matters specifying the invention can often be understood from the statement of the detailed description of the invention (see 3.1.1(2) and (3) of "Part II Chapter 1 Section 1 Enablement Requirement") and common general knowledge as of the filing.

(2) Interpretation of "limit"

Amendments that "limit" the matters specifying the invention refer to either (i) or (ii) below.

(i) Amendment that renders conceptually more specific one or more of the matters specifying the invention as described in the claims prior to amendment (note)

(Note) In respect of the matters specifying the invention (product) by way of its operation (such as a means of realizing its functions), any other matters specifying the invention by way of different operations are generally not recognized as conceptually more specific.

(ii) Amendment that deletes part of the alternatives from claims that express the matters specifying the invention as alternatives, such as Markush form claims

(3) Method for determining

The examiner shall determine whether the amendment at issue is intended to limit the matters specifying the invention, by comparing those identified separately for the pre-amendment invention and for the post-amendment invention.

2.1.3 The pre-amendment invention and the post-amendment invention are identical to each other in terms of the field of industrial application and the problems to be solved

(1) Recognition of the "field of industrial application" and the "problems to be solved"

The examiner shall identify the "field of industrial application" and the

"problems to be solved," based on the matters specifying the invention identified from the statement of the claims and taking into consideration the statement of the technical field to which the claimed invention pertains and the problems to be solved thereby as included in the detailed description of the invention. For the avoidance of doubt, problems to be solved by the invention need not be unresolved ones.

(2) Interpretation of "identical"

The pre-amendment and post-amendment inventions are deemed "identical" to each other in terms of the field of industrial application if either of the conditions (i) and (ii) below is met.

- (i) The technical fields to which they pertain coincide with each other.
- (ii) The technical fields to which they pertain are closely related to each other technically.

The pre-amendment invention post-amendment inventions are deemed "identical" to each other in terms of the problems to be solved by them if either of the conditions (i) and (ii) below is met.

- (i) The problems to be solved by them coincide with each other.
- (ii) The problems to be solved by them are closely related to each other technically.

The following (i) and (ii) are some of the cases in which "the problems to be solved by them are closely related to each other technically."

- (i) The problems to be solved by the post-amendment invention are conceptually more specific than those to be solved by the pre-amendment invention (such as "increasing tensile strength" vs "increasing strength").
- (ii) The pre-amendment and post-amendment inventions address problems of a similar nature (such as "making something compact" vs "reducing the weight of something").

(3) Method for determination

The examiner shall determine whether the pre-amendment and post-amendment inventions are identical to each other in terms of the field of industrial application and the problems to be solved, by comparing those identified separately for the pre-amendment invention and for the post-amendment invention.

It should be noted that the delegated Ministerial Ordinance prescribed in Article 36(4)(i) is applied in such a way that, for inventions like (i) and (ii) set forth below which are found not to address any particular problems, a statement of problems to be solved will not be required (see 2.1(b)(c) of "Part II Chapter 1 Section 2 Ministerial Ordinance Requirement"). In such case, the identity of the problems shall not be a criterion.

- (i) Inventions whose development is based on novel ideas that are totally different from prior art
- (ii) Inventions based on discoveries following trial and error

2.2 Requirement of independent patentability (Article 17bis(6))

Amendments intended for restriction in a limited way of the claims must also meet the requirement of independent patentability.

Independent patentability is examined solely for the claims subject to such amendments. The independent patentability test does not apply to claims subject to amendments that are intended solely for "correction of errors" or "clarification of an ambiguous statement" and not for restriction in a limited way, and claims that are not amended.

Whether or not the post-amendment invention is independently patentable or not shall be determined pursuant to the provisions set forth below. For the points to consider when dismissing amendments on the ground of noncompliance with the requirement of independent patentability, see 3.3 of "Part I Chapter 2 Section 6 Decision of Dismissal of Amendment."

- (i) Patentability and Industrial Applicability (The main paragraph of Article 29 (1))
- (ii) Novelty (Article 29 (1))
- (iii) Inventive Step (Article 29 (2))
- (iv) Prior Art Effect (Article 29 (2))
- (v) Category of Unpatentable Invention (Article 32)
- (vi) Description Requirements (Article 36(4)(i), and Article 36(6)(i) to Article 36(6)(iii)))
- (vii) Prior Application (Article 39(1) to (4))

3. Determination on the Deletion of a Claim (Article 17bis(5)(i))

The examiner shall determine whether the amendment at issue is intended to delete a claim as prescribed in Article 17bis(5)(i) if it falls under either (i) or (ii) below.

(i) Amendment that deletes a claims

(ii) Formal amendment of any other claim as an inevitable result of an amendment for claim deletion

The following (ii-1) or (ii-2) is a specific example of amendment type (ii) above.

(ii-1) Amendment that changes a citation number in other claims which cites the deleted claim

(ii-2) Amendment that changes a dependent claim into an independent one

4. Judgment as to the Correction of Errors (Article 17bis(5)(iii))

The examiner shall determine whether the amendment at issue is intended to correct an error in the description as prescribed in Article 17bis(5)(iii) in light of the definition of "correction of errors" given below.

"Correction of an error" is defined as "correcting an incorrect letter, word, or phrase to present the intended meaning that is obvious from the description, the claims, or the statement of drawings, or otherwise."

5. Determination on Clarification of an Ambiguous Statement (Article 17bis(5)(iv))

The examiner shall determine whether the amendment at issue is intended for a clarification of an ambiguous statement as prescribed in Article 17bis(5)(iv) if it meets both of the requirements (i) and (ii) below.

(i) It is intended to clarify an ambiguous statement (see 5.1).

(ii) It relates to the matters stated in the reasons for refusal in the notice of reasons for refusal (see 5.2).

5.1 The amendment is intended to clarify an ambiguous statement

(1) Interpretation of "ambiguous statement"

"Ambiguous statement" is a statement that is unclear or otherwise linguistically improper.

"Ambiguous statement" about the claims refers to any of (i) to (iii) below.

- (i) The meaning of the statement of a claim is ambiguous.
- (ii) The statement of a claim is unreasonable in relation to any other statement.
- (iii) The statement of a claim is clear, but the invention described in the claim is ambiguous as it cannot be accurately specified technically.

(2) Interpretation of "clarification"

"Clarification" refers to correcting an ambiguous statement to clearly present its "intended meaning."

(3) Method for determining

The examiner shall determine whether or not the amendment at issue is intended to clarify an ambiguous statement, in light of (1) and (2) above. If the claim is clearly stated and the invention is technically clear, an amendment submitted for resolving any of the notified reasons for refusal (such as lack of novelty or inventive step) is not considered to be intended for "clarification of an ambiguous statement."

5.2 The amendment relates to the matters stated in the reasons for refusal in the notice of reasons for refusal

"Clarification of an ambiguous statement" is limited to one that relates to the matters stated in the reasons for refusal in the notice of reasons for refusal. The purpose of this is to prevent the filing of amendments pertaining to any matter not pointed out in the examiner's notice of reasons for refusal that would otherwise lead to the amendment of already examined portions and give rise to new reasons for refusal.

(1) Amendment that "relates to the matters stated in the reasons for refusal"

- Amendment intended to resolve a certain improper statement specified as a reason for refusal in a notice of reasons for refusal pursuant to Article 36

(2) Examples of amendment that do not "relate to the matters stated in the reasons for refusal"

- (i) Amendment that limits any of the matters specifying the invention described in the claims, irrespective of inadequate statements specifically pointed out in a notice of reasons for refusal
- (ii) Amendment that includes in any claim a new technical matter for the resolution of a new problem, irrespective of improper statements specifically pointed out in a notice of reasons for refusal

6. Procedure of Examination Concerning Determination on the Validity of Amendment for Other than the Prescribed Purposes

Presented below is the procedure of examination under paragraphs 5 and 6 of Article 17bis in the case where the claims is amended within the period specified in the final notice of reasons for refusal (Note 1). The procedure of examination as to the satisfaction of the requirements provided for in the paragraphs of Article 17bis shall be stipulated in 3. of "Part I Chapter 2 Section 6 Decision of Dismissal of Amendment." See also 4. of "Chapter 1 Requirements for Amendments."

(Note 1) This includes the following timings (i) and (ii).

- (i) Within the period specified in a notice of reasons for refusal accompanied by notification pursuant to the provision of Article 50bis
- (ii) At the same time when a request is made for an appeal

(1) If the examiner finds under 2. to 5. that the amendment is intended for any of the matters set forth in the items of Article 17bis(5), then the examiner shall proceed with the examination on the assumption that the provision of paragraph 5 is satisfied.

If the examiner finds that the amendment at issue is intended to restrict the claims in a limited way (item (ii)), then the examiner shall examine it also in terms of whether the requirement of independent patentability (paragraph 6) is met (see 2.2).

(2) If the examiner finds under 2. to 5. that the amendment at issue is not intended for any of the matters set forth in the items of Article 17bis(5), then the examiner shall decide to dismiss the amendment (Note 2). If the examiner finds under 2 above

that the amendment at issue is intended to restrict the claims in a limited way (item (ii)) but does not meet the requirement of independent patentability (paragraph 6), then the examiner shall decide to dismiss the amendment (Note 2).

The examiner shall, in his or her dismissal decision, point out the amended matter which he or she finds does not meet the provision of paragraph 5 or 6, and provide a specific explanation of the reasons therefor.

(Note 2) For the amendment made at the same time when a request is made for an appeal (see (ii) of the note 1 above), the examiner shall not decide dismissal of the amendment except for cases of deciding to make a decision to grant a patent (Article 164(2)).

(Points to note)

As set forth in 1.1 above, in applying the provision of paragraph 5, the examiner shall ensure, giving due consideration to the original objective thereof, that it will not be applied more strictly than necessary if the inventions at issue are found to be subject of protection and the examiner believes that the examination already done can be used effectively to complete the examination process promptly.

Note: When any ambiguity of interpretation is found in this provisional translation, the Japanese text shall prevail.

Part IV Amendments of Description, Claims or Drawings

< Relevant Provisions >

Patent Act

(Amendment of Description, Claim or Drawing attached to the application)

Article 17-2

An applicant for a patent may amend the description, scope of claims, or drawings attached to the application, before the service of the certified copy of the examiner's decision notifying that a patent is to be granted; provided, however, that following the receipt of a notice provided under Article 50, an amendment may only be made in the following cases:

- (i) where the applicant has received the first notice (hereinafter referred to in this Article as the "notice of reasons for refusal") under Article 50 (including the cases where it is applied mutatis mutandis pursuant to Article 159(2) (including the cases where it is applied mutatis mutandis pursuant to Article 174(2)) and Article 163(2), hereinafter the same shall apply in this paragraph) and said amendment is made within the designated time limit under Article 50;
- (ii) where, following the receipt of the notice of reasons for refusal, the applicant has received a notice under Article 48-7 and said amendment is made within the designated time limit under said Article;
- (iii) where, following the receipt of the notice of reasons for refusal, the applicant has received a further notice of reasons for refusal and said amendment is made within the designated time limit under Article 50 with regard to the final notice of reasons for refusal; and
- (iv) where the applicant files a request for a trial against an examiner's decision of refusal and said amendment is made at the same time as said request for said trial.

(2) (Omitted)

(3) Except in the case where said amendment is made through the submission of a statement of correction of an incorrect translation, any amendment of the description, scope of claims or drawings under paragraph (1) shall be made within the scope of the matters described in the description, scope of claims or drawings originally attached to the application (in the case of a foreign language written application under Article 36-2(2), the translation of the foreign language documents as provided in Article 36-2(2) that is deemed to be the description, scope of claims and drawings under Article 36-2(6) (in the case where the amendment to the description, scope of claims or drawings has been made through the submission of the statement of correction of an incorrect translation, said translation or the amended description,

scope of claims or drawings); the same shall also apply to Article 34-2(1) and Article 34-3(1).)

(4) In addition to the case provided in the preceding paragraph, where any amendment of the scope of claims is made in the cases listed in the items of paragraph (1), the invention for which determination on its patentability is stated in the notice of reasons for refusal received prior to making the amendment and the invention constituted by the matters described in the amended scope of claims shall be of a group of inventions recognized as fulfilling the requirements of unity of invention set forth in Article 37.

(5) In addition to the requirements provided in the preceding two paragraphs, in the cases of items (i), (iii) and (iv) of paragraph (1) (in the case of item (i) of said paragraph, limited to the case where the applicant has received a notice under Article 50-2 along with the notice of reasons for refusal), the amendment of the scope of claims shall be limited to those for the following purposes:

- (i) the deletion of a claim or claims as provided in Article 36(5);
- (ii) restriction of the scope of claims (limited to the cases where the restriction is to restrict matters required to identify the invention stated in a claim or claims under Article 36(5), and the industrial applicability and the problem to be solved of the invention stated in said claim or claims prior to the amendment are identical with those after the amendment);
- (iii) the correction of errors; and
- (iv) the clarification of an ambiguous statement (limited to the matters stated in the reasons for refusal in the notice of reasons for refusal).

(6) Article 126(7) shall apply mutatis mutandis to cases under item (ii) of the preceding paragraph.

Article 37

Two or more inventions may be the subject of a single patent application in the same application provided that, these inventions are of a group of inventions recognized as fulfilling the requirements of unity of invention based on their technical relationship designated in Ordinance of the Ministry of Economy, Trade and Industry.

(Dismissal of amendments)

Article 53

In the case set forth in Article 17-2(1)(i) or 17-2(1)(iii) (in the case set forth in

Article 17-2(1)(i), limited to the case where the examiner has given a notice under Article 50-2 along with the notice of reasons for refusal), if, prior to the service of the certified copy of the examiner's decision notifying to the effect that a patent is to be granted, an amendment made to the description, scope of claims or drawings attached to the request is found not to comply with paragraphs 3 to 6 of Article 17-2, the examiner shall dismiss the amendment by a ruling.

(2) and (3) (Omitted)

(Trial for Correction)

Article 126

The patentee may file a request for a trial for correction with regard to the correction of the description, scope of claims or drawings attached to the application; provided, however, that such correction shall be limited to the following:

- (i) restriction of the scope of claims;
- (ii) correction of errors or incorrect translations;
- (iii), (iv) (Omitted)

(2) to (6) (Omitted)

(7) In the case of correction for any of the purposes as provided in item (i) or (ii) of the proviso to paragraph (1), an invention constituted by the matters described in the corrected scope of claims must be one which could have been patented independently at the time of filing of the patent application.

(8) (Omitted)

Regulations under the Patent Act

(Unity of Invention)

Article 25octies

(1) The technical relationship designated in Ordinance of the Ministry of Economy, Trade and Industry under Patent Act Article 37 means a technical relationship in which two or more inventions must be linked so as to form a single general inventive concept by having the same or corresponding special technical features among them.

(2) The special technical feature provided in the former paragraph stands for a technical feature defining a contribution made by an invention over the prior art.

(3) The technical relationship provided in the first paragraph shall be examined,

irrespective of whether two or more inventions are described in separate claims or in a single claim written in an alternative form.

Part V

Priority

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Part V Priority

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<Relevant Provisions>

Chapter 1 Priority under the Paris Convention

1. Overview

The priority under the Paris Convention is a right of a person who has filed a patent application in a country of the Union of the Paris Convention (the first country). Such a person may enjoy a benefit for his/her patent application in another country of the Union (the second country), for the purpose of determination of novelty, inventive step, etc., to be treated as filed on the filing date of the application in the first country (hereinafter referred to as "priority date"), as far as the contents were described in the application documents of the application in the first country.

On a person who would like to file patent applications etc. in multiple countries for the same invention, simultaneous filing of patent applications etc. would place a great burden because he/she needs to prepare translation etc. and/or follow different procedures for each country. To reduce such a burden, the Paris Convention provides a system of the priority (Paris Convention Article 4A to I).

The Patent Act Article 43 prescribes the procedures in Japan for claiming the priority under the Paris Convention.

In this Chapter, an application filed in Japan as the second country may be referred to just as an "application filed in Japan."

2. Requirements and Effects of Priority Claim under the Paris Convention

2.1 Person entitled to claim the priority under the Paris Convention

A person who claims the priority under the Paris Convention shall be the national of a country of the Union of the Paris Convention (including a person who is treated as the national of a country of the Union under the Paris Convention Article 3) who has regularly filed a patent application in a country of the Union, or his/her successor (Paris Convention Article 4A(1)).

A person who has assigned his/her right to obtain a patent to others and has not filed a patent application in the first country by himself/herself may file a regular patent application in the second country, but he/she may not claim the priority under Paris Convention based on a patent application filed by the assignee.

2.2 Priority period

The period for filing an application filed in Japan with a claim of the priority under the Paris Convention (the priority period) shall be 12 months from the priority date (Paris Convention Article 4C(1) and (2)).

2.3 Application entitled to serve as a basis for priority claim under the Paris Convention

2.3.1 Regular national application

The application that serves as a basis for the priority claim under the Paris Convention shall be a regular national application filed in a country of the Union of the Paris Convention (Paris Convention Article 4A(1) and (3)).

2.3.2 First application

The application that serves as a basis for the priority claim under the Paris Convention shall be the first application in a country of the Union of the Paris Convention (Paris Convention Articles 4C(2) and(4)). This is because the priority period would be substantively extended if the right of priority were recognized again based on subsequent applications (i.e., cumulatively) for the invention disclosed in the first application.

2.4 Effects of priority claim under the Paris Convention

Any subsequent application shall not be invalidated by reason of any acts accomplished in the period from the priority date to the date of filing in Japan, in particular, (1) another filing, (ii) the publication or exploitation of the invention, or (iii) other acts. Moreover, such acts cannot give rise to any third-party right (Paris Convention Article 4B).

Since the priority under the Paris Convention has such effects, when the effect is recognized, the priority date shall be treated as the date based on which the following requirements (i) to (v) will be determined (hereinafter, that date is referred to as the "relevant date" in this Chapter).

- (i) Novelty (Article 29(1))
- (ii) Inventive step (Article 29(2))
- (iii) Secret Prior Art (Main clause of Article 29bis)
- (iv) Prior application (Articles 39(1) to (4))

- (v) Requirements for independent patentability concerning (i) to (iv) above (Article 126(7) applied as mutatis mutandis under Article 17bis(6))

However, determination of other requirements (for example, Articles 32 and 36) on the patent application claiming priority under the Paris Convention shall be made based on the filing date of the patent application concerned.

In a case of determination of the requirement under Article 29bis (secret prior art) with the patent application claiming priority under the Paris Convention as "another application" prescribed in the article, see "Part III Chapter 3 Secret Prior Art" 6.1.2".

3. Determination of Effect of Priority Claim under the Paris Convention

3.1 Basic idea

3.1.1 Need of determination of the effect of the priority claim under the Paris Convention

The examiner needs to determine whether or not the effect of the priority claim is recognized only when he/she finds prior art and the like which would be a basis of a reason for refusal and has been made available to the public on or after the priority date claimed and before the filing date of the application filed in Japan. Only in such a case, determination of novelty, inventive step, and the like may be changed according to whether the effect of the priority claim under the Paris Convention is recognized.

The examiner may make a determination in advance of the prior art search in cases when determination of the effect of the priority claim under the Paris Convention can be made easily. Determination in advance of the prior art search sometimes contributes to effective examination as it may restrict the target time range of the prior art search.

3.1.2 Subject to be determined

The examiner determines the effect of the priority claim under the Paris Convention on a claim-by-claim basis, in principle. When the claimed elements are expressed by alternatives in a claim, the examiner determines the effect for each invention identified from each alternative. Furthermore, when an embodiment of the claimed invention is newly added in relation to the application in the first country, the effect is determined based on each part, i.e., the added part and the others, respectively.

3.1.3 Comparison with the matter stated in the application documents as a whole of the application filed in the first country

(1) Basic ideas of the comparison

Assume that the description, claims and drawings of the application filed in Japan are amendments of the application filed in the first country (Note). If the claimed invention of the application filed in Japan introduces any new technical matter in relation to the "matters stated in the application documents as a whole of the application filed in the first country," the effect of the priority claim of the Paris Convention shall not be recognized.

Here, the "matters stated in the application document as a whole of the application filed in the first country" mean technical matters that a person skilled in the art understands from the whole description in the application documents of the application filed in the first country, and hereinafter may be referred to as the "matters stated in the application filed in the first country."

(Note) The examiner should note that the application filed in the first country shall be the "first application" (see 2.3.2). See the 3.3, 5.4.1, and 5.4.2 for examples in which whether an application concerned is the "first application" is an issue.

(2) Typical cases where the claimed invention in the application filed in Japan is not considered to be within the scope of the matters stated in the application filed in the first country

a Recitation of matters not stated in the application filed in the first country

When a claimed invention in an application filed in Japan adds any new matter in relation to the matters stated in the application filed in the first country due to recitation of elements which were not stated in the application filed in the first country, the effect of the priority claim under the Paris Convention shall not be recognized. The following cases correspond thereto.

- (i) A case where the structural element stated in the application filed in the first country are combined with a structural element which is newly added to be the claimed invention
- (ii) A case where a selection invention is claimed in the application filed in Japan,

wherein the invention selects a more specific element from an invention of generic concept stated in application filed in the first country

b Addition of an embodiment, deletion of a part of claimed elements, or the like

When the claimed invention in the application filed in Japan is regarded as addition of any new part due to statement of matters which were not stated in the application filed in the first country, e.g., addition of new embodiments etc., or due to deletion of matters stated in the application filed in the first country, e.g., partial deletion of the claimed elements etc., the effect of priority claim under the Paris Convention shall not be recognized for the part concerned.

Concerning these cases, the examiner should note the following points.

- (i) When a part of the claimed invention in the application filed in Japan is recognized to be within the scope of the matters stated in the application filed in the first country, the effect of the priority claim under the Paris Convention can be recognized for the part concerned (see 3.2.1).
- (ii) Even though the effect of the priority claim under the Paris Convention is not partially recognized because of the addition of new embodiments, if, due to the deletion of the embodiments by an amendment, the claimed invention in the application filed in Japan falls within the scope of the matters stated in the application filed in the first country, the effect of the priority claim under the Paris Convention will be recognized.

Example: a case where a part that goes beyond the scope of the matters stated in the application filed in the first country is added, by adding a new embodiment, to the claimed invention in the application filed in Japan, but the claimed invention could be carried out based on the whole description of the application documents of the application filed in the first country without any embodiment

[Application filed in the first country] The claimed invention is a light scanning system comprising mirror angle adjusting means, and only the light scanning system wherein the mirror angle is adjusted by a screw is stated as an embodiment.

[Application filed in Japan] Although the expression of the claimed invention is the same as that in the first application, an embodiment of a light scanning system that automatically adjusts the mirror with a piezoelectric element is newly added.

(Determination of the effect of the priority claim) For the claimed invention in the application filed in Japan, the effect of the priority claim for the part corresponding to the light scanning system that automatically adjusts the mirror with a piezoelectric element is not recognized, but the effect of the priority claim are recognized for the matters within the scope of the matters stated in the application filed in the first country.

(Explanation) In case of this example, the embodiment of automatically adjusting the mirror with a piezoelectric element is not stated in the application filed in the first country. Because of addition of such an embodiment, the claimed invention in the application filed in Japan contains a newly added matter in relation to the matter stated in the application filed in the first country. Therefore, the effect of the priority claim is not recognized for the part added.

c Invention which could not be carried out as of the priority date claimed

When an invention could not be carried out by a person skilled in the art based on the whole description of the application documents of the application filed in the first country and it has become possible for the invention, which is claimed in the application filed in Japan, to be carried out by such a person due to addition of an embodiment or deposition of a biological material and the like, the application filed in Japan contains a newly added matter in relation to the matters stated in the application filed in the first country. Therefore, the effect of the priority claim under the Paris Convention is not recognized in such a case. When the changes in the common general knowledge have made it possible for a person skilled in the art to carry out the invention claimed in the application filed in Japan, the same is applied thereto.

3.2 Partial priority and multiple priorities

An application filed in Japan sometimes contains one or more elements that were not included in the application filed in the first country. The Paris Convention recognizes the claim of priority for the elements included in the application filed in the first country in this case (Paris Convention Article 4F; So-called "partial priority").

In addition, the priority under the Paris Convention can be claimed based on multiple applications filed in the first countries respectively to file an application (Paris Convention Article 4F; So-called "multiple priorities"). The multiple applications filed in the first countries include not only a case where all of them are filed in the same

country, but also a case where they originate from different countries.

In these cases, the effects of the priority claims under the Paris Convention are determined according to 3.2.1 and 3.2.2.

3.2.1 Partial priority

The examiner determines that, only for a part of claimed inventions or a part of alternatives in a claimed invention in the application filed in Japan, which is stated in the application filed in the first country, the priority under the Paris Convention claimed based on the application filed in the first country is recognized.

Example: a case where only a part of alternatives among the claimed invention in the application filed in Japan is stated in the application documents as a whole of the application filed in the first country

[Application filed in the first country] What is claimed is an invention wherein the carbon number of an alcohol is 1 to 5, and only an embodiment wherein the carbon number of the alcohol is 1 to 5 is stated in the application documents as a whole.

[Application filed in Japan] An invention claimed is one wherein the carbon number of the alcohol is 1 to 10.

(Determination of the effect of the priority claim) Since a part of the claimed invention in the application filed in Japan, wherein the carbon number of the alcohol is 1 to 5, is stated in the application filed in the first country, the effect of priority claim is recognized for the part concerned. On the other hand, since the other part of the invention, wherein the carbon number of the alcohol is 6 to 10, corresponds to the addition of new matter in relation to the matters stated in the application filed in the first country, the effect of priority claim is not recognized for that part.

3.2.2 Multiple priorities

- (1) Cases when a part of claimed inventions or a part of alternatives in a claimed invention in the application filed in Japan is stated in one of the applications filed in the first countries, and another part of the claimed inventions or another part of alternatives in the claimed invention in the application filed in Japan is stated in another application filed in the first countries

In this case, the examiner determines whether or not the effect of the priority under the Paris Convention claimed is recognized based on the corresponding application filed in the first country on a claim-by-claim basis or an alternative-by-alternative basis.

Example: a case where the matters stated in the multiple applications filed in the first countries are recited in combination in a claim in the application filed in Japan

[Applications filed in the first countries] An invention, wherein the carbon number of an alcohol is 1 to 5, is stated in an application A filed in a first country. Also, another invention, wherein the carbon number of the alcohol is 6 to 10, is stated in another application B filed in a first country.

[Application filed in Japan] With priority claims based on the both applications A and B, an invention, wherein the carbon number of the alcohol is 1 to 10, (substantial alternative) (Note) is claimed.

(Determination of the effect of the priority claim) Since the claimed invention in the application filed in Japan has substantial alternatives, determination is made for each alternative. For a part of the invention, wherein the carbon number of alcohol is 1 to 5, the effect of the priority claim based on the application A is recognized. For the other part, wherein the carbon number of alcohol is 6 to 10, the effect based on the application B is recognized.

(Note: see “Part III, Chapter 2, Section 3 Procedure of Determining Novelty and Inventive Step,” 4.1.1 (Note 1).)

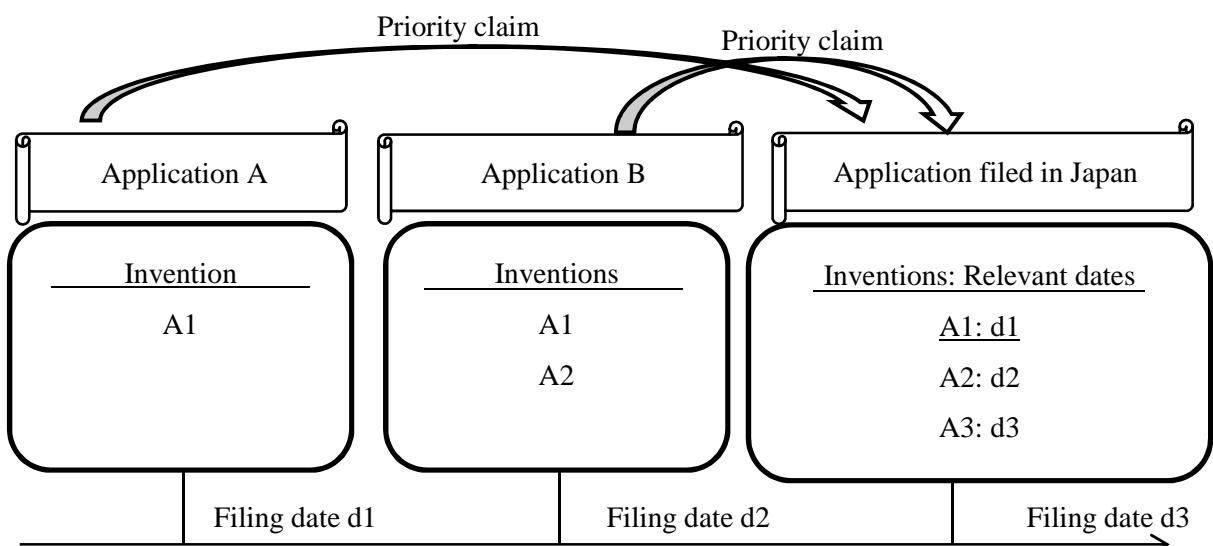


Figure 1 Relevant dates in a case where multiple priorities are claimed

- (2) Cases where the application filed in Japan claims the priorities under the Paris Convention based on two or more applications filed in first countries (multiple priorities), and claimed elements in the application filed in Japan are commonly stated in multiple applications based on which priorities are claimed

In this case, the examiner treats the filing date of the earliest application, in which the claimed elements are stated, as the relevant date (See 3.3 in a case where no priority under the Paris Convention is claimed based on the first application).

- (3) Cases where the claimed invention in the application filed in Japan, which claims the priority under the Paris Convention based on two or more applications filed in first countries, is a combination of the matters stated in the application documents as a whole of multiple applications based on which priorities are claimed, and the combination is not stated in either of the application documents as a whole of those applications

In this case, the effect of the priority claims based on either of the applications is not recognized.

Example: a case where the claimed invention in the application filed in Japan is not stated in either of the applications based on which priorities are claimed

[Application filed in the first countries] A "greenhouse comprising a temperature sensor and a shading curtain opening/shutting system that opens/shuts the shading curtain in response to signals from the temperature sensor" is stated in the application documents as a whole of an application A, and a "greenhouse comprising a humidity sensor and a ventilating window opening/shutting system that opens/shuts the ventilating window in response to signals from the humidity sensor" is stated in the application documents as a whole of another application B.

[Application filed in Japan] The claimed invention in the application filed in Japan, which claims priorities based on both of the applications A and B, is a "greenhouse comprising a temperature sensor and a ventilating window opening/shutting system that opens/shuts the ventilating window in response to signals from the temperature sensor".

(Determination of the effect of the priority claim) Since the greenhouse comprising a temperature sensor and a ventilating window opening/shutting system that opens/shuts the ventilating window in response to signals from the temperature

sensor is not stated in either of the application documents as a whole of the application A or B, it corresponds to a new matter. Accordingly, the effect of priority claim based on either of the applications is not recognized.

3.3 Cases where an application based on that the priority under the Paris Convention is claimed has a priority claim

Where an application based on that the priority under the Paris Convention is claimed (the second application) claims the priority based on another application filed prior to that application (the first application), for the parts which have already been stated in the application documents as a whole of the first application among the matters stated in the whole application documents of the second application, the effect of the priority claim is not recognized. This is because the second application is not "the first application" prescribed by Paris Convention Article 4C(2) for the parts stated in the application documents as a whole of the first application among the matters stated in the second application. Therefore, where the priority is claimed based only on the second application, the effect of the priority claim under the Paris Convention is recognized only for the parts which are not stated in the application documents as a whole of the first application among the matter stated in the whole application documents of the second application. See 3.2.2(2) for a case where the priority under the Paris Convention based on the first application is also claimed.

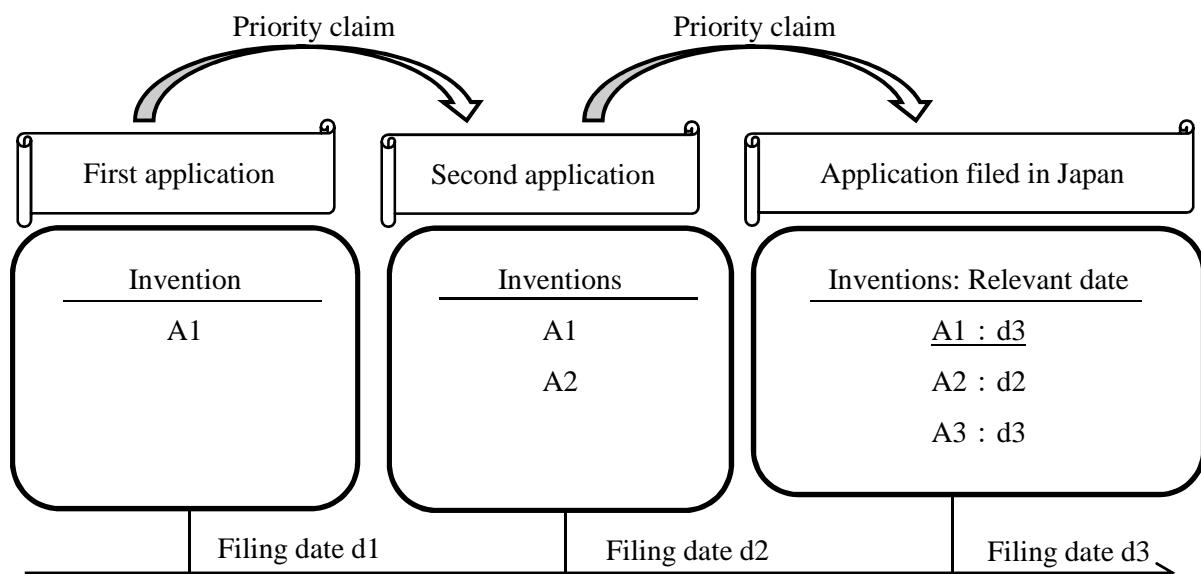


Figure 2 Relevant dates in a case where the priorities are claimed cumulatively

4. Examination Procedure for Determination of the Effect of Priority Claim under the

Paris Convention

When a reason for refusal is raised because of no recognition of the effect of the priority claim under the Paris Convention, the examiner specifies the claimed invention concerned, makes it clear that the priority claim is not effective and explains reason therefor in a notice of reasons for refusal. When a reason for refusal is raised because of no recognition of the effect of the priority claim under the Paris Convention for a part of a claim, the examiner also specifies the part concerned.

Where a written opinion is submitted or an amendment of the description, claims or drawings is made in response to the notice of reasons for refusal, the examiner re-determines whether or not the effect of the priority claim under the Paris Convention is recognized.

5. Various Kinds of Applications and the Like

5.1 Division or conversion of the application claiming the priority under the Paris Convention

For a divisional application of the original application filed in Japan claiming priority under the Paris Convention, the priority claimed in the original application is deemed to be claimed (Paris Convention Article 4G). The statements or documents certifying the priority submitted with respect to the original application are deemed to have been submitted simultaneously to the Commissioner of the Patent Office with the divisional patent application (Patent Act Article 44(4)). This shall apply mutatis mutandis to the converted application (Patent Act Article 46(5)).

5.2 Priority claims recognized under the Paris Convention prescribed in Patent Act Article 43ter

Any following priorities (i) to (iv) may be claimed as the priorities recognized under the Paris Convention:

- (i) the priority based on the application made by Japanese nationals or nationals of a country of the Union of the Paris Convention (including nationals deemed to be the nationals of the country of the Union in accordance with Paris Convention Article 3) in one of the Member of the World Trade Organization (WTO) (Patent Act Article 43ter(1));
- (ii) the priority based on the application made by the nationals of a Member of the

WTO in one of the countries of the Union of the Paris Convention or a Member of the WTO (Patent Act Article 43ter(1));

- (iii) the priority based on an application filed in a country that is neither a country of the Union of the Paris Convention nor a Member of the WTO, allows Japanese nationals to declare a priority under the same conditions as in Japan, and is designated by the Commissioner of the Japan Patent Office (hereinafter, such a country is referred to as a "specified country" in this Chapter) made by a national of the country (Patent Act Article 43ter(2)); or
- (iv) the priority based on the application filed in a specified country by a Japanese national, a national of the country of the Union of the Paris Convention or a national of a Member of the WTO (Patent Act Article 43ter(2)).

These applications claiming the priority shall be treated, as well as the cases of the applications in Japan claiming the priority under the Paris Convention, in accordance with the 3. and 4.

5.3 International application under the Patent Cooperation Treaty and priority

Where Japan is specified as a designated States by an international application claiming the priority based on a national application in Japan (so-called "self-designation"), the internal priority (the priority based on an application filed in Japan) can be claimed for the Japanese national phase (Patent Cooperation Treaty (PCT) Article 8(2)(b)). On the other hand, where an international application claiming the priority based on an earlier international application containing the designation of Japan and other PCT Contracting States, and containing the designation of Japan, the priority under the Paris Convention can be claimed for the Japanese national phase (PCT Article 8(2)(a)).

Earlier application as a basis of the priority claim	Later application claiming the priority	Priority that can be claimed
National application	International application designating Japan (Self-designation)	Internal priority
International application designating Japan and other Contracting States	National application	Internal priority or Priority under the Paris Convention (Selection by the applicant)
	International application designating Japan	Priority under the Paris Convention

(For details, see the attached table)

5.4 Priority claim under the Paris Convention based on various kinds of applications

5.4.1 Divisional application or converted application filed in the first country

Where an application filed in Japan claims the priority under the Paris Convention based on a divisional or converted application filed in the first country, the divisional or converted application is not the "first application" for matters stated in the application documents as a whole of the original application, among the matters stated in the application documents as a whole of the divisional or converted application. Where the priority is claimed based on both a divisional or converted application and its original application under the Paris Convention, the examiner determines the effect thereof according to item 3.2.2(2).

5.4.2 Continuation-in-part application in the US

Where the application filed in Japan claims the priority under the Paris Convention based on a continuation-in-part (CIP) application in the US, the continuation-in-part application is not the "first application" for the matters stated in the application documents as a whole of the original application among the matters stated in the application documents as a whole of the CIP application. Where the priority under the Paris Convention is claimed based on both of a continuation-in-part application and its original application, the examiner determines the effect thereof according to item 3.2.2(2).

5.4.3 Provisional application

A provisional application or a provisional specification under applicable systems in the US, UK, or Australia can serve as a basis of the priority claim under the Paris Convention because it is considered to be a regular national application (Paris Convention Articles 4A(2) and (3)) in the country concerned.

Chapter 2 Internal Priority

1. Overview

In the system of priority based on a patent application etc. prescribed by the provision of Patent Act Article 41 (hereinafter referred to as “internal priority” in this chapter), in cases where a patent application claiming priority is filed for content consolidated as a comprehensive invention (hereinafter referred to as “later application” in this chapter) containing invention(s) of its own patent application or application for utility model registration that has been already filed (hereinafter referred to as “earlier application” in this chapter), amongst the comprehensively claimed inventions, for invention(s) stated in the originally attached description, claims or drawings (hereinafter referred to as “originally attached description etc.” in this chapter) of the earlier application a prioritized treatment is allowed to deem the later application to have been filed at the time when the earlier application was filed, with respect to determination on whether the requirements of novelty, inventive step etc. are met.

According to this system, where an application for basic invention(s) has already been filed, a subsequent patent application can be filed as a comprehensive invention bringing the content of such basic invention(s) and later invention(s) of improvement together so that the results of technical development can be easily and smoothly protected as a patent right in a complete form. The system also allows the effects of claim of priority be recognized in Japan, for an international application under the Patent Cooperation Treaty (PCT) claiming priority based on an earlier application and including Japan as a designated country (PCT Article 8 (2) (b), so-called, “self designation”).

2. Requirements and Effects of Claim of Internal Priority

2.1 Person who can claim internal priority

A person who can claim internal priority is the one who desires a patent and the applicant of the earlier application (Patent Act Article 41(1) main paragraph).

Therefore the applicant of the earlier application and the applicant of the later application shall be the same at the time when the later application is filed.

Where there is a person who holds a provisional exclusive license on the earlier application, the applicant of the later application needs to obtain consent from the

person before the filing date of the later application (Article 41(1) proviso).

2.2 Period when a later application claiming internal priority can be filed

The period when a later application claiming internal priority can be filed (priority period) shall in principle be one year from the filing date of the earlier application (Patent Act Article 41 (1)(i)).

2.3 Earlier application that can serve as a basis of claim of internal priority

Except where any of the following cases of (i) to (iv) is applicable, an earlier application can serve as a basis of claim of internal priority. However, an application for design registration cannot serve as a basis of claim of internal priority (Patent Act Article 41 (1)).

- (i) Where the earlier application is a new application divided out from or converted from an application, or a new patent application based on a utility model registration (Patent Act Article 41(1) (ii));
- (ii) Where the earlier application has been abandoned, withdrawn or dismissed as of the time when the later application claiming internal priority is filed (Patent Act Article 41(1) (iii));
- (iii) Where the examiner's decision or the trial decision on the earlier application has become final and binding as of the time when the later application claiming internal priority is filed (Patent Act Article 41(1)(iv)); or
- (iv) Where the registration of establishment of the utility model right has been effected with respect to the earlier application, as of the time when the later application claiming internal priority is filed (Patent Act Article 41(1) (v)).

In contrast to the priority system under the Paris Convention under which only the first application in one of the member countries of the Paris Convention can serve as the basis of priority claim (see 2.3.2 in “Chapter 1 Priority under the Paris Convention”), an earlier application serving as the basis of internal priority shall not be limited to the first application in Japan.

2.4 Effects of claim of internal priority

For inventions amongst those claimed in a later application claiming internal priority, for inventions that are stated in the originally attached descriptions etc. to an earlier application on which the internal priority claim is based, the later application shall be deemed to have been filed at the time when the earlier application was filed, in application of the following provisions of (i) to (vi) in connection with substantive examination (Patent Act Article 41(2)).

- (i) Novelty (Article 29(1))
- (ii) Inventive step (Article 29(2));
- (iii) Secret prior art (Article 29bis main paragraph);
- (iv) Exceptions to lack of novelty of invention (Article 30(1) to (2));
- (v) Prior application (Article 39(1) to (4));
- (vi) Requirements for independent patentability on the above-mentioned (i) to (v) (Article 126 (7) as applied mutatis mutandis under Article 17bis(6)).

However, in application of the provisions of the other clauses in connection with substantive examination (for example, Article 32 and Article 36) on the later application claiming internal priority, determination shall be made based on the time when the later application is filed. In the case of application of the provisions of Article 29bis on the later application claiming internal priority as a precedent application under such provision, see 6.1.3 in “Part III Chapter 3 Secret Prior Art.”

3. Determination on Effects of Claim of Internal Priority

3.1 Basic idea

3.1.1 Where determination on effects of internal priority claim is required

It is sufficient for the examiner to determine whether or not the effects of internal priority claim shall be recognized, only when the examiner finds that a prior art, etc. that can be the ground of reasons for refusal exists during the period from the filing date of the earlier application that serves as a basis of internal priority claim to the filing date of the later application. Only in the case where the examiner finds the existence of a prior art, etc. that can be referenced to in the reason for refusal during the period between the filing dates of the earlier application and the later application, the examiner may change the determination on requirements of novelty, inventive step, etc.,

depending upon whether or not the effects of internal priority claim is recognized.

The examiner may also determine on the effects of internal priority claim in advance of prior art search where such effects can be easily determined or otherwise applicable, since determination of the effects of priority claim in advance of prior art search may sometimes contribute to effective examination due to restriction of the time range of prior art search.

3.1.2 Subject of determination

In principle, the examiner shall determine the effects of internal priority claim on a claim-by-claim basis. Where matters specifying the invention in one claim are expressed by alternatives, however, the examiner shall determine the effects of internal priority claim for each invention that is understood based on each alternative. Furthermore where modes for carrying out the claimed invention are newly added, the examiner shall determine the effects of internal priority claim for the newly added part within the claimed invention, separately from the remaining part.

3.1.3 Comparison with matters stated in the originally attached descriptions etc. of the earlier application and determination

(1) Basic idea

Based on the assumption that the description, claims and drawings of the later application are amended description, claims and drawings of the earlier application, if such amendment would add new matters on the claimed invention of the later application relative to the "originally attached descriptions etc. of the earlier application," the effects of internal priority claim shall not be recognized. In other words, the effects of internal priority claim shall not be recognized where such amendment introduces new technical matters to the claimed invention relative to the "matters stated in the originally attached descriptions etc."

The term "matters stated in the originally attached descriptions etc." herein means technical matters which are derived by a person skilled in the art from comprehensive understanding of all the matters stated in the originally attached descriptions etc.

(2) Typical cases where the claimed invention of the later application is not considered to be within the scope of the matters stated in the originally attached descriptions

etc. of the earlier application

Subject to 3.1.3(2) in "Chapter 1 Priority under the Paris Convention."

3.2 Partial priority or multiple priorities

Treatment of partial priority or multiple priorities is subject to 3.2 in "Chapter 1 Priority under the Paris Convention."

3.3 Treatment of cases where application that serves as a basis of claim of internal priority claims priority

Where the earlier application that serves as a basis of claim of internal priority (the second application) claims internal priority, priority under the Paris Convention or priority declared by the Paris Convention based on a prior application (the first application) which was filed in advance of the second application, among the matters stated in the originally attached description etc. of the second application, the effects of internal priority claim shall not be recognized for the invention(s) already stated in the originally attached description, etc. of the first application. Otherwise the period of priority would be substantively extended as the priority is recognized again (cumulatively) for the invention(s) stated in the first application. Thus for the second application that serves as a basis of claim of internal priority, the effects of internal priority claim shall be recognized only for the part unstated in the originally attached descriptions etc. of the first application (Article 41(2) to (3)). For a case where the first application also serves as a basis of claim of internal priority, priority under the Paris Convention or priority declared by the Paris Convention, see 3.2.2(2) in "Chapter 1 Priority under the Paris Convention."

4. Procedure of Examination for Determination on the Effects of Internal Priority Claim

The procedure of examination for determination on the effects of internal priority claim shall be subject to the procedure of examination for determination on the effects of priority claim under the Paris Convention (see 4. in "Chapter 1 Priority under the Paris Convention").

5. Points to Note

5.1 Division or conversion of applications claiming internal priority

A divisional application derived from a subsequent application claiming internal priority, or an application for converting a utility model registration application claiming internal priority into a patent application, is deemed to claim the same internal priority as claimed in the original application. This is because documents evidencing internal priority that were submitted for the original patent application are deemed to have been submitted to the JPO Commissioner concurrently with the new patent application (Articles 44(4) or 46(6)).

5.2 Withdrawal of the application underlying the claim for internal priority

(1) The earlier application, which is alleged to underlie the claim for internal priority, is deemed withdrawn one year and four months after the date of filing thereof except in the cases set forth in (i) to (iv) below (Article 42(1) and Regulations under the Patent Act, Article 28quater(2)).

- (i) The earlier application was waived, withdrawn, or dismissed.
- (ii) The examiner's decision or a trial decision on the earlier application became final.
- (iii) Registration establishing a utility model right has been effected for the earlier application.
- (iv) All internal priority claims based on the earlier application were withdrawn.

(2) The applicant of the subsequent application claiming internal priority may not withdraw such claim after one year and four months from the date of filing of the earlier application (Article 42(2) and Regulations under the Patent Act, Article 28quater(2)). If the subsequent application claiming internal priority is withdrawn within one year and four months from the date of filing of the earlier application, then such priority claim is deemed withdrawn simultaneously (Article 42(3) and Regulations under the Patent Act, Article 28quater(2)).

(3) If an internal priority claim is based on a PCT international application in which the designated states include Japan, then it is deemed withdrawn "at the standard time of national processing (in principle, at the time of expiration of the period for submission of national documents (Note)) or one year and four months after the date of filing of that international application, whichever is later" (Article 184quindecies(4) and Regulations

under the Patent Act, Article 38sexies(5)).

(Note) "Period for submission of national documents" refers to the two-year-and-six-month period beginning on the priority date specified in PCT Article 2(xi) (Article 184quater(1)).

Appended table: Relationship between PCT international application and right of priority

Earlier application underlying priority claim	Subsequent application claiming priority	Claimable priority	Time when earlier application is deemed withdrawn	Period during which claim of priority may be withdrawn
National application	PCT international application in which the designated states include Japan (self-designation)	Internal priority (PCT Article 8(2)(b), Patent Act Articles 184ter(1) and 41(1))	One year and four months after date of filing of earlier application (Patent Act Article 42(1) and Regulations under the Patent Act Article 28quater(2))	Within 30 days from priority date (*) (PCT Rules 90bis.3(a) and Patent Act Article 184quindecies(1))
PCT international application in which Japan and other countries are designated	National application	Internal priority or right of priority under Paris Convention (At the applicant's option) (Patent Act Articles 184ter(1), 184quindecies(4) and 41, or Paris Convention Article 4(A))	In the case of internal priority, "at the standard time of national processing" or "one year and four months after filing of PCT international application," whichever is later (Patent Act Articles 184quindecies(4), 42(1) and Regulations under the Patent Act Article 38sexies(5)) No such time is set for priority under Paris Convention	In the case of internal priority, within one year and four months from the date of filing of earlier application (Patent Act Article 42(2), Regulations under the Patent Act Article 28quater(2)) Priority claim under Paris Convention may not be withdrawn
	PCT international application in which the designated states include Japan	Right of priority under Paris Convention PCT Article 8(2)(a) and Paris Convention Article 4(A))	No such time set	Within 30 days from priority date (PCT Rules 90bis.3(a))

* Even after one year and four months from the date of filing of the earlier application, the priority claim may still be withdrawn at any time within 30 months from the priority date; provided, however, that this will not revive the earlier application, which is already deemed withdrawn.

<Relevant Provisions>

Patent Act

(Priority claim based on patent application, etc.)

Article 41

A person requesting the grant of a patent may make a priority claim for an invention claimed in the patent application, based on an invention disclosed in the description or scope of claims for a patent or utility model registration, or drawings (in the case where the earlier application was a foreign language written application, foreign language documents) originally attached to the request of an earlier application filed for a patent or utility model registration which said person has the right to obtain (hereinafter referred to as "earlier application"), except in the following cases:(omitted)

- (i) where said patent application is not filed within one year from the date of the filing of the earlier application (except in the case where there is a legitimate reason for the applicant having failed to file said patent application within one year from the date of the filing of the earlier application, and said patent application is filed within the period specified in the Ordinance of the Ministry of Economy, Trade and Industry);
 - (ii) where the earlier application is a new divisional patent application extracted from a patent application ..., a patent application converted from a patent application ... or a patent application based on a utility model registration ..., or a new divisional utility model registration application extracted from a utility model registration application ... or a utility model registration application converted from a utility model registration application ...;
 - (iii) where at the time of the filing of said patent application, the earlier application had been waived, withdrawn or dismissed;
 - (iv) where, at the time of the filing of said patent application, the examiner's decision or the trial decision on the earlier application had become final and binding; and
 - (v) where, at the time of the filing of said patent application, the registration establishing a utility model right under Article 14(2) of the Utility Model Act with respect to the earlier application had been effected.
- (2) For those of the inventions claimed in a patent application claiming a right of priority under the preceding paragraph which are stated in the description, scope of claims for a patent or utility model registration or drawings (in the case where the earlier application was a foreign language written application, foreign language documents) originally attached to the request of the earlier application on which the priority claim is based ..., said patent application shall be deemed to have been filed at the time when the earlier application was filed, for the purpose of the application of Article 29, the main clause of Article 29-2, Articles 30(1) and (2), 39(1) to (4), 69(2)(ii), 72, 79, 81, 82(1), 104 (...) and 126(7) ...
- (3) Among inventions disclosed in the description, scope of claims or drawings (in the case of a foreign language written application, foreign language documents) originally attached to the application in a patent application containing a priority claim under paragraph (1), for those that are stated in the description, scope of claims for a

patent or utility model registration or drawings (or claims or drawings (in the case of a foreign language) of Utility Model pertaining to the earlier application shall be deemed to have been effected or issued at the time when the patent gazette containing patent or the laying open of application pertaining to the said patent application was issued or effected, and the main clause of Article 29-2 of the patent Act or Article 3-2 of the Utility Model Act shall apply.

(4) (Omitted)

(Procedures for a priority claim under the Paris Convention)

Article 43(1)

A person desiring to take advantage of the priority under Article 4.D(1) of the Paris Convention regarding a patent application shall submit to the Commissioner of the Patent Office a document stating the same, and specify the country of the Union of the Paris Convention in which the application was first filed, deemed to have been first filed under C(4) of said Article, or recognized to have been first filed under A(2) of said Article, and the date of filing of said application within the period prescribed in the Ordinance of the Ministry of Economy, Trade and Industry.

(2) A person who has made a declaration of priority under the preceding paragraph shall submit to the Commissioner of the Patent Office a certificate showing the date of filing from the country of the Union of the Paris Convention in which the application was first made, or deemed to have been first made under Article 4.C(4) of the Paris Convention, or recognized to have been first made under A(2) of said Article, as well as certified copies of those equivalent to the description, scope of claims for patent or utility model registration, and drawings submitted at the time of the filing of the application, or any bulletin or certificate equivalent thereto issued by the government of said country, within one year and four months from the earliest of the following dates:

- (i) the date of filing which was first made, deemed to have been first made under Article 4.C(4) of the Paris Convention, or recognized to have been first made under A(2) of said Article;
- (ii) where such patent application contains a priority claim under Article 41(1), the date of filing of the application on which said priority claim is based; or
- (iii) where such patent application contains other priority claims under 43(1) or 44

(1) (including the cases where it is applied mutatis mutandis pursuant to Article 43-3(3) or 43-3(1) or (2), the date of filing of the application on which said priority claim is based.

(3) A person who has made a declaration of priority under paragraph (1) shall, in addition to the documents as provided in the preceding paragraph, submit to the Commissioner of the Patent Office a document specifying the filing number of the application which was first filed, deemed to have been first filed under Article 4.C(4) of the Paris Convention, or recognized to have been first filed under A(2) of said Article; provided, however, that where such filing number is not available to the person prior to the submission of the documents as provided in said paragraph, in lieu of said document, a document specifying the reason thereof shall be submitted and

the document specifying such filing number shall be submitted without delay when such number becomes available to said person.

(4) Where a person who has made a declaration of priority under paragraph (1) fails to submit the documents specified in paragraph (2) within the time limit provided therein, said priority claim shall lose its effect.

(5) In relation to the application of the preceding two paragraphs, in the case of prescribing Ordinance of the Ministry of Economy, Trade and Industry that a conversion of matters stated in the documents provided in paragraph (2) is allowed between the government of a country of the Union of the Paris Convention or an international organization relating to industrial property through an electromagnetic device (a device that is not perceivable by human senses including electronic and magnetic devices), where a person who having made a declaration of a priority claim provided in paragraph (2) submit to the Commissioner of the Patent Office the document stating the matters prescribed in Ordinance of the Ministry of Economy, Trade and Industry as a required matter for which the other matters including its filing number is converted, the documents as provided in paragraph (2) shall be deemed to have been submitted.

(6) Where a document under paragraph (2) or a document under the preceding paragraph have not been submitted within the time limit under paragraph (2), the Commissioner of the Patent Office shall notify a person who has made a priority claim under paragraph (1) thereof.

(7) A person who has received a notice provided under the preceding paragraph may submit a document under paragraph (2) or a document under paragraph (5) to the Commissioner of the Patent Office only within the time limit as provided in Ordinance of the Ministry of Economy, Trade and Industry.

(8) Notwithstanding the preceding paragraph, where, due to reasons beyond the control of a person who has received a notice provided under paragraph (6), the person is unable to submit the documents as provided in paragraph (2) or the document as provided in paragraph (5) within the time limit provided under the preceding paragraph, the person may submit to the Commissioner of the Patent Office the documents or the document within the time limit as provided in Ordinance of the Ministry of Economy, Trade and Industry.

(9) Where the documents specified in paragraph (2) or the document specified in paragraph (5) are submitted under paragraph (7) or the preceding paragraph, paragraph (4) shall not apply.

(Priority claims recognized under the Paris Convention)

Article 43-2(1)

Although a person intended to declare a priority under Article 4.D(1) of the Paris Convention regarding a patent application, where the person was unable to file the patent application with the priority claim within the period of priority prescribed in the same article C.(1) (hereinafter, referred to as "a period of priority"), there is a

reasonable ground for failing to file the patent application, and the person filed the patent application within the period prescribed in the Ordinance of the Ministry of Economy, Trade and Industry, the person may declare a priority claim regarding the patent application recognized under the same article of the Paris Convention even after the lapse of the period of priority.

(2) The preceding paragraph shall apply mutatis mutandis to the case where a priority claim is declared under the preceding paragraph.

Article 43-3(1)

A priority claim may be declared in a patent application under Article 4 of the Paris Convention, where the priority claim is based on an application filed by a person specified in the left-hand column of the following table in a country specified in the corresponding right-hand column.

Japanese nationals or nationals of a country of the Union of the Paris Convention (including nationals deemed to be the nationals of the country of the Union in accordance with Article 3 of the Paris Convention - hereinafter the same shall apply in the following paragraph).	Member of the World Trade Organization
Nationals of a Member of the World Trade Organization (meaning the nationals of Members provided for in paragraph (3) of Article 1 of the Annex 1C to the Marrakesh Agreement – hereinafter the same shall apply in the following paragraph).	Country of the Union of the Paris Convention or Member of the World Trade Organization

(2) A national of a country that is neither a country of the Union of the Paris Convention nor a member of the World Trade Organization (limited to the countries that allows Japanese nationals to declare a priority under the same conditions as in Japan and limited to the country designated by the Commissioner of the Patent Office, hereinafter referred to as a "specified country" in this paragraph), a Japanese national, a national of a country of the Union of the Paris Convention or a national of a member of the World Trade Organization may declare a priority claim in the patent application based on the application filed in the specified country under Article 4 of the Paris Convention.

(3) The preceding two articles shall apply mutatis mutandis to the case where a priority claim is declared under the preceding two paragraphs.

Paris Convention Article 4

A(1) Any person who has duly filed an application for a patent, or for the registration of a utility model, or of an industrial design, or of a trademark, in one of the countries of the Union, or his successor in title, shall enjoy, for the purpose of filing in the other countries, a right of priority during the periods hereinafter fixed.

(2) Any filing that is equivalent to a regular national filing under the domestic legislation of any country of the Union or under bilateral or multilateral treaties concluded between countries of the Union shall be recognized as giving rise to the right of priority.

(3) The term “regular national filing” means any filing that is adequate to establish the date on which the application was filed in the country concerned, regardless of the subsequent fate of the application.

B Consequently, any subsequent filing in any of the other countries of the Union before the expiration of the periods referred to above shall not be invalidated by reason of any acts accomplished in the interval, in particular, another filing, the publication or exploitation of the invention, such acts cannot give rise to any third-party right or any right of personal possession.

Rights acquired by third parties before the date of the first application that serves as the basis for the right of priority are reserved in accordance with the domestic legislation of each country of the Union.

C(1) The periods of priority referred to above shall be twelve months for patents and utility models, and six months for industrial designs and trademarks.

(2) These periods shall start from the date of filing of the first application; the day of filing shall not be included in the period.

(3) If the last day of the period is an official holiday, or a day when the Office is not open for the filing of applications in the country where protection is claimed, the period shall be extended until the first following working day.

(4) A subsequent application concerning the same subject as a previous first application within the meaning of paragraph (2), above, filed in the same country of the Union shall be considered the first application, of which the filing date shall be the starting point of the period of priority, if, at the time of filing the subsequent application, said previous application has been withdrawn, abandoned, or refused, without having been laid open to public inspection and without leaving any rights outstanding, and if it has not yet served as a basis for claiming a right of priority. The previous application may not thereafter serve as a basis for claiming a right of priority.

D(1) Any person desiring to take advantage of the priority of a previous filing shall be required to make a declaration indicating the date of such filing and the country in which it was made. Each country shall determine the latest date on which such declaration must be made.

(2) These particulars shall be mentioned in the publications issued by the competent authority, and in particular in the patents and the specifications relating thereto.

(3) The countries of the Union may require any person making a declaration of priority to produce a copy of the application (description, drawings, etc.) previously filed. The copy, certified as correct by the authority which received such application, shall not require any authentication, and may in any case be filed, without fee, at any time within three months of the filing of the subsequent application. They may require it to be accompanied by a certificate from the same authority showing the date of filing, and by a translation.

(4) No other formalities may be required for the declaration of priority at the time of filing the application. Each country of the Union shall determine the consequences of failure to comply with the formalities prescribed by this Article, but such consequences shall in no case go beyond the loss of the right of priority.

(5) Subsequently, further proof may be required.

Any person who avails himself of the priority of a previous application shall be required to specify the number of that application; this number shall be published as provided for by paragraph (2), above.

E(1) Where an industrial design is filed in a country by virtue of a right of priority based on the filing of a utility model, the period of priority shall be the same as that fixed for industrial designs.

(2) Furthermore, it is permissible to file a utility model in a country by virtue of a right of priority based on the filing of a patent application, and vice versa.

F No country of the Union may refuse a priority or a patent application on the ground that the applicant claims multiple priorities, even if they originate in different countries, or on the ground that an application claiming one or more priorities contains one or more elements that were not included in the application or applications whose priority is claimed, provided that, in both cases, there is unity of invention within the meaning of the law of the country.

With respect to the elements not included in the application or applications whose priority is claimed, the filing of the subsequent application shall give rise to a right of priority under ordinary conditions.

G(1) If the examination reveals that an application for a patent contains more than one invention, the applicant may divide the application into a certain number of divisional applications and preserve as the date of each the date of the initial application and the benefit of the right of priority, if any.

(2) The applicant may also, on his own initiative, divide a patent application and preserve as the date of each divisional application the date of the initial application and the benefit of the right of priority, if any. Each country of the Union shall have the right to determine the conditions under which such division shall be authorized.

H Priority may not be refused on the ground that certain elements of the invention for which priority is claimed do not appear among the claims formulated in the application in the country of origin, provided that the application documents as a whole specifically disclose such elements.

(omitted)

Part VI

Special Application

Note: When any ambiguity of interpretation is found in this provisional translation, the Japanese text shall prevail.

Part VI Special Application

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Part VI Special Application

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<Relevant Provisions>

Note: When any ambiguity of interpretation is found in this provisional translation, the Japanese text shall prevail.

Part VI Chapter 1 Section 1 Requirements for Division of Patent Application

Chapter 1 Division of Patent Application

Section 1 Requirements for Division of Patent Application

1. Overview

Article 44 of the Patent Act, which covers the division of patent applications. This article stipulates that the applicant may make part of a patent application containing two or more inventions a new patent application. And, this article stipulates that, if a patent application is lawfully divided, the new application is deemed to have been filed at the same time as the original application.

The patent application division system was established to provide as much access to legal protection as possible for inventions that are included in patent applications and do not meet the requirement of unity of invention, pursuant to the objective of the patent system; i.e., the granting of exclusive rights for a certain period in exchange for publication.

In this Chapter, an "original application" and a "new application" are called an "original application" and a "divisional application," respectively, regardless of whether or not the division is carried out lawfully.

2. Requirements for and Effect of Division of a Patent Application

In order for the division of a patent application to be recognized as lawfully done, it must meet certain requirements for division of applications (In this chapter, hereinafter, referred to as "requirements for division."). The requirements for division consist of formal requirements (see 2.1) and substantive requirements (see 2.2). If the requirements for division are satisfied, the effect of the division of the application (see 2.3) is recognized.

2.1 Formal requirements for the division of a patent application

2.1.1 Person entitled to divide a patent application

Entitled to divide a patent application is the applicant thereof (Article 44(1)). In other words, the applicant of the original application and that of the divisional application must be the same at the time of division.

2.1.2 When the division of a patent application is allowed

A patent application may be divided at any of the timings set forth in (i) to (iii) below.

- (i) During the time period in which amendments to the description, claims, or drawings (In this chapter, hereinafter, referred to as "description, etc.") are allowed (Article 44(1)(i)) (Note 1)
- (ii) Within 30 days from transmittal of a certified copy of a decision to grant a patent (Note 2) (Article 44(1)(ii)) (Notes 3 to 5)
- (iii) Within three months from transmittal of a certified copy of the non-final decision of refusal (Note 6) (Article 44(1)(iii)) (Notes 4 and 5)

(Note 1) For information about when amendments to the description, etc. are allowed, see 2. of "Part IV Chapter 1 Requirements for Amendments."

(Note 2) The following cases are excluded.

- (a) If a decision to grant a patent is given upon reconsideration by examiners before appeal proceedings (Article 51 as applied mutatis mutandis in Article 163(3)).
- (b) If a decision of refusal is cancelled by an appeal against the examiner's decision of refusal and is referred back by an appeal decision for re-examination, and a decision to grant a patent is given (Articles 160(1) and 51).

(Note 3) Even before 30 days have passed from the date of transmittal of a certified copy of a decision to grant a patent, once the registration of the patent right is established, the application may not be divided as it is no longer pending at the Patent Office.

(Note 4) A decision in an appeal against the examiner's decision of refusal is not a decision to either grant or refuse a patent, so the time periods set forth in (ii) and (iii) above do not include the time period following the transmittal of a certified copy of the appeal decision.

(Note 5) The time periods set forth in (ii) and (iii) above may be extended or otherwise changed (Article 44 (5) to (7)).

(Note 6) The following cases are excluded.

- If a decision of refusal is cancelled by an appeal against the examiner's decision of refusal and is referred back by an appeal decision for re-examination, and another decision of refusal is given (Articles 160(1) and 49).

2.2 Substantive requirements for the division of a patent application

The division of a patent application is to make part of a patent application containing two or more inventions a new patent application; therefore, Requirements 1 and 3 below must be met. Moreover, given the effect of division, that is, the divisional application being deemed to have been filed at the same time as the original application, Requirement 2 below must also be satisfied.

(Requirement 1) All of the inventions stated in the description, etc., as they stand immediately prior to the division of the original application do not together constitute the invention claimed in the divisional application.(see 3.1)

(Requirement 2) The matters stated in the description, etc., of the divisional application are within the scope of those stated in the description, etc., of the original application as they stood at the time of filing thereof. (see 3.2)

(Requirement 3) The matters stated in the description, etc., of the divisional application are within the scope of those stated in the description, etc., of the original application as they stand immediately prior to the division thereof. (see 3.3)

However, if a patent application is divided during the time period in which amendments to the description, etc., of the original application are allowed (Note), then Requirement 3 shall be deemed satisfied so long as Requirement 2 is met. This is because a matter which is not stated in the description, etc., of the original application as it stands immediately prior to the division thereof but was stated in the description, etc., of the original application as it stood at the time of filing thereof, may be included by an amendment in the description, etc., of the original application before it is divided.

(Note) For information about when amendments to the description, etc. are allowed, see 2. of "Part IV Chapter 1 Requirements for Amendments."

2.3 Effect of the division of a patent application

If the requirements for division are met, the divisional application is deemed filed at the same time as the original application. If the substantive requirements in the requirements for division are not satisfied, however, the divisional application is not deemed filed at the same time as the original application, but is treated as being filed when it is actually filed. If the formal requirements are not met, the divisional application is dismissed per se.

3. Determination on the Substantive Requirements

- 3.1 All of the inventions stated in the description, etc., as they stand immediately prior to the division of the original application do not together constitute the invention claimed in the divisional application (Requirement 1).

Requirement 1 is usually satisfied.

(Explanation)

Usually, various inventions are identified from the description, etc., from many angles and in many phases, so they can be said to present two or more inventions. All of the two or more inventions stated in the description, etc., of the original application together constitute the invention claimed in the divisional application if all of the inventions identified from the description, etc., of the original application are stated in the claims of the divisional application; however, this practice, which means non-compliance with Requirement 1, is not expected in ordinary cases.

Therefore, the mere fact that the statement of the claims of the divisional application is the same as that of the claims of the original application does not provide a ground for the satisfaction of Requirement 1. If the invention claimed in the divisional application is the same as the one claimed in the original application after division, see 6.2.

- 3.2 The matters stated in the description, etc., of the divisional application are within the scope of those stated in the description, etc., as they stood at the time of filing

of the original application (Requirement 2)

The examiner shall determine in this respect by supposing that the Description, etc., of the divisional application are the description, etc., as they stand after an amendment is made to the "description, etc., of the original application as they stood at the time of filing thereof" and then by evaluating whether such amendment is to add any new matter in relation to the "description, etc., of the original application as they stood at the time of filing thereof." (Note)

(Note) For judgment as to whether the amendment is to add a new matter, see "Part IV Chapter 2 Amendment Adding New Matter". Common general knowledge considered in making a judgment in this respect is as of the filing of the original application.

3.3 The matters stated in the description, etc., of the divisional application are within the scope of those stated in the description, etc., as they stand immediately prior to the division of the original application (Requirement 3)

The examiner shall make a judgment in this respect by supposing that the description, etc., of the divisional application are the description, etc., as they stand after an amendment is made to the "description, etc., as they stand immediately prior to the division of the original application" and then by evaluating whether such amendment is to add any new matter in relation to the "description, etc., as they stand immediately prior to the division of the original application." (Note)

(Note) Same as Note of 3.2 .

4. Procedure of Examination for Determination on the Substantive Requirements

4.1 Treatment in the case where the substantive requirements are not met

If the examiner finds that the substantive requirements are not met, he or she shall provide a specific statement of such failure and the reasons for such finding in the notice of reasons for refusal or the decision of refusal.

4.2 Request for the submission of written explanations necessary for judgment on the

substantive requirements

(1) If it is not easy for the examiner to determine whether or not the substantive requirements are satisfied, then he or she may request the applicant to submit documents that provide explanations about (i) and (ii) below and so on, pursuant to the provision of Article 194(1).

(i) Changed portions from the description, etc., of the original application as they stand immediately prior to the division thereof or at the time of filing thereof

(ii) Statement of the description, etc., of the original application as they stood at the time of filing thereof which supports the invention according to the claims of the divisional application

If the applicant has submitted a written statement which includes an explanation of these points, then the examiner shall scrutinize it before deciding whether or not to request the submission of additional written explanations.

(2) If the applicant fails to give substantial explanations on the examiner's request as set forth in (1) above and it is considerably difficult for the examiner to conclude that the substantive requirements are met, then the examiner may proceed with his or her examination on the assumption that the substantive requirements are not met.

5. Points to Note Concerning Determination on the Requirements for Division

5.1 Divisional application whose original application is a divisional application

The applicant may file a divisional application ("child application") from an original application ("parent application") and further file a divisional application ("grandchild application") from a child application.

In this case, if all of the conditions set forth in (i) to (iii) below are satisfied, the examiner shall, when examining the grandchild application, deem it to have been filed at the same time as the parent application.

(i) The child application meets all the requirements for division in relation to the parent application.

(ii) The grandchild application meets all the requirements for division in relation to the child application.

(iii) The grandchild application meets all the substantive requirements for division

in relation to the parent application. (Note)

(Note) "Description, etc., as they stand immediately prior to the division of the original application" as an element of Requirement 3 set forth in 2.2 refers, in this case, to "description, etc., of the parent application as they stand immediately prior to the division of the child application from the parent application."

5.2 If an application is divided on the same day when an appeal against the examiner's decision of refusal is filed

If division takes place on the same day when an appeal against the examiner's decision of refusal of the original application is filed, then the examiner shall examine the substantive requirements for division as if such division took place at exactly the same time as the filing of such appeal (during the time period in which amendments are allowed) (see 2.2), unless it is obvious that such division has not taken place simultaneously with the filing of such appeal.

6. Points to Note Concerning Examination of Divisional Application

6.1 Confirmation of the contents of examination, appeal, etc., of other applications

When examining a patent application and a single application (e.g., a child application) selected from a group of divisional applications based on the patent application (Note), the examiner shall confirm the contents of examination, appeals, and other proceedings pertaining to such patent application and others in such group (e.g., the parent application).

(Note) A group of divisional applications based on a patent application refers to a series of divisional applications derived from a single patent application.

6.2 Treatment in the case where the invention claimed in the divisional application is the same as the one claimed in the original application after division

If the divisional application is lawful and the invention claimed therein is the same as the one claimed in the original application after division, then the provision of

Article 39(2) shall apply.

The examiner shall apply the provision of Article 39(2) in accordance with "Part III Chapter 4 Prior Application."

Section 2 Notification under Article 50bis

1. Overview

Article 50bis of the Patent Act provides for notification by the examiner in the examination of a divisional application and related matters. It stipulates that if the examiner is to give notice of reasons for refusal of a patent application and such reasons are the same as those for refusal of the original application, etc., then the examiner must include a statement to that effect.

The objective of the provision of Article 50bis (and Article 17bis(5)) is to encourage the applicant to fully scrutinize the reasons for refusal notified in the examination of the original application, etc., and refrain from dividing the application for the invention for which such reasons were already notified, without resolving such reasons.

If notification pursuant to the provision of Article 50bis (In this section, hereinafter, referred to as "Article 50bis notification.") is given together with a notice of reasons for refusal with respect to a patent application and the description, etc., are to be amended, then such amendment must meet the requirements prescribed in paragraphs 3 to 6 of Article 17bis, just as amendments after the final notice of reasons for refusal are required to do so. Amendments that do not satisfy such requirements are dismissed.

For the sake of clarity, in the cases described in (i), (ii) below, the examiner shall be careful not to apply the provision of Article 50bis more formally than necessary.

- (i) It is not clear whether the reasons for refusal at issue are the same as those stated in a notice of reasons for refusal of another patent application (e.g., reasons for refusal cannot be clearly identified from statements in a notice of reasons for refusal of another patent application).
- (ii) The reasons for refusal relate to errors or other minor improper in statements.

2. Determination on whether or not to Give the Article 50bis Notification

In connection with the patent application for which the examiner intends to give a notice of reasons for refusal (In this section, hereinafter, referred to as

"application concerned."), the examiner shall give the Article 50bis notification based on the reasons for refusal notified in connection with another patent application if all of the Requirements 1 to 3 below are met.

(Requirement 1) The application concerned and such other patent application are deemed to have been filed simultaneously pursuant to the provision of Article 44(2) (see 2.1).

(Requirement 2) The reasons for refusal of the application concerned are the same as those stated in a notice of reasons for refusal of such other patent application (see 2.2).

(Requirement 3) The notice of reasons for refusal of such other patent application was accessible to the applicant of the application concerned prior to the filing of a request for examination of the application concerned (see 2.3).

2.1 The application concerned and such other patent application are deemed to have been filed simultaneously pursuant to the provision of Article 44bis (Requirement 1)

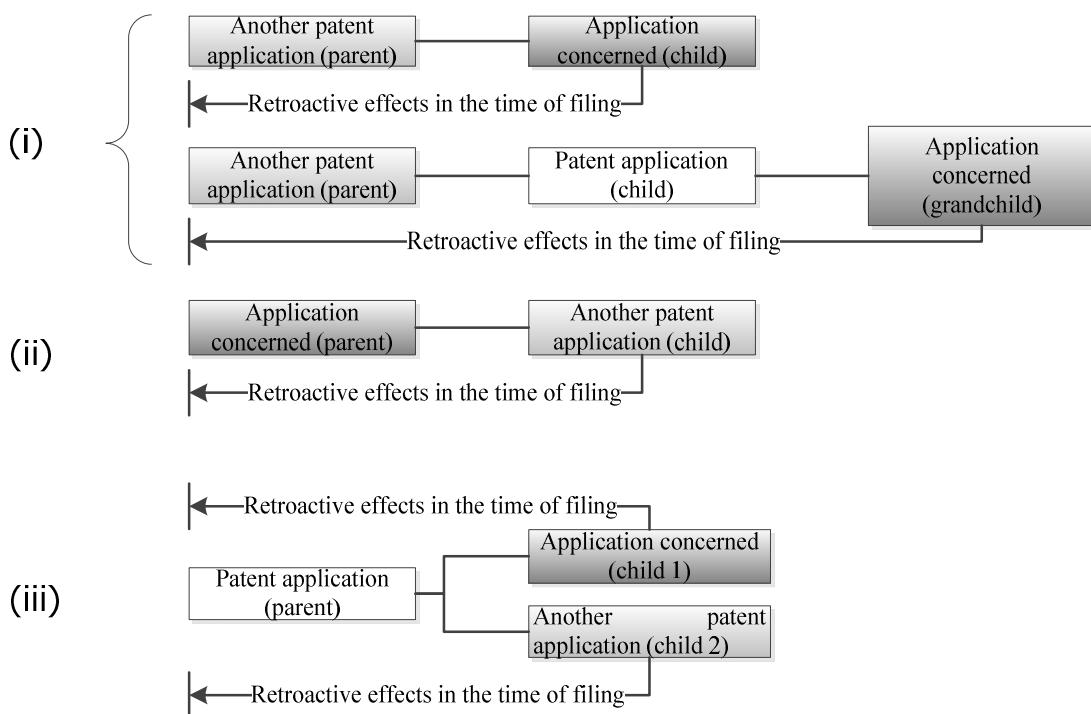
In order for the provision of Article 44(2) to be applied, at least either the application concerned or such other patent application must be a divisional application. Therefore, the examiner shall determine whether the relationship between the application concerned and such other patent application comes under any of the relationships set forth in (i) to (iii) below.

Furthermore, in order for the provision of Article 44(2) to be applied, the substantive requirements for the division of a patent application must also be met. Therefore, the examiner shall also confirm whether the application concerned or such other patent application, whichever is filed as a divisional application, satisfies the substantive requirements for division and thus the application concerned and such other patent application are deemed to have been filed simultaneously. (Note 1)

- (i) The application concerned is one of a group of divisional applications based on another patent application (Note 2)
- (ii) Such other patent application is one of a group of divisional applications based on the application concerned
- (iii) Both the application concerned and such other patent application are among a group of divisional applications based on the same patent application

(Note 1) For his or her judgment as to whether or not Requirement 1 is satisfied, the examiner shall rely on statements in the description etc. of the application concerned and such other patent application as they stand when reasons for refusal of the application concerned are notified. For the substantive requirements for the division of a patent application, see "Section 1 Requirements for Division of Patent Application."

(Note 2) A group of divisional applications based on a patent application refers to a series of divisional applications derived from a single patent application. Examples include divisional applications derived from a single original application, and a divisional application (grandchild application) whose original application is such a divisional application (child application).



2.2 Reasons for refusal of the application concerned are the same as those stated in a notice of reasons for refusal of such other patent application (Requirement 2)

Reasons for refusal of the application concerned are the same as those stated in a notice of reasons for refusal of such other patent application (Notes 1) if the reasons for refusal of the application concerned and of such other patent application are based on the same clause and their specifics are substantially identical to each other. (Note 2)

Specifically, the examiner shall determine whether or not Requirement 2 is met, as follows. Assuming that the description, etc., of the application concerned are the same as the description, etc., of another patent application as they stand after an amendment is made in response to a notice of reasons for refusal, the examiner shall determine in this respect on the basis of whether the description, etc., of the application concerned have resolved the reasons for refusal stated in the notice of reasons for refusal of such other patent application. If the examiner finds that the reasons for refusal are not resolved, he or she shall conclude that Requirement 2 is met.

(Note 1) "Notice of reasons for refusal of such other patent application" does not refer solely to a notice of reasons for refusal given upon the examination of such other application, but also includes notices of reasons for refusal based on appeals against the examiner's decision of refusal, retrials, and reconsideration by examiners before appeal proceedings.

Decisions to dismiss amendments and refuse patent applications are not "notices of reasons for refusal." Therefore, the examiner shall not give the Article 50bis notification if the reasons for refusal of the application concerned are identical solely to those stated in decisions to dismiss amendments to or refuse another patent application.

(Note 2) In such cases where there are two or more reasons for refusal of the application concerned and a notice of reasons for refusal of another patent application also includes more than one reason for refusal, if one of the reasons for refusal of the application concerned is the same as one of the reasons for refusal stated in such notice for such other application, then the reason for refusal of the application concerned shall be deemed to be identical with the one stated in the notice of reasons of refusal of such other application.

2.3 The notice of reasons for refusal of such other patent application was accessible to the applicant of the application concerned prior to the filing of a request for examination thereof (Requirement 3)

The examiner shall conclude that Requirement 3 is met if the notice of reasons for refusal of such other application comes under either (i) or (ii) below.

- (i) The notice of reasons for refusal reached the applicant of the application concerned prior to the filing of a request for examination thereof
- (ii) The notice of reasons for refusal was accessible to the applicant of the application concerned prior to the filing of a request for examination of the

application concerned (Note)

(Note) If such other patent application was laid open prior to the filing of a request for examination of the application concerned, such notice of reasons for refusal is deemed to have been accessible to the applicant of the application concerned prior to the filing of a request for examination of the application concerned.

This does not depend on whether the applicant of the application concerned is the same as or different from the applicant of such other application; in the case of different applicants, the notice of reasons for refusal of such other application is not sent to the applicant of the application concerned, but is deemed accessible to him or her so long as such other application is laid open.

(Points to note)

In the cases set forth in (i) or (ii) below, it shall be deemed that the applicant of the application was not accessible to the notice of reasons for refusal of such other application prior to the filing of the request for examination of the application concerned, unless the request for examination of the application concerned was obviously filed "after" the arrival (or the becoming accessible) of the notice of reasons for refusal.

- (i) The notice of reasons for refusal of such other application arrived at the relevant applicant on the same day when the request for examination of the application concerned was filed
- (ii) The notice of reasons for refusal of such other application became accessible on the same day when the request for examination of the application concerned was filed

3. Procedure of Examination for Determination on whether or not to Give the Article 50bis Notification

3.1 Procedure

If the Application concerned is a divisional application or the original application of a divisional application, the examiner shall determine whether or not to give the Article 50bis notification. If any written statement has been submitted that the description, etc., of the application concerned have resolved the reasons for refusal stated in a notice of reasons for refusal of another patent application, then the examiner shall take it into consideration.

If the examiner concludes in accordance with 2. that all of the Requirements 1 to 3 are met, then the examiner shall give the Article 50bis notification together with a notice of reasons for refusal of the application concerned.

If any of Requirements 1 to 3 above is not satisfied, however, the Article 50bis notification shall not be given with respect to the application concerned.

(Point to consider)

As shown in 1. , in the cases described in (i) and (ii) below, the examiner shall be careful not to apply the provision of Article 50bis more formally than necessary.

(i) It is not clear whether the reasons for refusal at issue are the same as those stated in a notice of reasons for refusal of another patent application (e.g., reasons for refusal cannot be clearly identified from statements in a notice of reasons for refusal of another patent application).

(ii) The reasons for refusal relate to errors or other minor improper in statements.

3.2 Matters to be stated in the Article 50bis notification

When giving the Article 50bis notification, the examiner shall include therein information that helps identify such reasons for refusal stated in a notice of reasons for refusal of another patent application as the examiner has found are identical.

(Point to consider)

The examiner shall not omit describing the reasons for refusal in sufficient detail in the notice of reason for refusal of the application concerned even if the Article 50bis notification contains information that helps identify reasons for refusal stated in a notice of reasons for refusal of another patent application. This is because, even if the application concerned is a divisional application or the like, it is still a different application from the original application or the like, so it is inappropriate if the notice of reasons for refusal of the application concerned cannot be understood without taking into consideration a notice of reasons for refusal of another patent application.

4. Procedure of Examination where an Amendment is Made in Response to a Notice of Reasons for Refusal Accompanied by the Article 50bis Notification

The examiner shall proceed with his or her examination as follows, depending

on whether the notice of reasons for refusal accompanied by the Article 50bis notification is "non-final" or "final."

For illustrative purposes, the procedure of examination where an amendment is made in response to a notice of reasons for refusal accompanied by the Article 50bis notification is shown in the figure below.

4.1 If the notice of reasons for refusal is "non-final"

If an amendment is made in response to the "non-final notice of reasons for refusal" accompanied by the Article 50bis notification, the examiner shall re-examine whether it was appropriate to give the Article 50bis notification, taking into consideration the applicant's arguments in written opinions, etc. (Note)

(Note) If the Article 50bis notification stated that two or more of the reasons for refusal of the application concerned are the same as those stated in a notice of reasons for refusal of another patent application, then the examiner shall conclude that it was appropriate to give the Article 50bis notification so long as any one of such reasons is still valid.

4.1.1 If it was appropriate to give the Article 50bis notification

The examiner shall examine whether the amendment made in response to the notice of reasons for refusal accompanied by the Article 50bis notification complies with any of the provisions of paragraphs 3 to 6 of Article 17bis. If the examiner determines that it is in violation of any of these provisions, he or she shall decide to dismiss the amendment. See "Part IV Amendments of Description, Claims or Drawings" for detailed guidelines on judgment as to the conformity of such amendment to these provisions.

(Point to consider)

If it was appropriate to give the Article 50bis notification at the time it was given, any subsequent amendment must still meet the provisions of paragraphs 3 to 6 of Article 17bis even if such amendment would cause the application concerned to cease to satisfy the substantive requirements for division, making it and another application at issue no longer qualified to be deemed to have been filed simultaneously.

The same applies if, following the Article 50bis notification for the application concerned, another patent application at issue is amended and ceases to satisfy the substantive

requirements for division, making it and the application concerned no longer qualified to be deemed to have been filed simultaneously.

If it was appropriate to give the Article 50bis notification, the examiner shall proceed with his or her examination in accordance with the following guidelines, which can be found in 3. to 5. of "Part I Chapter 2 Section 6 Decision of Dismissal of Amendment."

In so doing, the examiner shall read "final notice of reasons for refusal" in these guidelines as "non-final notice of reasons for refusal accompanied by the Article 50bis notification."

For the sake of clarity, if the examiner gives a renewed notice of reasons for refusal in accordance with 4.(3) or 5.(3) of "Part I Chapter 2 Section 6 Decision of Dismissal of Amendment," then the examiner shall examine whether or not to give the Article 50bis notification as well, in accordance with 2. and 3. .

4.1.2 If it was inappropriate to give the Article 50bis- notification

The examiner shall accept the amendment without dismissing it.

Moreover, if the previously notified reasons for refusal are not resolved in the application as so amended, the examiner shall give another "non-final notice of reasons for refusal," rather than immediately refusing the application.

If the examiner is to give notice of only the reasons for refusal that need to be notified in connection with the amendment, the examiner shall issue it as another "non-final notice of reasons for refusal," rather than as the "final notice of reasons for refusal." Moreover even in the case where the examiner notifies reasons for refusal that are identical with those stated in a notice of reasons for refusal of another patent application, the examiner shall not give the Article 50bis notification.

(Point to consider)

If it is found that an amendment is being made by the applicant asserting and assuming that the Article 50bis notification should not have been given as the reasons for refusal of a patent application and another patent application at issue are not considered to be identical, or on any other grounds, then the examiner shall treat the amendment as if the Article 50bis notification had not been given.

In other words, if the previously notified reasons for refusal are not resolved in the

application as so amended, the examiner shall refuse it.

If the examiner is to give notice of only the reasons for refusal that need to be notified in connection with such amendment, the notification shall be issued as the "final notice of reasons for refusal." Moreover, if the examiner notifies reasons for refusal that are identical with those stated in a notice of reasons for refusal of another patent application, the examiner shall give the Article 50bis notification as well.

4.2 If the notice of reasons for refusal is "final"

If an amendment is made in response to the "final notice of reasons for refusal" accompanied by the Article 50bis notification, the examiner shall re-examine whether it was appropriate to give the Article 50bis notification and issue the notice of reasons for refusal as "final," taking into consideration the applicant's arguments in written opinions, etc.,(see Note to 4.1).

The examiner shall judge whether it was appropriate to issue the notice of reasons for refusal as "final" shall be judged in accordance with 3.2.1 of "Part I Chapter 2 Section 3 Notice of Reasons for Refusal."

4.2.1 If at least either the giving of the Article 50bis notification or the issuance of the notice as "final" was appropriate

The examiner shall examine whether the amendment made in response to the notice of reasons for refusal accompanied by the Article 50bis notification complies with any of the provisions of paragraphs 3 to 6 of Article 17bis. If the examiner determines that it is in violation of any of these provisions, he or she shall decide to dismiss the amendment. See "Part IV Amendments of Description, Claims or Drawings" for detailed guidelines on judgment as to the conformity of such amendment to these provisions.

(Point to consider)

If it was inappropriate to issue the notice of reasons for refusal as "final," but it was appropriate to give the Article 50bis notification at the time it was given, any subsequent amendment must still meet the provisions of paragraphs 3 to 6 of Article 17bis even if such amendment would cause the application concerned to cease to satisfy the substantive requirements for division, making it and another application at issue no longer qualified to be deemed to have been filed simultaneously.

The same applies if, following the Article 50bis notification for the application concerned, another patent application at issue is amended and ceases to satisfy the substantive requirements for division, making it and the application concerned no longer qualified to be deemed to have been filed simultaneously.

For the specific examination procedure in the case where at least either the giving of the Article 50bis notification or the issuance of the notice as "final" was appropriate, the examiner shall observe the following 3. to 5. of "Part I Chapter 2 Section 6 Decision of Dismissal of Amendment."

In so doing, the examiner shall read "final notice of reasons for refusal" in these guidelines as "final notice of reasons for refusal accompanied by the Article 50bis notification."

For the sake of clarity, if the examiner gives a renewed notice of reasons for refusal in accordance with 4.(3) or 5.(3) of "Part I Chapter 2 Section 6 Decision of Dismissal of Amendment," then the examiner shall examine whether or not to issue the notice as "final," and whether or not to give the Article 50bis notification as well, in accordance with 2. and 3. .

4.2.2 If both the giving of the Article 50bis notification and the issuance of the notice as "final" were inappropriate

The examiner shall accept the amendment without dismissing it.

Moreover, if the previously notified reasons for refusal are not resolved in the application as so amended, the examiner shall give another "non-final notice of reasons for refusal," rather than immediately refusing the application.

If the examiner is to give notice of only the reasons for refusal that need to be notified in connection with the amendment, the examiner shall issue it as another "non-final notice of reasons for refusal," rather than as the "final notice of reasons for refusal." Moreover, even in the case where the examiner notifies reasons for refusal that are identical with those stated in a notice of reasons for refusal of another patent application, the examiner shall not give the Article 50bis notification.

(Point to consider)

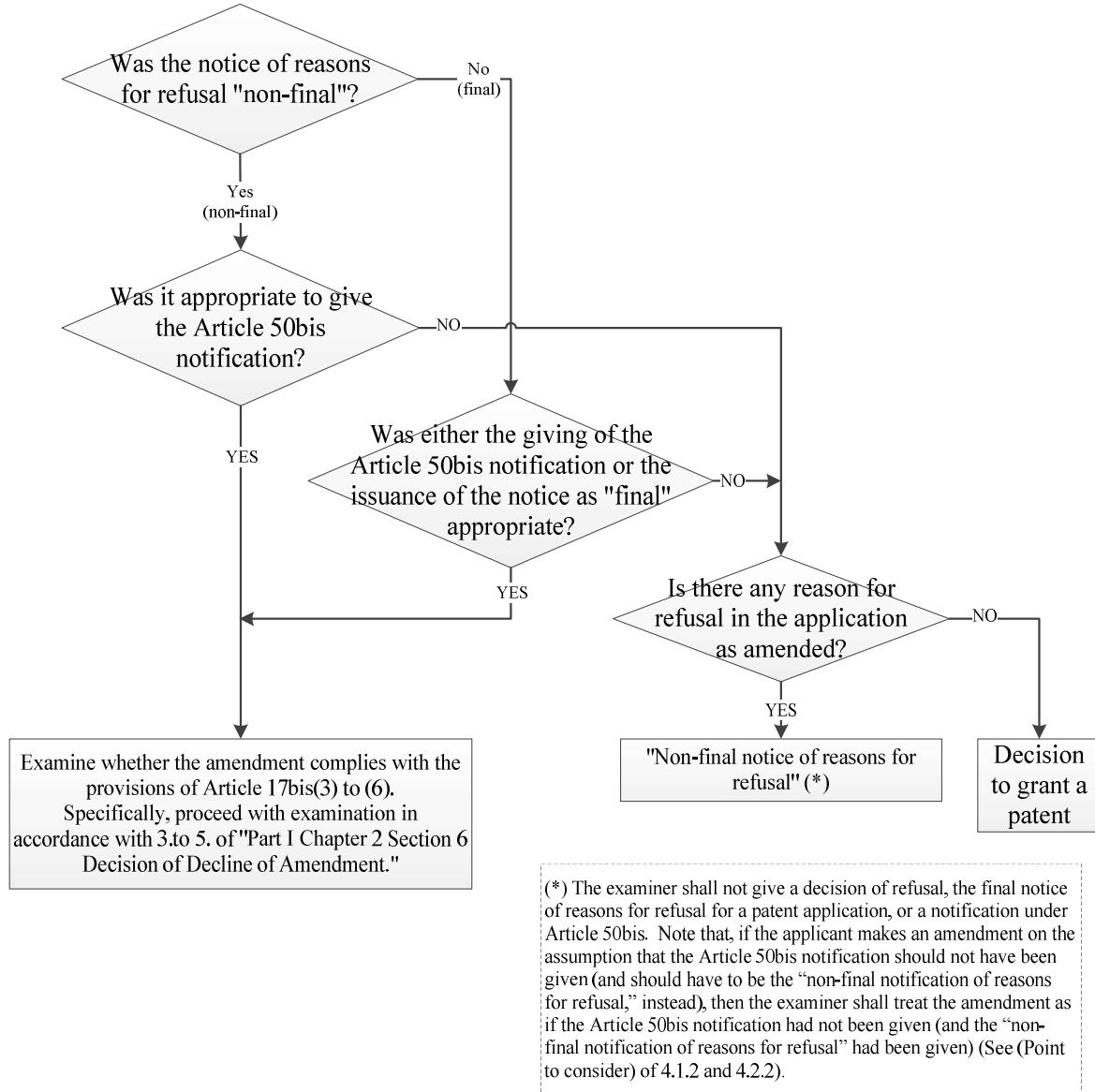
If it is found that an amendment is being made by the applicant asserting and assuming that the Article 50bis notification should not have been given as the reasons for refusal of the patent application and another patent application at issue are not considered to be identical, or

on any other grounds, and that the notice of reasons for refusal should have been issued as "non-final," then the examiner shall treat the amendment as if the Article 50bis notification had not been given and the notice had been issued as "non-final."

In other words, if the previously notified reasons for refusal are not resolved in the application as so amended, the examiner shall refuse it.

If the examiner is to give notice of only the reasons for refusal that need to be notified in connection with such amendment, the notification shall be issued as the "final notice of reasons for refusal." Moreover, if the examiner notifies reasons for refusal that are identical with those stated in a notice of reasons for refusal of another patent application, the examiner shall give the Article 50bis notification as well.

Figure Procedure of examination where an amendment is made in response to a notice of reasons for refusal accompanied by the Article 50bis notification



Chapter 2 Conversion of Application (Patent Act Article 46)

1. Overview

Article 46 of the Patent Act prescribes that the applicant of an application for utility model or design registration may convert it into a patent application. And, this article prescribes that, if the conversion is carried out lawfully, the resulting patent application is deemed to have been filed at the same time as the original application.

Applicants sometimes hope to change the form of application into a more favorable one after its filing, on such grounds as the selection of an incorrect form of application (whether for a patent or for utility model or design registration) or a change in their business plans that take place after the filing of the original application. This is why the application conversion system was introduced.

Provided in 2. to 4. below are explanations in the case where the original application is for the registration of a utility model. Conversion from a design registration application will be explained in 5. .

In this Chapter, "original application" and "new patent application" are called "original application" and "converted application," respectively, regardless of whether the conversion is carried out lawfully or not.

2. Requirements for Conversion of Application

In order for the conversion of an application to be recognized as lawfully done, it must meet certain requirements. The requirements for conversion consist of formal requirements (see 2.1) and substantive requirements (see 2.2). If the conversion requirements are satisfied, the effect of the conversion of an application (see 2.3) is recognized.

2.1 Formal requirements for the conversion of an application

2.1.1 Person entitled to convert an application

Entitled to convert an application is the applicant thereof (Article 46(1)). This

means that the applicant of the original application and that of the converted application must be the same at the time of conversion.

2.1.2 When the conversion of an application is allowed

An application may be converted at any time except at the timings set forth in (i) and (ii) below.

- (i) After a utility model right is established and registered
- (ii) After three years from the date of filing of the application for utility model registration (Note)

(Note) Relief measures are provided in connection with this time limitation (Article 46(5)).

2.2 Substantive requirements for the conversion of an application

The conversion of an application must satisfy requirement 1 below as it is to change the original application into a different form of application. And, given the effect of conversion, that is, the converted application being deemed to have been filed at the same time as the original application, requirement 2 below must be satisfied, too.

(Requirement 1) The matters stated in the description, claims, or drawing of the converted application are within the scope of those stated in the description, claims, or drawings (In this chapter, hereinafter, referred to as "description, etc.") of the original application as they stand immediately prior to conversion.

(Requirement 2) The matters stated in the description, claims, or drawings of the converted application are within the scope of those stated in the description, etc., of the original application as they stood at the time of filing thereof.

However, in the case of the conversion of an application within the time period during which the description, etc., of the original application may be amended (within one month from the date of filing thereof (Article 2bis(1) of the Utility Model Act and Article 1 of the Ordinance for Enforcement of the Utility Model Act)), requirement 1 shall be deemed met if requirement 2 is satisfied. This is because a matter that is not

stated in the description, etc., of the original application as they stand immediately prior to the conversion thereof may be included by an amendment in the description, etc., of the original application before conversion, so long as it was stated in the description, etc., of the original application as they stood at the time of filing thereof.

2.3 Effect of conversion of application

If the conversion requirements are met, the converted application is deemed filed at the same time as the original application. If the substantive requirements in the conversion requirements are not satisfied, however, the converted application is not deemed filed at the same time as the original application, but is treated as being filed when actually submitted. If the formal requirements are not met, the converted application is dismissed per se. If the formal requirements are met, it is deemed that the original application has been withdrawn.

3. Judgment on the Substantive Requirements and Procedure of Examination therefor

The examiner shall proceed with his or her examination substantially in accordance with 3. and 4. of "Chapter 1 Section 1 Requirements for Division of Patent Application."

4. Point to Note when Making a Judgment on the Substantive Requirements

4.1 If the original application is a divisional application

If an application for utility model registration is divided and a divisional application derived therefrom is lawfully converted into a patent application, then the examiner shall make a judgment on the satisfaction of the division requirements in relation to the original application, assuming that the converted patent application is a divisional application (see "Chapter 1 Section 1 Requirements for Division of Patent Application").

5. Point to Note in Connection with the Conversion of a Design Registration Application into a Patent Application

If the original application is for design registration, it shall be treated in the same way as one that is for utility model registration; provided, however, that the examiner shall consider 5.1 and 5.2 below with respect to the permitted timings of and substantive requirements for conversion.

5.1 When the conversion of an application is allowed

An application may be converted at any time except at the timings set forth in (i) to (iii) below.

- (i) After a design right is established and registered
- (ii) After three months (Note 2) from the date of transmittal of a certified copy of the first decision of refusal of the design registration application (Note 1)
- (iii) After three years (Note 3) from the date of filing of the design registration application (except within three months (Note 2) from the date of transmittal of a certified copy of the first decision of refusal (Note 1))

(Note 1) Excluded is the case in which

- a decision of refusal is cancelled by an appeal against the examiner's decision of refusal and is referred back by an appeal decision for re-examination, and another decision of refusal is given (Patent Act Article 160(1) as applied mutatis mutandis in Article 52 of the Design Act, and Patent Act Article 49).

(Note 2) This period may be extended (Article 46(3)).

(Note 3) Relief measures are provided in connection with this time limitation (Article 46(5)).

5.2 Substantive requirements for the conversion of an application

The examiner shall deem "description, claims, or drawings" in 2.2 to be replaced by "statement in the application or drawing and so on attached to the request form."

Note: When any ambiguity of interpretation is found in this provisional translation, the Japanese text shall prevail.

Part VI Chapter 3 Patent Application Based on Utility Model Registration

Chapter 3 Patent Application Based on Utility Model Registration (Patent Act Article 46bis)

1. Overview

The Patent Act stipulates in its Article 46bis that a patent application may be filed by an owner of utility model right on the basis of utility model registration after the establishment and registration of a utility model right, subject to the satisfaction of certain conditions. And, this article stipulates that, if a patent application based on utility model registration is filed lawfully, it is deemed to have been made at the same time as the relevant utility model registration application.

Applications for utility model registration may be converted into patent applications; however, utility model registration applications are registered without substantive examination, so conversion must be completed within a very short period. Under these circumstances, applicants of utility model registration would have difficulties converting their applications into patent applications when such conversion is desirable to better respond to changes in technological trends. This is why the filing of patent applications based on utility model registration is permitted.

2. Requirements for Patent Application based on Utility Model Registration

In order for a patent application based on utility model registration to be recognized as having been made lawfully, certain requirements must be met. Requirements for patent application based on utility model registration consist of formal requirements (see 2.1) and substantive requirements (see 2.2). If these requirements are satisfied, the effect of patent application based on utility model registration (see 2.3) is recognized.

2.1 Formal requirements for patent application based on utility model registration

2.1.1 Person entitled to file a patent application based on utility model registration

Entitled to file a patent application based on utility model registration is the holder of the utility model right to such registration (Article 46bis(1)). This means that

the holder of the utility model right and the applicant of the patent application based on utility model registration must be the same at the time of filing of that patent application.

For the sake of clarity, if there is an exclusive licensee, pledgee, or non-exclusive licensee for the utility model right, then the owner thereof must obtain its approval for this purpose (Article 46bis(4)).

2.1.2 When a patent application based on utility model registration may be filed

Patent applications based on utility model registration may be filed at any time except at the timings set forth in (i) to (iv) below.

- (i) After three years (Note) from the date of filing of the application for utility model registration at issue (Article 46bis(1)(i))
- (ii) When a request for a report of expert opinion on registrability of the utility model is filed by the applicant of the utility model registration or the owner of the utility model right (item (ii) of the same paragraph)
- (iii) After 30 days (Note) from the date of receipt of an initial notice that a request for a report of expert opinion on registrability of the utility model is filed by a person who is neither the applicant of the utility model registration nor the owner of the utility model right (item (iii) of the same paragraph)
- (iv) After the expiration of the originally designated period during which a written reply must be submitted in a trial for invalidation of utility model registration (item (iv) of the same paragraph)

(Note) Relief measures are provided in connection with this time limitation (Article 46bis(3)).

2.1.3 Abandonment of a utility model right

For filing a patent application based on utility model registration, the owner of utility model right must abandon the relevant utility model right (Article 46bis(1) and Article 27sexies of the Ordinance for Enforcement of the Patent Act).

2.2 Substantive requirements for patent application based on utility model registration

Given the effect of patent application based on utility model registration, that is, the relevant patent application being deemed to have been filed at the same time as the relevant utility model registration application, requirement 2 below must be met in addition to requirement 1 below.

(Requirement 1) The matters stated in the description, claims, or drawings of the patent application based on utility model registration are within the scope of those stated in the description, claims, or drawings (In this chapter, hereinafter, referred to as “description , etc.”) of the application for the underlying utility model registration as they stood at the time of registration thereof (Article 46bis(2)).

(Requirement 2) The matters stated in the description, claims, or drawings of the patent application based on utility model registration are within the scope of those stated in the description, etc., of the application for the underlying utility model registration as they stood at the time of filing thereof.

For the purpose of requirement 1, if the description, etc., are corrected after the registration of the utility model, the description, etc., "as corrected" are regarded as the description, etc., as they stood at the time of registration (Article 14bis(11) of the Utility Model Act).

2.3 Effect of patent application based on utility model registration

A patent application based on utility model registration that meets the requirements is deemed to have been filed at the same time as the relevant utility model registration application. If the substantive requirements in requirements for patent application based on utility model registration are not satisfied, however, that patent application is deemed filed when actually submitted, rather than at the same time as the relevant utility model registration application. Note that, if the formal requirements are not met, the patent application based on utility model registration is dismissed per se.

3. Judgment on the Requirements for Patent Application based on Utility Model Registration, and Procedure of Examination therefor

The examiner shall proceed with his or her examination substantially in

accordance with 3. and 4. of "Chapter 1 Section 1 Requirements for Division of Patent Application."

4. Point to Note when Examining a Patent Application based on Utility Model Registration

Even if the invention claimed in a patent application based on utility model registration is identical with the device claimed in the relevant utility model registration, the examiner shall take note of the fact that the provision under Article 39(4) of the Patent Act is not applied thereto (parenthesized provision thereof).

Chapter 4 Reference filing (Patent Act Article 38ter)

1. Overview

Article 38ter of Patent Act rules relating to a patent application that a person desiring a patent files a patent application, without attaching description and necessary drawing(s) to the request, by a method where an applicant asserts that a patent application the person previously filed (hereinafter referred to as “earlier patent application” in this chapter) is to be referred to (hereinafter referred to as “reference filing” in this chapter).

In the same Article, even if description and drawing(s) are not attached to the request at the time of submission of the request of reference filing, if the description and the drawing(s) are submitted by an applicant within four months from the day of submission of the request together with a Document for Submitting Description, etc. (Article 27decies (6) of Regulations under the Patent Act; form 37bis) in which the applicant asserts that the earlier patent application is to be referred to, thus submitted description and drawing(s) are regarded as description and drawing(s) as attached to the request of reference filing and, therefore, the day of submission of the request may be admitted as a filing date.

The provision as to the reference filing rules one of requirements for admitting a filing date prescribed under the Patent Law Treaty (PLT). More specifically, the provision regulates how to handle an application when description and drawing(s) are substituted by reference to the earlier application (Article 5 (7) (a) of the PLT and Article 2 (5) (a) of Rules of the PLT).

2. Requirements for reference filing

In order for the reference filing to be admitted as a legally proper application, formal requirements (see, 2.1) should be satisfied. If the reference filing does not satisfy the formal requirements, the reference filing shall be dismissed.

If the reference filing satisfies the formal requirements, a filing date shall be admitted according to substantive requirements (see, 2.2).

2.1 Formal requirements for reference filing

2.1.1 Person entitled to file a reference filing

Entitled to file such application is a person who filed the earlier patent application (or a successor or a predecessor thereof) (Article 38ter (1)).

2.1.2 Type of application which is not applicable as the reference filing

An application which is not applicable as the reference filing is an application in foreign language (Article 36bis), a divisional application (Article 44), a converted application (Article 46), and a patent application filed based on a utility model registration (Article 46-2) (Article 38ter (1) and (6)).

2.1.3 Application which is applicable as the earlier patent application

An application which is applicable as the earlier patent application is a patent application filed in Japan or a foreign country.

2.1.4 Document which should be submitted in the reference filing

An applicant should submit documents of the below mentioned (i) to (iii) within four months from a day of submission of the request of reference filing (Article 38ter (3) and Article 27decies (3) and (4) of Regulations under the Patent Act).

- (i) a document for submitting description, etc. to which a description and drawing(s) are attached
- (ii) a certified copy of application, claims, or drawing(s) attached to the request of earlier patent application, or a document corresponding to the description, the claims, or the drawings (hereinafter referred to as “description, etc. of earlier patent application”) (hereinafter simply referred to as “certified copy”) (Note)
- (iii) translation of description, etc. of earlier patent application if it is stated in foreign language

(Note) In a case where the applicant has already submitted the certified copy to the Japanese Patent Office (in a case where the applicant has already submitted the certified copy as a

priority certificate for the other patent application, etc.), the applicant may omit submission of the certified copy if the applicant states thereof in the request. Further, in a case where the earlier patent application was filed in Japan, the applicant may omit submission of the certified copy (Article 27decies (5) of Regulations under the Patent Act and Article 26, Remark 32 of Form).

2.2 Substantive requirements for the reference filing

In a case where matters stated in the description or drawing(s) of reference filing remains in matters stated in the description, etc. of earlier patent application, the day of submission of the request of reference filing shall be a filing date of the reference filing. Otherwise, the day of submission of the description and drawing(s) shall be a filing date of the reference filing.

3. Determination on the Substantive Requirements

3.1 Concrete determination steps

The examiner makes determination as to whether or not matters stated in the description or drawing(s) of reference filing remain in matters stated in the description, etc. of earlier patent application by comparing the matters stated in the description or drawing(s) of reference filing (Note 1) with the matters stated in the description, etc. of earlier patent application (Note 2).

Where it is assumed that the description or drawing(s) of reference filing is a result of amendment of the description, etc. of earlier patent application, if the examiner makes determination that the amendment introduces a new matter in relation to the description, etc. of earlier patent application, the day of submission of the description or drawing(s) of reference filing shall be a filing date of the reference filing. Incidentally, with respect to determination as to whether or not the amendment introduces a new matter, see “Part IV, Chapter 2, Amendment Adding New Matter”.

(Note 1) Claim(s) and abstract of the reference filing shall not be the basis for comparison and determination.

(Note 2) In a case where the certified copy has already been submitted (including a case where the certified copy has already been submitted as the priority certificate for the other

patent application (see, 2.1.4 (note)), the description, etc. of earlier patent application stated in the certified copy shall be used in comparison and determination. Where the earlier patent application was filed in Japan and where submission of the certified copy was omitted, the description as of filing the application shall be used, as the description, etc. of earlier patent application, in comparison and determination. The same shall apply hereafter in this chapter.

3.2 Case where the description, etc. of earlier patent application is stated in foreign language

Since it is highly probable that the content of the description, etc. of earlier patent application coincides with the content of translation thereof (see, 2.1.4 (iii)), it is usually sufficient for the examiner to make determination based on the translation of the description, etc. of earlier patent application. The examiner makes determination based on the description, etc. of earlier patent application only if any questions arise in consistency between the description, etc. of earlier patent application and its translation (Note).

(Note) If any questions arise in consistency there between, see (1) of “2.2 Procedures of Examination of the determination of the new matters beyond the original text” and (1) of “2.3 Typical Examples in which comparison with the foreign language documents is necessary” in “Part VII, Chapter 2, Examination of Foreign Language Written Application”. At the time of referencing, it is assumed that the description, etc. of earlier patent application and its translation correspond to “document in foreign language” and “description, etc.”, respectively, in “Part VII, Chapter 2, Examination of Foreign Language Written Application”.

4. Procedure of Examination for Determination on the Substantive Requirements

- (1) If the examiner determines that the matters stated in the description or drawing(s) of reference filing remains in the matters stated in the description, etc. of earlier patent application, the examiner proceeds the examination admitting the day of submission of the request of reference filing as a filing date.

(2) If the examiner determines that the matters stated in the description or drawing(s) of reference filing do not remain in the matters stated in the description, etc. of earlier patent application, the examiner proceeds the examination admitting the day of submission of the description and the drawing(s) as a filing date.

In this case, when the examiner issues Notice of Reasons for Refusal, Notice of Refusal, etc., the examiner shall specify, in the Notice of Reasons for Refusal, the Notice of Refusal, etc., why the examiner determined that the matters stated in the description or drawing(s) of reference filing do not remain in the matters stated in the description, etc. of earlier patent application, concerting the matter to the effect that the examiner admits the day of submission of the description and the drawing(s) as a filing date, and thus admitted filing date.

(3) Against the examiners determination that the day of submission of the description and drawing(s) is admitted as a filing date, the applicant may submit Written Opinion stating argument, explanation, etc. against the admission, and Written Amendment stating that the day of submission of the request of reference filing should be set to a filing date (e.g., Written Amendment to delete the matters which do not remain in the matters stated in the description, etc. of earlier patent application from the matters stated in the description or the drawing(s)).

(4) If the description or drawing(s) was amended according to the submission of the Written Amendment mentioned in (3), the examiner determines again as to whether or not the description or drawing(s) after amendment remains in the matters stated in the description, etc. of earlier patent application. If the examiner determines that the description or drawing(s) after amendment remains in the matters stated in the description, etc. of earlier patent application, the examiner proceeds the examination admitting the day of submission of the request of reference filing as a filing date.

Even when Written Amendment has not been submitted, if the examiner determined that the day of submission of the request of reference filing should be set to a filing date in consideration with contents of the Written Opinion mentioned in (3), the examiner proceeds the examination admitting the day of submission of the request of reference filing as a filing date.

(5) If the examiner changes a filing date to the day of submission of the request of reference filing accepting the Written Amendment and the Written Opinion mentioned in (3) received from the applicant and, therefore, if the examiner issues Notice of

Reasons for Refusal, Notice of Refusal, etc., the examiner shall specify, in the Notice of Reasons for Refusal, the Notice of Refusal, etc., concerning the matter to the effect that the examiner admits the day of submission of the request of reference filing as a filing date, and thus admitted filing date.

(6) If the examiner issues Notice of Reasons for Refusal, Notice of Refusal, etc. still admitting the day of submission of the description and drawing(s) as a filing date even after considering the Written Amendment and the Written Opinion mentioned in (3), the examiner shall specify, in the Notice of Reasons for Refusal, the Notice of Refusal, etc., the reason why the applicant's argument, explanation, etc. are not acceptable, concerning the matter to the effect that the day of submission of the description and drawing(s) is admitted as a filing date, and thus admitted filing date.

<Relevant Provisions>

Patent Act

(Amendment of Description, Claim, or Drawing attached to the Request)

Article 17-2

(Omitted)

(2) to (4) (Omitted)

(5) In addition to the requirements provided in the preceding two paragraphs, in the cases set forth in items (i), (iii) and (iv) of paragraph 1 (the case set forth in item (i) thereof being limited to the case where the applicant has received a notice under Article 50-2 along with the notice of reasons for refusal), the amendment of the scope of claims shall be limited to those for the following purposes:

(i) to (iv) (Omitted)

(6) (Omitted)

(Patent applications)

Article 36

(Omitted)

(2) The description, scope of claims, drawings (where required), and abstract shall be attached to the application.

(3) to (7) (Omitted)

(Certification of filing date)

Article 38bis

The Commissioner of the Patent Office shall certify the date on which the application with regard to a patent application is submitted as the date of the filing of a patent application, except in cases where the patent application falls under any of the following items:

- (i) where it is recognized that indication of requesting the grant of a patent is not clear;
- (ii) where the statement of the name of the applicant(s) does not exist or it is recognized that the said statement is not so clear to specify the applicant(s); and
- (iii) where description (in foreign-language-written-application, the matters to be stated in the description are stated in foreign-language as provided by Ordinance of the Ministry of Economy, Trade and Industry under Article 36bis(1); hereinafter, the same shall apply in this Article) is not attached to the said

application (except in the case where a patent application is filed by a method prescribed in the paragraph (1) of the immediately following Article).

(2) to (9) (Omitted)

(Patent application by a method for claiming to refer an earlier patent application)

Article 38ter

Except for a case of filing a foreign-language-written-application, a person requesting the grant of a patent, notwithstanding Article 36(2), may file a patent application by a method for claiming to refer a patent application made by the person (including one made in a foreign country, hereinafter referred to as "earlier patent application" in this Article); provided, however, that this shall not apply where the patent application falls under item (i) or (ii) of Article 38bis(1).

(2) A person filing a patent application by a method under the preceding paragraph shall submit to the Commissioner of the Patent Office a document stating thereof and matters as provided by Ordinance of the Ministry of Economy, Trade and Industry, at the time of filing the said patent application.

(3) A person who has filed a patent application by the method under paragraph (1) shall submit the description and drawing(s) (if necessary) to be submitted with the application of the said patent application, and the document as provided by Ordinance of the Ministry of Economy, Trade and Industry with regard to the earlier patent application referred in the method under the said paragraph within the time limit as provided in Ordinance of the Ministry of Economy, Trade and Industry.

(4) Where the matters stated in the description and drawing(s) submitted under the preceding paragraph do not remain the matters stated in the description, claims or drawing(s) attached to the application of the earlier patent application referred in the method under paragraph(1) (in the case where the said earlier patent application is a foreign-language-written-application, foreign-language-documents; in the case where the said earlier patent application is filed in a foreign country, documents which are submitted at the time of filing the application and correspond to the description, claims or drawing(s)), the said patent application, notwithstanding Article 38bis(1), shall be deemed to have been filed at the time of submission of the description and drawing(s) under the preceding paragraph.

(5) The description and drawing(s) submitted under paragraph (3) shall be deemed to be submitted with the application.

(6) Any of the preceding paragraphs shall not apply to a new patent application

arising from the division of a patent application under Article 44(1), a patent application arising from the conversion of an application under Article 46(1) or (2), and a patent application based on a utility model registration under Article 46bis(1).

(Division of patent applications)

Article 44

An applicant for a patent may extract one or more new patent applications out of a patent application containing two or more inventions only within the following time limits:

- (i) at such time when or within such time period in which amendments of the description, scope of claims or drawings attached to the request are allowed;
 - (ii) within 30 days from the date of service of a certified copy of the examiner's decision to the effect that a patent is to be granted (excluding the examiner's decision to the effect that a patent is to be granted under Article 51 as applied mutatis mutandis under Article 163(3) and the examiner's decision to the effect that a patent is to be granted with regard to a patent application that has been subject to examination as provided in Article 160(1)); and
 - (iii) within three months from the date of service of a certified copy of the examiner's initial decision to the effect that the application is to be refused.
- (2) In the case referred to in the preceding paragraph, the new patent application shall be deemed to have been filed at the time of filing of the original patent application; provided, however, that this shall not apply for the purposes of application of these provisions and the provision of Article 30(3) in the case where the new patent application constitutes another patent application as prescribed in Article 29bis or a patent application as prescribed in Article 3bis of the Utility Model Act.
- (3) For the purpose of application of Article 43(2) (including the cases where it is applied mutatis mutandis in Article 43bis(2) (including the case where it is applied mutatis mutandis in paragraph 3 of the preceding Article) and in paragraph 3 of the preceding Article) in the case where a new patent application is filed under paragraph 1, "within one year and four months from the earliest of the following dates" in Article 43(2) shall be deemed to be replaced with "within one year and four months from the earliest of the following dates or three months from the date of filing of the new patent application, whichever is later."
- (4) Where a new patent application is filed under paragraph 1, any statements or documents which have been submitted in relation to the original patent application

and are required to be submitted in relation to the new patent application under Article 30(3), 41(4), or 43(1) and 43(2) (including the cases where these provisions are applied mutatis mutandis in Article 43bis(2) (including the case where it is applied mutatis mutandis in paragraph 3 of the preceding Article) and in paragraph 3 of the preceding Article) shall be deemed to have been submitted to the Commissioner of the Patent Office simultaneously with such new patent application.

(5) If the period as provided in Article 108(1) is extended under Article 4 or Article 108(3), the 30-day period as provided in paragraph (1)(ii) shall be deemed to have been extended only for that period as extended.

(6) If the period as provided in Article 121(1) is extended under Article 4, the three-month period as provided in paragraph (1)(iii) shall be deemed to have been extended only for that period as extended.

(7) If the applicant of a new patent application as provided in paragraph 1 cannot file such new application within the time period provided in item (ii) or (iii) of the same paragraph due to a reason not attributable to the applicant, then, notwithstanding these provisions, the applicant may file such new application within 14 days (or two months, if the applicant is a resident abroad) from the day when such reason ceases to exist, but no later than six months from the expiry of the time period provided in these provisions.

(Conversion of application)

Article 46

An applicant of utility model registration may convert the application into a patent application; provided, however, that this shall not apply after the expiration of three years from the date of filing of the utility model registration application.

(2) An applicant of design registration may convert the application into a patent application; provided, however, that this shall not apply after the expiration of three months from the date of service of a certified copy of the examiner's initial decision to the effect that the application for design registration is to be refused or after the expiration of three years from the date of filing of the design registration application (except within three months from the date of service of a certified copy of the examiner's initial decision to the effect that the application for design registration is to be refused).

(3) If the period as provided in Article 46(1) of the Design Act is extended under Article 4 of the Patent Act as applied mutatis mutandis in Article 68(1) of the Design

Act, the three-month period as provided in the proviso of the preceding paragraph shall be deemed to have been extended only for that period as extended.

(4) If an application is converted pursuant to the provision of paragraph 1 or 2, the original application shall be deemed to have been withdrawn.

(5) If a person who intends to convert an application pursuant to the provision of paragraph 1 cannot convert such application within the time period provided in the proviso thereof due to a reason not attributable to him or her or if a person who intends to convert an application pursuant to the provision of paragraph 2 cannot convert such application within the three-year period provided in the proviso thereof due to a reason not attributable to him or her, then, notwithstanding these provisions, he or she may convert such application within 14 days (or within two months if he or she is a resident abroad) from the day when such reason ceases to exist, but no later than six months from the expiration of the time periods provided in these provisions.

(6) The provisions of paragraphs 2 to 4 of Article 44 shall apply mutatis mutandis to the conversion of an application pursuant to the provision of paragraph 1 or 2.

(Patent applications based on utility model registration)

Article 46-2

Except for the following cases, a holder of utility model right may file a patent application based on his/her own utility model registration as provided in an Ordinance of the Ministry of Economy, Trade and Industry, in which case, the utility model right shall be abandoned:

- (i) when three years has elapsed from the date of filing of the application for the relevant utility model registration;
- (ii) when a request for the examiner's technical opinion as to the registerability of the utility model claimed in the utility model registration application or of the utility model registration (simply referred to as "utility model technical opinion" in the following item) is filed by the applicant of the utility model registration or the utility model right holder pursuant to the provision of Article 12(1) of the Utility Model Act;
- (iii) when 30 days has elapsed from the date of receipt of an initial notice pursuant to the provision of Article 13(2) of the Utility Model Act that pertains to a request for a utility model technical opinion made by a person who is neither the applicant of the relevant utility model registration nor the holder of the relevant utility model right in connection with the relevant utility model registration

application or the relevant utility model registration; and

(iv) when the period originally designated pursuant to the provision of Article 39(1) of the Utility Model Act in connection with a trial for the invalidation of the relevant utility model registration requested under Article 37(1) thereof, has expired.

(2) A patent application filed pursuant to the provision of the preceding paragraph shall be deemed to have been filed at the time of filing of the relevant utility model registration application if the matters stated in the description, scope of claims, or drawings attached to the patent request are within the scope of the matters stated in the description, scope of claims, or drawings attached to the utility model registration request on which the patent application is based; provided, however, that this shall not apply for the purpose of the application of these provisions in the case where such patent application is another patent application as provided in Article 29-2 or a patent application provided in Article 3-2 of the Utility Model Act, as well as the application of the provisions of Article 30(3), the proviso of Article 36-2(2), and Article 48-3(2).

(3) If a person who intends to file a patent application pursuant to the provision of paragraph 1 cannot file such application within the time period provided in item (i) or (iii) of the same paragraph due to a reason not attributable to him or her, then, notwithstanding these provisions, he or she may file such application within 14 days (or within two months, if he or she is a resident abroad) from the day when such reason ceases to exist, but no later than six months from the expiration of the time periods provided in these provisions.

(4) If there is an exclusive licensee, a pledgee, or a non-exclusive licensee pursuant to the provision of Article 35(1) of this Act as applied mutatis mutandis in Article 11(3) of the Utility Model Act, the provision of Article 77(4) of this Act as applied mutatis mutandis in Article 18(3) of the Utility Model Act or the provision of Article 19(1) of the Utility Model Act, then the holder of a utility model right may file a patent application pursuant to the provision of paragraph 1 only when the consent of such exclusive licensee, pledgee, or non-exclusive licensee has been obtained.

(5) The provisions of Articles 44(3) and 44(4) shall apply mutatis mutandis to the filing of a patent application pursuant to the provision of paragraph 1.

(Notice to the effect that the reasons for refusal stated therein are the same as those stated in a preceding notice)

Article 50-2

In the case where the examiner intends to give a notice of reasons for refusal for a patent application under the preceding Article, if such reasons for refusal are the same as those stated in a notice given under the preceding Article (including the cases in which it is applied mutatis mutandis in Article 159(2) (including the case in which it is applied mutatis mutandis in Article 174(2)) and in Article 163(2)) in connection with another patent application (limited to one that is deemed to have been filed simultaneously with the application concerned by virtue of the application of the provision of Article 44(2) to at least either of the application concerned and such other application) (except where the contents of such notice were not accessible to the applicant of the application concerned prior to the filing of a request for examination thereof), then the examiner shall also give a notice to that effect.

Regulations under the Patent Act

(Procedure, etc. of a case where a person files a patent application by asserting referencing to an earlier patent application)

Article 27decies

Matters prescribed by the Ordinance of the Ministry of Economy, Trade and Industry under Article 38ter (2) of the Patent Act shall be listed below:

(i) the name of country or international organization where the earlier patent application was filed

(ii) the filing date of the earlier patent application

(iii) the application number of the earlier patent application

(2) A person who intends to file a patent application in the manner prescribed in Article 38ter (1) of the Patent Act may omit submission of document prescribed under Article 38ter (2) if the person states concerning the matter to that effect in the request of the patent application and matters listed in the former paragraph.

(3) Period prescribed by the Ordinance of the Ministry of Economy, Trade and Industry under Article 38ter (3) of the Patent Act shall be four months from the day of filing the patent application.

(4) The document prescribed by the Ordinance of the Ministry of Economy, Trade and Industry under Article 38ter (3) of the Patent Act shall be the copies of documents as of filing the earlier patent application certified by the country or the international organization where the application was filed, the documents corresponding to the description, claims, and drawing(s) of the application (hereinafter referred to as “certified copy of earlier patent application” in this article)

and, in a case where the certified copy of earlier patent application is stated in a foreign language, Japanese translation thereof.

(5) A person who filed a patent application in the manner prescribed in Article 38ter (1) of the Patent Act may omit submission of the certified copy of earlier patent application, notwithstanding the provision of Article 38 (3) of the Patent Act, in a case where the applicant has already submitted the certified copy of earlier patent application or the corresponding document to the Commissioner of the JPO, in a case where the applicant has already submitted the document prescribed under Article 43 (5) of the Patent Act (Article 43bis (2) of the Patent Act (including a case where applied mutatis mutandis pursuant to Article 43ter (3) of the Patent Act) and including a case where applied mutatis mutandis pursuant to Article 43ter (3) of the Patent Act) to the commissioner of the JPO (including a case where the applicant omits submission of the document in which matters prescribed in each item of Article 27ter (3) (iii) are stated pursuant to the provision of Article 27quater (5)), or in a case where the earlier patent application was filed in Japan.

(6) In a case where the applicant submits the description and necessary drawing(s) pursuant to the provision of Article 38ter (3) of the Patent Act, the submission should be performed pursuant to Form 37bis.

(7) In a case where the applicant submits the certified copy of earlier patent application and Japanese translation thereof pursuant to the provision of Article 38ter (3) of the Patent Act, the submission should be performed pursuant to Form 22.

Patent Law Treaty (PLT)

Article 5 Filing Date

(1) [Elements of Application]

(a) Except as otherwise prescribed in the Regulations, and subject to paragraphs (2) to (8), a Contracting Party shall provide that the filing date of an application shall be the date on which its Office has received all of the following elements, filed, at the option of the applicant, on paper or as otherwise permitted by the Office for the purposes of the filing date:

- (i) an express or implicit indication to the effect that the elements are intended to be an application;
- (ii) indications allowing the identity of the applicant to be established or allowing the applicant to be contacted by the Office;
- (iii) a part which on the face of it appears to be a description.

(b),(c) (Omitted)

(2) to (6) (Omitted)

(7) [Replacing Description and Drawings by Reference to a Previously Filed Application]

(a) Subject to the requirements prescribed in the Regulations, a reference, made upon the filing of the application, in a language accepted by the Office, to a previously filed application shall, for the purposes of the filing date of the application, replace the description and any drawings.

(b) (Omitted)

(8) (Omitted)

Regulations under the patent law treaty

Rule 2 Details Concerning Filing Date Under Article 5

(1) to (4) (Omitted)

(5) [Requirements Under Article 5(7)(a)]

(a) The reference to the previously filed application referred to in Article 5(7)(a) shall indicate that, for the purposes of the filing date, the description and any drawings are replaced by the reference to the previously filed application; the reference shall also indicate the number of that application, and the Office with which that application was filed. A Contracting Party may require that the reference also indicate the filing date of the previously filed application.

(b),(c) (Omitted)

(6) (Omitted)

Part VII

Foreign Language Written Application

Note: When any ambiguity of interpretation is found in this provisional translation, the Japanese text shall prevail.

Part VII Foreign Language Written Application

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Part VII Foreign Language Written Application

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<Relevant Provisions>

Note: When any ambiguity of interpretation is found in this provisional translation, the Japanese text shall prevail.

Part VII Chapter 1 Overview of Foreign Language Written Application System

Chapter 1 Overview of Foreign Language Written Application System

See "Part VIII International Patent Application," concerning the handling of international patent applications in foreign language (foreign language patent applications).

1. Overview

The foreign language written application system is a system by which a person who seeks a patent (in this chapter, hereinafter, referred to as the "applicant") may file a patent application by attaching to a patent request the written document and written abstract in foreign language as prescribed in an Ordinance of the Ministry of Economy, Trade and Industry, instead of the description, claims, required drawings (in this chapter, hereinafter, referred to as "description, etc.") and abstract (Article 36bis(1)).

Foreign applicants usually file a patent application in Japan, claiming the priority under the Paris Convention based on the first application in foreign language. If only applications in Japanese were admissible, foreign applicants might be required to prepare the translation in a short period of time in cases where there is no choice but to file a patent application immediately before the expiration of the period for claiming the priority under the Paris Convention. In addition, it is not admissible to add, by amendments, other than the matters which are not stated in the originally attached description, etc. Therefore, in cases where foreign applicants file a patent application by translating the first application into Japanese and if there is any mistranslation in the process of translating a foreign language into Japanese, no invention may achieve appropriate protection, including opportunity to correct the mistranslation based on the statements in foreign language.

For solving these problems, the foreign language written application system has been established.

2. Documents concerning Foreign Language Written Application

2.1 Patent request

Concerning a foreign language written application, the applicant should file a patent request in Japanese similarly as the regular patent applications in Japanese (in

this part, hereinafter, referred to as simply "regular patent application").

2.2 Foreign language document and foreign language abstract document

(1) The applicant may attach the foreign language document and foreign language abstract document instead of the description, etc. and abstract set forth in Article 36(2) (Article 36bis(1) and Article 25quarter of Regulations under the Patent Act).

(2) Foreign language documents are the following documents of item (i) and (ii).

- (i) foreign language document stating the matters(Article 36(3) to (6)) necessary to be stated in the description, etc. and the claims
- (ii) among required drawings, those stating the explanation included in themselves, in foreign language

In addition, a foreign language abstract document is a document stating the matters (Article 36(7)) necessary to be stated in the abstract, in foreign language.

Furthermore, a foreign language document is not the description, etc. as prescribed in Article 36(2). Moreover, a foreign language abstract document is not the abstract as prescribed in Article 36(2).

(3) In cases where patent request, foreign language document and foreign language abstract document have been submitted, the patent application in foreign language is accepted as a regular patent application and the filing date is accorded for the request.

2.3 Translation

(1) The applicant who files a foreign language application is required to submit the translation into Japanese of the foreign language document and foreign language abstract document within 16 months from the filing date (earliest priority date, in case of the application claiming priority) (Article 36bis(2)). However, in cases where the foreign language application is a patent application based on a divisional application, converted application, or utility model registration, the applicant may submit the translation within 2 months from the filing date of that application, even after the expiration of the period of 16 months from the filing date of original application (the proviso of the same paragraph).

If the translation has not been submitted within the period for submission of the

translation, it is notified to the applicant under the name of the Director-General of the Patent Office. (Article 36bis(3)). The applicant can submit the translation of the foreign language document within 2 months from the notified date (Article 36bis(4) and Article 25septies(4) of Regulations under the Patent Act)

Meanwhile, even if the drawings filed at the filing date do not include explanations, the applicant is required to submit the translation of all drawings.

See 3., concerning the handling in cases where the translation has not been submitted.

(2) The translation of foreign language document is deemed as the description, etc. filed as attached to the patent request, and the translation of a foreign language abstract document is deemed as the abstract filed as attached to the patent request (Article 36bis(8)).

2.4 Written correction of mistranslation

(1) If the applicant who files a foreign language written application amends the description, etc. for the purpose of correction of mistranslation, the applicant is not required to submit written amendment, but written correction of mistranslation stating the reasons for correcting mistranslation (Article 17bis(2)).

(2) If the applicant who files a foreign language written application makes amendment of the description, etc. (in this part, hereinafter, referred to as "regular amendment") together with the amendment for the purpose of correction of mistranslation, the applicant may include the matters of amendment corresponding to regular amendment into written correction of mistranslation.

3. Handling in Cases Where Translation has not been Submitted

3.1 Cases where translation of "foreign language document (other than drawings)" has not been submitted

In cases where the translation of foreign language document other than drawings has not been submitted during the period (See 2.3(1)) for submitting translation as set forth in Article 36bis(2) and (4), the foreign language written

application is deemed to have been withdrawn (Article 36bis(5)).

3.2 Cases where translation of drawings of "foreign language document" has not been submitted

In cases where the translation of drawings has not been submitted, the patent application is not deemed to have been withdrawn, but is handled as the patent request without drawings.

The applicant and the examiner should keep in mind that, as a result, the detailed description of the invention or the claims may fail to satisfy the requirements of statements or the requirements for patentability, and thus the correction of mistranslation may be necessary.

3.3 Cases where translation of abstract has not been submitted

Even though the translation of abstract has not been submitted within 16 months from the filing date, the patent application is not deemed to have been withdrawn. However, lack of submission of such translation may be subject to an order of amendment and dismissal of proceedings (Article 17(3)(ii) and Article 18(1)).

4. Amendment of the Description, etc. of Foreign Language Written Application

4.1 Document treated as the subject of amendment

Concerning foreign language written application, the description, etc. (See 2.3(2)) is treated as the subject of amendment. Foreign language documents and foreign language abstract documents are not entitled to amendment (Article 17(2)).

4.2 Period for amending the description, etc.

Concerning a foreign language written application, the period for amending the description, etc. is the same as the period for amending the description, etc. of regular patent applications. In addition, the period for amendment is the same as the above period, regardless of a regular amendment or the amendment for the purpose of correction of mistranslation (See "Part IV Chapter 1 Requirements for Amendments,"

concerning the period for amendment).

5. Reasons for Refusal against Foreign Language Written Application

Concerning foreign language written application, the matters which fall under the following 5.1 constitute the reasons for refusal, in addition to the matters which fall under the reasons for refusal in regular patent applications.

In addition, in cases where addition of new matters falls under the following 5.2, the addition constitutes the reasons for refusal.

5.1 Addition of new matters to original text (See 2. of "Chapter 2 Examination of Foreign Language Written Application")

In cases where a foreign language written application includes those matters stated in the description, etc. which fall within the matters (new matters beyond original text) other than those stated in foreign language document, the application constitutes the reasons for refusal (Article 49(vi)).

5.2 Addition of new matters beyond translation (See 3. of " Chapter 2 Examination of Foreign Language Written Application")

In cases where foreign language written application includes, by written amendment, those matters stated in the description, etc. after amendment which fall within the matters (new matters beyond translation) other than those stated in the following document of item (i) or (ii), the application constitutes the reasons for refusal (Article 17bis(3)).

- (i) In cases where written correction of mistranslation has not been submitted, the translation which is deemed as the description, etc. submitted as attached to the patent request
- (ii) In cases where the description, etc. has been amended by submitting written correction of mistranslation, the translation, the description, etc. after the amendment

6. Handling of Various Patent Applications

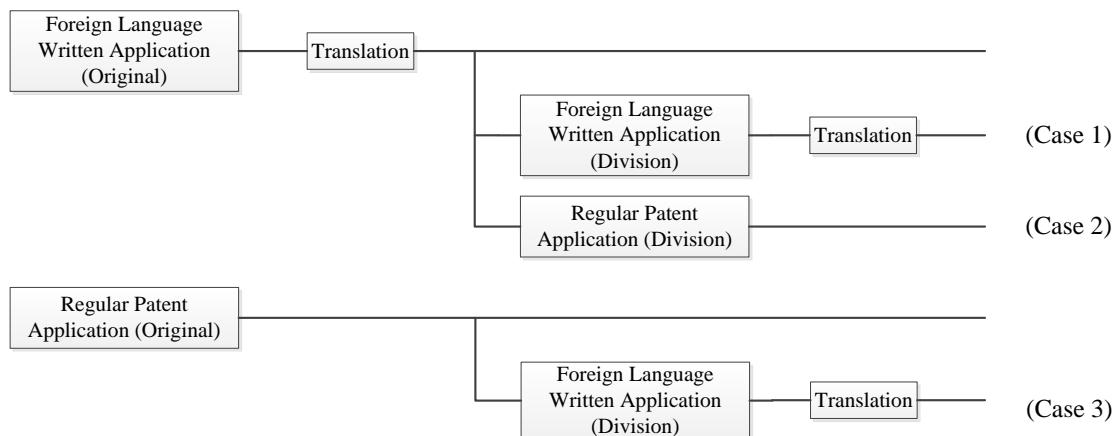
A foreign language written application is that which has been accepted as a regular national patent application. Therefore, a divisional application or converted application based on a foreign language written application, or claim of internal priority is admitted.

In addition, concerning a divisional application, converted application, patent application based on utility model registration, or application claiming internal priority, there is no difference from regular patent applications in view of filing a patent application. Accordingly, in case of filing these applications, foreign language written applications are admitted.

6.1 Handling of divisional application

6.1.1 Types of divisional application

As types of the divisional application related to foreign language written application, the following cases can be indicated.



6.1.2 Cases where original application is made in foreign language, the period for filing a divisional application (Case 1 or Case 2)

The period for filing a divisional application in cases where a foreign language written application is an original application, is basically the same as the period for filing a divisional application in cases where a regular patent application is an original application. However, since the description, etc. of the original application to be divided does not exist until submitting the translation for an original application, the applicant cannot file a divisional application during this period.

6.1.3 Points to note on examination

(1) Cases where original application is foreign language written application (Case 1 or Case 2)

The document submitted at the filing date of original application is a foreign language document. Therefore, concerning the requirement of “within the matters stated in the description, etc. as of the filing of original application” (See 2.2 and 3.2 of “Part VI Chapter 1 Section 1 Requirements for Division of Patent Application”) among the substantial requirements of division of patent application, the examiner makes a determination based not on the translation of the original application but based on the foreign language document.

However, it is highly possible that the contents of the foreign language document and those of translation correspond with each other. Therefore, it is generally sufficient to make determination based on the translation of the original application.

(2) Cases where divisional application is foreign language written application (Case 1 or Case 3)

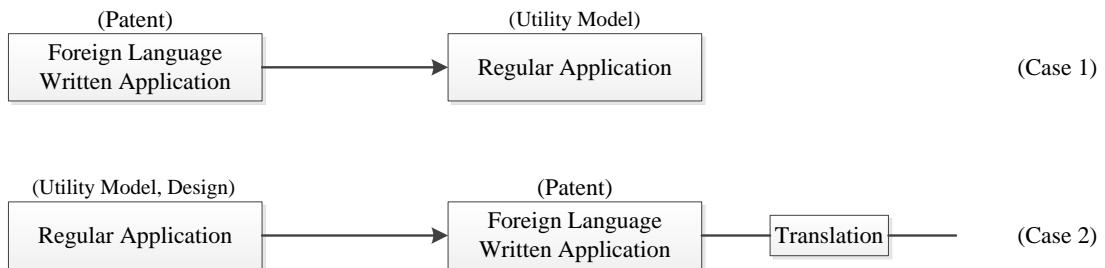
The examiner determines whether the substantial requirements of division of patent application are satisfied based not on the foreign language document but based on the translation deemed as the description, etc., or in cases where amendment has been made after the filing, based on the description, etc. after the amendment.

When the translation deemed as the description, etc., or in cases where amendment has been made after the filing, the description, etc. after the amendment, satisfies the substantial requirements of division of patent application, even if foreign language document does not satisfy the substantial requirements, it is considered that the division of patent application has been appropriately made.

6.2 Handling of converted application

6.2.1 Types of Converted Application

It is not admitted that an application for utility model registration or application for design registration is made in such a manner as a foreign language written application. Accordingly, as types of the converted application related to foreign language written application, the following cases can be indicated.



6.2.2 The period for filing converted application in cases where original application is foreign language written application (Case 1)

The period for filing a converted application in cases where original application is foreign language written application, is same as the period for filing a converted application in cases where original application is a regular patent application.

6.2.3 Points to note on examination, etc.

(1) Cases Where Original Application is Foreign Language Written Application (Case 1)

The document which has been filed at the filing date of original application is foreign language document. Therefore, the examiner does not determine on the substantive requirements of conversion of patent application based on the translation of original application but based on foreign language document.

However, it is highly possible that the contents of foreign language document and those of translation correspond with each other. Therefore, in cases where translation has been submitted, it is generally sufficient to make determination based on the translation of original application.

(2) Cases Where Converted Application is Foreign Language Written Application (Case 2)

The examiner does not determine whether the substantive requirements of conversion of patent application are satisfied based on foreign language document but based on the translation deemed as the description, etc., or in cases where amendment has been made after the filing, based on the description, etc. after the amendment.

When the translation deemed as the description, etc., or in cases where amendment has been made after the filing, the description, etc. after the amendment, satisfies the substantive requirements of conversion of patent application, even if

foreign language document does not satisfy the substantive requirements, it is considered that the conversion of patent application has been lawfully made.

6.3 Handling of patent application based on utility model registration

6.3.1 Types of patent application based on utility model registration

It is not admitted that application for utility model registration is made in such a manner as foreign language written application. Accordingly, as types of the patent application based on the utility model registration related to foreign language written application, following case can be indicated.



6.3.2 Points to note on determination

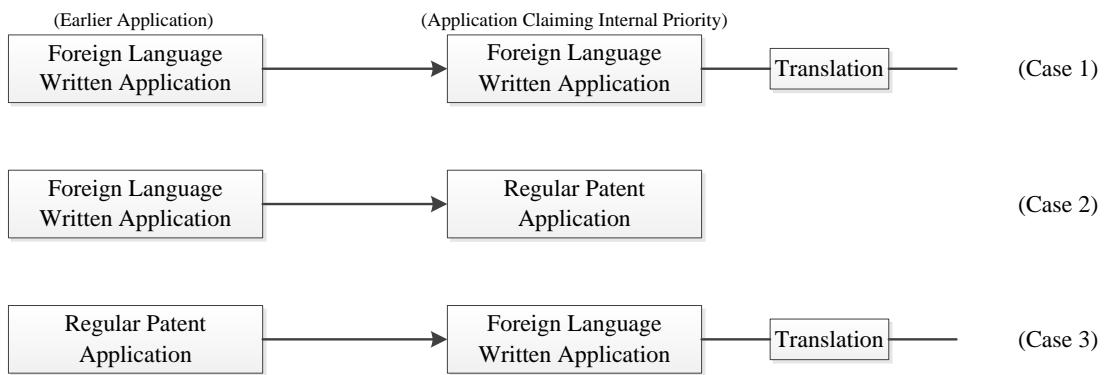
The examiner does not determine whether the substantive requirements of the patent application based on utility model registration are satisfied based on foreign language document but based on the translation deemed as the description, etc., or in cases where amendment has been made after the filing, based on the description, etc. after the amendment.

When the translation deemed as the description, etc., or in cases where amendment has been made after the filing, the description, etc. after the amendment, satisfies the substantive requirements of the patent application based on utility model registration, even if foreign language document does not satisfy the substantive requirements, it is considered that the patent application based on utility model registration has been lawfully made.

6.4 Handling of claim of internal priority

6.4.1 Types of claim of internal priority

As types of the claim of internal priority related to foreign Language written application, the following cases can be indicated.



6.4.2 In Cases where earlier application is foreign language written application, the period for claiming internal priority (Case 1 or Case 2)

In cases where earlier application is foreign language written application, the period for claiming internal priority is same as the period for filing a patent application claiming internal priority in cases where earlier application is a regular application.

6.4.3 Points to note on examination

(1) Cases where earlier application which constitutes a basis of claim of internal priority is foreign language written application (Case 1 or Case 2)

In cases where the claimed invention of the application claiming internal priority falls within the matters stated in foreign language document of the earlier application which constitutes a basis of claim of internal priority, the effect of claim of internal priority is admitted (the bracket of main paragraph of Article 41(1)).

However, it is highly possible that the contents of foreign language document and those of translation correspond with each other. Therefore, in cases where translation has been submitted, it is generally sufficient to make determination based on the translation of earlier application.

(2) Cases where the application claiming internal priority is foreign language written application (Case 1 or Case 3)

The examiner determines whether the effect of claim of internal priority is admitted, by comparing earlier application with the translation deemed as the description, etc. of foreign language written application claiming priority, or in cases where amendment has been made after the filing, with the matters stated in the

description, etc. after the amendment.

With regard to the matters stated in earlier application, among the translation deemed as the description, etc. of foreign language written application, or in cases where amendment has been made after the filing, among the description, etc. after the amendment, the effect of claim of internal priority is admitted.

In any case of above (1) and (2), it is sufficient, in principle, to determine whether the effect of claim of internal priority is admitted, only when the prior art and the like which can be a basis of reasons for refusal has been found during the period from the filing date of earlier application to the filing date of the application claiming internal priority, similarly as the regular patent application claiming internal priority.

Chapter 2 Examination of Foreign Language Written Application

1. Overview

In the foreign language written application, documents in which the content of the invention has been disclosed as of filing to submit it (documents corresponding to the originally filed Description, the Claims or the Drawings (hereinafter, referred to as an "originally attached description etc." in this chapter) in a regular patent application) are the foreign language documents. Since the translation of the foreign language documents is deemed to be the Description, the Claims and the Drawings, the examination of foreign language written application is performed based on this translation.. The examination is the same for the regular patent application, except in the following points (i) to (iii). Based on these points, the examiner determines the new matter beyond the original text and the new matter beyond the translation. In this chapter, the examination as for these points is explained.

- (i) a point of that there is a new matter as to the original text in the description, the claims or the drawings (hereinafter, referred to as "description, etc." in this chapter) is as a reason for refusal (see 2.)
- (ii) a point that the description, etc. on which the determination of "amendment adding a new matter" is based are the translations (including the description, etc. which are amended by the correction of the incorrect translation, where the statement of correction of the incorrect translation has been submitted) (see 3.).
- (iii) a point that the amendment as for the description, etc. is made not only by the written amendment but also by the statement of correction of the incorrect translation (see 4.)

2. New Matter beyond the Original Text

Where the matter stated in the description, etc. is not within the range of the matter stated in the foreign language document description, etc. for the foreign language written application (that is, the description contains new matter beyond the original text), this will be the reason for refusal (Article 49(vi)).

In case of the foreign language written application, documents in which the content of the invention has been disclosed as of filing to submit it (documents corresponding to the originally attached description etc. in the regular patent

application) are the foreign language documents. Therefore, it shall not be recognized that matters not stated in the foreign language documents are added by submitting the following translations or the amendment to grant a patent. Accordingly, when the description contains the new matter beyond the original text in the description, etc. the reason for refusal arises.

2.1 Determination as to whether the new matter beyond the original text is present in the description, etc.

The examiner assumes a translation (hereinafter, referred to as an "assumed translation" in this chapter) which is translated from the foreign language document into proper Japanese, and determines whether the amendment is an amendment adding new matters in relation to the assumed translation, where it is presumed that the description, etc. are description, etc. which are amended for the assumed translation. See the "Part IV Chapter 2 Amendment Adding New Matter" as to determination as to whether it corresponds to the amendment adding the new matters.

(Points to note)

- (1) Even where it is translated upon interchanging the order of the sentences etc. in the foreign language documents, no new matters beyond the original text are present, as long as matters not stated in the foreign language document are deemed to be stated in the description, etc. by interchanging thereof.

Therefore, if it is the matter stated in any portions in the foreign language documents, such a matter does not normally correspond to the new matters beyond the original text.

- (2) In the regular patent application, the amendment deleting the matter stated in the originally attached description etc. does not often correspond to the addition of new matters. Similarly even where a part of the foreign language documents was not translated, no new matters beyond the original text are often present. However, depending on the content of the part which is not translated, the examiner will notice that the new matters beyond the original text may be present.

Example 1: An example in which no new matters beyond the original text are present

A case in which while a generic concept A is stated in a claim of the foreign language documents and more specific concepts a1, a2, a3 and a4 are stated as its working example, a part of a4 is not translated

(Explanation)

In this case, since the matter not stated in the foreign language documents is not stated in the description, etc., no new matters beyond the original text are present.

Example 2: An example in which new matters beyond the original text are present

In the case where the matter of "rubber treated to be heat-resistant" is stated in the foreign language documents and the matter cannot be understood to mean a generic "rubber" even though the description of the description, etc. is reviewed, the matter is translated simply as "rubber".

(Explanation)

In this case, the new matters beyond the original text are present, since only the rubber treated to be heat-resistant is stated in the foreign language documents, and the generic rubber is stated in the description, etc., even though it is not perceived that the generic rubber is within the range of the matter stated in the foreign language documents.

2.2 Procedures of Examination of the determination of the new matters beyond the original text

(1) The examiner treats the description, etc. as the subject of the substantive examination, on the premise that the foreign language documents are normally identical to the contents of the description, the claims and the drawings. The examiner compares the foreign language documents and the description, etc., only where any doubts for the identity between the foreign language documents and the description, etc. are raised (see 2.3). As the results, the reason for refusal will be notified where the examiner becomes provisionally convinced that the new matters beyond the original text are present according to the 2.1 .

(Explanation)

Where the new matters beyond the original text are present in the description, etc. of the foreign language written application, such an application will have the reason for refusal. However, it is not necessary for the examiner to compare the foreign language documents and the description, etc. for all cases, in light of the following (i), (ii) and the like. Accordingly, the procedure shall be treated, as described above.

- (i) It is highly probable that the contents of the foreign language documents coincide with the contents of the description, etc.
- (ii) The inconsistency between the contents of the foreign language documents and the

contents of the description, etc. can be found by solely examining the description, etc. in light of the conformity among descriptions, common general knowledge, etc. by the examiner.

(2) Upon notifying the notice of reasons for refusal, the decision of refusal, etc., the examiner points out all matters corresponding to the new matters beyond the original text found as mentioned in the above item (1) and specifically explains the reason thought as such.

(3) The applicant can amend the description, etc. by submitting the written amendment or the statement of correction of the incorrect translation and can argue or clarify by the written opinion etc., against the notice of reasons for refusal that the new matters beyond the original text are present.

Where the examiner can achieve a state of the conviction that the new matters beyond the original text are not present in the description, etc. by the amendment, the argument or the clarification, the reason for refusal can be overcome. The examiner will make the decision of refusal based on the reason for refusal that the new matters beyond the original text are present where the conviction has not been changed.

(4) Where the description of the description, etc. is unnatural or unreasonable, a suspicion that the new matters beyond the original text in the description, etc. are present is raised (see 2.3(1)). However, where the notice of reasons for refusal is notified based on the non-compliance with Article 36 because of the description of the description, etc. being unnatural or unreasonable to an extent not complying with the description requirement prescribed in Article 36, the examiner may notify the reason for refusal without comparing the foreign language documents, regardless of raising the suspicion for the presence of the new matters beyond the original text.

The examiner points to note that unnatural or unreasonable portion in a part of the description, the claims and the drawings does not necessarily lead to not complying with the requirement of Article 36.

2.3 Typical Examples in which comparison with the foreign language documents is necessary

(1) Where unnatural or unreasonable descriptions in the description, etc. raise a suspicion that the description, etc. may contain new matters beyond the original text

Among typical examples of mistranslation are oversight of expressions to be translated (Example 1) and errors in interpretation of words, context or grammar (Examples 2 and Example 3). Such mistranslation brings in the description, etc. which do not make sense as a whole, or which are contrary to the common general knowledge.

Therefore, where such a portion is present in the description, etc., there is a suspicion that the mistranslation in the description, etc. is raised and the new matters beyond the original text are present.

Example 1:

A case in which while the foreign language documents describe "The battery is discharged" and it should be translated as such, it has been mistranslated into "The battery is charged" upon oversight of the wording of "dis".

(Explanation)

If it is described as the battery being charged while the battery is originally discharged, the current flow is inverse. So, the meaning of this sentence usually does not make sense. In such a case, there is a reason to suspect the existence of the new matters beyond the original text resulting from the mistranslation.

Example 2:

A term "beam" in the foreign language document is mistranslated into "hari (girder)" despite that it should have been translated into "kosen (ray)".

(Explanation)

It is very unnatural to find the term "hari (girder)" being used in a completely different technical field where the correct translation "kosen (ray)" is usually used. Therefore, there is a reason to suspect the existence of new matters beyond the original text resulting from the mistranslation.

Example 3:

The foreign language documents include a statement, "first opening is drilled through the substrate at 20% of the desired diameter for the hole, and another opening is then drilled at 30% of the full diameter." A person skilled in the art would be able to recognize that the "first opening" and "another opening" are drilled with the same center in succession in order to form a single hole of accurate size, in view of the context of the descriptions in the foreign language documents and the disclosed technological details. Accordingly, the above sentence should be translated as "first opening is drilled through the substrate at 20% of the

desired diameter for the hole, and in succession, the opening is additionally drilled up to 30% of the full diameter" (in Japanese). However, a translator misunderstood that the 20%-diameter hole and the 30%-diameter hole were to be separately formed at different positions, and mistranslated the sentence as "first opening at 20% of the desired diameter is drilled through the substrate, and a different opening at 30% of the desired diameter is drilled" (in Japanese).

(Explanation)

It is unnatural and unreasonable that the translation states that two different holes are formed in the context where only one hole is to be formed. Therefore, there is a reason to suspect the existence of the new matters beyond the original text resulting from the mistranslation.

- (2) Where there is a suspicion that the new matters beyond the original text may exist in the corrected description, etc. because it is not objectively clear that the aim of the correction is to correct the mistranslation even by referring to the reason for correction of the written correction of mistranslation.

When an applicant submits a written correction of mistranslation, (s)he must state the details of the correction and a reason for correction etc. so as to objectively make clear that the correction aims at correcting a mistranslation.

On the contrary, where it cannot be said to be clear that the aim of correction is to correct a mistranslation (Examples 4 and Example 5), there is a suspicion that the new matters beyond the original text may exist in the description, etc. corrected by the written correction of mistranslation.

See 4. , as to the handling of the written correction of mistranslation.

Example 4:

Where there is no objective explanation about the reasons why the translation before the correction is improper and why the translation after the correction is proper, although it is insisted that by the applicant that there are some mistranslations in words

(For example, where an objective documentary evidence such as a copy of a dictionary is not attached to the written correction despite that it is necessary as a material for explanation of the reasons)

Example 5:

Although it is insisted by the applicant that the incorrect translation is due to

misinterpretation of the common general knowledge or the context, there is no sufficient explanation or there is a doubt about explanation with respect to the common general knowledge or the comprehension of the context.

- (3) A case where there is an offer of information to the effect that the new matters beyond the original text exist in the description, etc., and the result of the examination provides a suspicion that the new matters beyond the original text may exist in the description, etc.

Where the information concerning the new matters beyond the original text may be gathered through the following (i) or (ii), there is a suspicion that the new matters beyond the original text may exist in the description, etc.:

- (i) Information is offered under Article 13bis of Regulations under the Patent Act (Example 6); and
- (ii) By the submission of a written opinion etc. by an applicant to whom the foreign language written application is cited as a prior application of Article 29bis or Article 39 (Example 7), it is found that the foreign language written application contains a new matter beyond the original text.

Example 6:

Where the examiner is informed by a third party that matters beyond the foreign language documents are added in the description, etc. and where such information is deemed reasonable.

Example 7:

When a foreign language written application is cited as a ground of the reason for refusal of another application (Article 29bis or Article 39), and where the applicant of the latter makes an assertion that the translation of the foreign language document of the cited application contains the new matters beyond the original text, and the argument is reasonable.

(for example, where the examiner has issued a notice of reasons for refusal under Article 29bis after referring only to the translation of the cited application, and the applicant makes an objection to the notice by asserting that the foreign language documents do not disclose such an invention).

3. New Matter beyond Translation

Concerning the foreign language written application, an amendment adding matters (except the amendment by the written correction of mistranslation) not stated in the translation (where the written correction of mistranslation is submitted, the corrected description, etc. are included) cannot be recognized (Article 17bis(3)). Such an amendment is referred to as "amendment adding new matter beyond translation".

The reason why such provision is provided is that it is perceived that the contents of the foreign language documents in the foreign language written application and its translation are normally identical each other and to be enough to determine whether the amendment is of adding the new matter based on the translation, not the foreign language documents, in the examination.

Where the mistranslation is in the translation, it is usual to submit an amendment beyond the matters stated in the translation, at the same time, to overcome the mistranslation. Accordingly, in the case of correcting the mistranslation, it is necessary that the matter stated in the foreign language documents can be added beyond the matters stated in the translation by such an amendment, and the provision under the same paragraph shall not be applied for the amendment by the written correction of mistranslation.

3.1 Determination as to whether an amendment is an amendment adding a new matter beyond translation

The examiner determines whether the amendment is an amendment adding the new matter beyond translation, by determining whether the amendment (except the amendment by the written correction of mistranslation) is made within the matter stated in the translation (including the corrected description, etc. where the written correction of mistranslation was submitted). The determination as to whether the amendment is made within the matter stated in the translation (including the corrected description, etc. where the written correction of mistranslation was submitted) is the same as the determination as to whether the amendment is made within the matter stated in the originally attached description etc. in the "Part IV Chapter 2 Amendment Adding New Matter".

3.2 Procedures of Examination concerning Determination on New Matter beyond

Translation

The examiner proceeds with the examination according to the 4. in "Part IV Chapter 2 Amendment Adding New Matter".

4. Amendment by Written Correction of Mistranslation

The applicant of the foreign language written application shall submit a written correction of mistranslation stating a reason for correction of mistranslation, not a written amendment, where (s)he is to amend the description, etc. as a purpose of correcting the mistranslation (Article 17bis(2)).

This procedure aims at lightening the burden of monitoring by the third party and the workload of examination with regard to the foreign language document by clarifying the fact the statement in the translation was amended based on the statements in the foreign language written document.

4.1 Examination where the amendment by the written correction of mistranslation is made

Where the amendment by the written correction of mistranslation is made, the examiner confirms the reason for correction, etc. stated in the written correction of mistranslation and examines as the same where the amendment by the written amendment is made. Since the provision for the new matter beyond translation shall not be applied for the amendment by the written correction of mistranslation, the examiner does not determine the new matter beyond translation. In addition, see 2. for the determination of the new matter as to the original text.

In addition, even where an amendment not aiming to correct the mistranslation is contained in the amendment by the written correction of mistranslation, this is not a reason for refusal. Therefore, the examiner does not determine whether the amendment by the written correction of mistranslation is to correct the mistranslation or is of another purpose.

The amendment as the purpose of the correction of mistranslation shall be made by the written correction of mistranslation (Article 17bis(2)). Therefore, what the amendment aiming to correct the mistranslation is made by the written amendment is not usually allowed. Even where the amendment aiming to correct the

mistranslation is made by the written amendment, and if such an amendment is not to add the new matter beyond translation as the result, it is allowed that such an amendment is made by the written amendment.

4.1.1 Action against Insufficient Description of "Reasons for Correction, etc."

(1) If the examiner is not convinced that no new matter as to the original text exists in the description, etc. as amended by the correction of mistranslation, due to insufficient description of the reasons for correction and insufficiency of the materials necessary for explanation of reasons for correction, the examiner may ask the applicant for an explanation by sending a notice according to Article 194(1) (Submission of documents, etc.) or by making a telephone call, etc.

(2) If the examiner is not convinced in spite of the action (1) above, this is the case where the examiner should suspect that new matter as to the original text exists (see 2.3(2)). Therefore, the examiner should compare with the foreign language document and determine as to whether the new matter as to the original text exists.

4.1.2 Treatment of a case in which an amended matter contained in the written correction of mistranslation as being an amended matter capable of being treated as the amendment by the written amendment was actually the new matter beyond translation (an amended matter not capable of being treated as the amendment by the written amendment)

(1) Even where the amended matter contained in the written correction of mistranslation as being an amended matter capable of being treated as the amendment by the written amendment (an amended matter for which the reason for correction is not stated in the written correction of mistranslation) was actually the new matter beyond translation (an amended matter not capable of being treated as the amendment by the written amendment), the examiner cannot notify the notice of reasons for refusal, decide the refusal or decide the dismissal of amendment based on the reason. This is because the provision of the new matter beyond translation cannot be applied for the amendment by the written correction of mistranslation.

Since such an amendment is made as the amended matter capable of being treated as the amendment by the written amendment, such a written correction of mistranslation will be insufficient in the reason for correction for the amended matter.

Therefore, the examiner may ask the applicant for an explanation by sending a notice according to Article 194(1) (Submission of descriptions, etc.) or by making a telephone call, etc.

(2) If the examiner is not convinced that the new matter as to the original text in the description after correcting mistranslation etc. does not exist in spite of the action (1) above, this is the case where the examiner should suspect that new matter as to the original text exists (see 2.3(2)). Therefore, the examiner should compare with the foreign language document and determine as to whether the new matter as to the original text exists.

4.1.3 Treatment of a case where a written correction of mistranslation containing an amended matter capable of being treated as the amendment by the written amendment was submitted within the designated period for responding to the final notice of reasons for refusal, etc.

It can be accepted to make amendment with containing an amended matter capable of being treated as the amendment by the written amendment in the written correction of mistranslation. However, where the amendment by the written correction of mistranslation submitted within the designated period for responding to the final notice of reasons for refusal, etc. (Note 1) does not comply with the requirements of Article 17bis(4) to (6) (Note 2), the examiner shall decide the dismissal of amendment. Where there is an amended matter not complying with the requirements of Article 17bis(4) to (6) in the written correction of mistranslation, as similar to the case where one amended matter does not comply with the requirements of the amendment, the whole written amendment containing such an amendment is dismissed in the regular patent application, the examiner notices in that the whole written correction of mistranslation is dismissed, including the amended matter capable of being treated as the amendment by the written amendment (an amended matter not corresponding to the new matter beyond translation).

(Note 1) "etc." means to include the notice of reasons for refusal with the notice under the provision of Article 50bis. The same can be applied for the following matters in this chapter.

(Note 2) The examiner notices that the provision of Article 17bis(3) (new matter beyond translation) shall not be applied for the amendment by the written correction of mistranslation.

4.1.4 Treatment of a case where a written amendment adding a new matter beyond translation is submitted, followed by a written correction of mistranslation maintaining (Note) the new matter beyond translation being submitted

(Note) "maintaining" herein refers to, for example, the following (i) and (ii).

- (i) a described portion containing a new matter beyond translation added as the amendment by the former written amendment is remained as the portion corresponding to the new matter beyond translation to be included in a unit of amendment in the "[Unit to be Corrected]" in the written correction of mistranslation.
- (ii) a described portion containing a new matter beyond translation added as the amendment by the former written amendment is not included in a unit of amendment in the "[Unit to be Corrected]" in the written correction of mistranslation.

(1) Where it is objectively clear from the description of the written correction of mistranslation that a matter corresponding to the new matter beyond translation is maintained in the description, etc. by the written correction of mistranslation (Example 1), the reason for refusal for the new matter beyond translation shall be deemed to be overcome by submitting such a written correction of mistranslation. Even though the description of the written correction of mistranslation is not necessarily sufficient, the reason for refusal can be overcome if it is clear from the statements of the written correction of mistranslation that the matter corresponding to the new matter beyond translation is maintained in the description, etc. by the written correction of mistranslation.

Example 1:

Where the described portion including the new matter beyond translation which was added by the amendment through the former written amendment is included in the unit of amendment indicated in "[Unit to be Corrected]" of the written correction of mistranslation, and where the written correction of mistranslation sufficiently showing the reason for correction was submitted

(2) On the other hand, where it is not objectively clear from the description of the written correction of mistranslation that the matter corresponding to the new matter beyond translation is maintained in the description, etc. by the written correction of mistranslation (Example 2), the reason for refusal for the new matter beyond translation shall be deemed not to be overcome by submitting such a written correction of

mistranslation.

In such case, the examiner may notify the notice of reasons for refusal for the new matter beyond translation, and where such a reason for refusal is notified on ahead, the examiner may decide the refusal based on the reason. However, the examiner cannot dismiss the written correction of mistranslation based on the reason.

Example 2:

Where the described portion including the new matter beyond translation which was added by the amendment through the former written amendment is not included in the unit of amendment indicated in "[Unit to be Corrected]" of the written correction of mistranslation, and where the reason for correction is not also stated.

(Explanation)

Where the addition of the new matter beyond translation is originated from the amendment through the written amendment and such an addition is not deemed as the addition of the new matter beyond translation if such an amendment is made by the written correction of mistranslation, such an addition of the new matter beyond translation is a formal defect which is merely error in the selection of the document to be proceeded. Therefore, where after the written amendment adding the new matter beyond translation was submitted, the written correction of mistranslation clarifying that the matter corresponding to the new matter beyond translation is present in the foreign language documents was submitted, it is proper to deem that the reason for refusal for the new matter beyond translation was overcome.

5. Procedures of Examination on Foreign Language Written Application

- (1) The examiner proceeds with the examination according to the "Part I Outline of Examination" on the examination of the foreign language written application. On this case, the examiner shall replace the "new matter" into the "new matter beyond translation". However, the examiner notices that the provision of the new matter beyond translation (Article 17bis(3)) shall not be applied for the amendment by the written correction of mistranslation.
- (2) Where the new matter as to the original text was added by the amendment responding to the final notice of reasons for refusal, etc. (including the amendment by

the written correction of mistranslation), such an amendment shall not be dismissed based on a reason of adding the new matter as to the original text (Note). Accordingly, the examiner will notify a reason for refusal, again. Where the reason for refusal in the final notice of reasons for refusal, etc. is not overcome, the examiner may decide the refusal based on the reason for refusal which was not overcome, without notifying the reason for refusal that the new matter as to the original text is present. In this case, the examiner shall indicate in the decision of refusal that the new matter as to the original text is present.

(Note) The addition of the new matter as to the original text is not a requirement for amendment.

Accordingly, even if the amendment is to add the new matter as to the original text, the amendment is not dismissed based on a reason that the new matter as to the original text is added.

6. Guideline of Submitting the Written Correction of Mistranslation

The procedure of the amendment of the description, etc. by the written correction of mistranslation is a procedure which is provided for clarification to the third party and the examiner that the content of the correction for mistranslation is a proper amendment within the range of the matter stated in the foreign language documents by clearly indicating the content of the mistranslation and the reason for the correction, etc., differing from the procedure of the amendment by the written amendment.

Therefore, the written correction of mistranslation should be according to a form prescribed in Regulations under the Patent Act, and the submission of the written correction of mistranslation should be made as follows.

6.1 Material necessary for the explanation of the reason for correction

(1) Where a material is necessary for a person skilled in the art to easily understand that the content of the correction for mistranslation and its reason are reasonable, the applicant shall attach the "material necessary for the explanation of the reason for correction".

(2) The case where it is necessary to indicate that the content of the correction for

mistranslation and its reason are reasonable using the material means a case where materials including a dictionary are necessary for indicating that the content of the correction for mistranslation is reasonable, such as a case where the mistranslation of technical terms is corrected. In this case, the applicant shall attach a copy of corresponding page(s) of the dictionary and the like as a material necessary for the explanation of the reason for correction.

(3) Where the material necessary for the explanation of the reason for correction is identical to another amended portion, the applicant shall state such a statement in the column of "[Reasons for Correction, etc.]" and may abbreviate to attach the material.

6.2 Examples of the written correction of mistranslation

The example of the written correction of mistranslation is referred to the following "Written Correction of Mistranslation (Sample)".

6.3 Concerning that the amended matter capable of being treated as the amendment by the written amendment is included in the written correction of mistranslation

(1) While the written correction of mistranslation is originally a document submitted when an amendment for correcting the mistranslation is made, a case where an amendment for which the correction of mistranslation is not aimed is concurrently necessary can be raised on the practice. In this case, where the amended matter capable of being treated as the amendment by the written amendment is amended in addition to the correction of mistranslation, it is desirable for the applicant that such an amendment is included in the written correction of mistranslation to proceed with one procedure for amendment without submitting another written amendment.

On the contrary, the amendment on the purpose of correcting the mistranslation cannot be included in the written amendment without submitting the written correction of mistranslation.

(Explanation)

Even if the amended matter capable of being treated as the amendment by the written amendment is included in the written correction of mistranslation, it is possible to notify the third party or the examiner of the content of mistranslation and the reason for correction concerning the corrected portion of mistranslation.

In addition, even though both amendment matter corresponding to the amendment by the written amendment and other amendment matter corresponding to the correction of mistranslation are mixed with each other in the written correction of mistranslation, appropriateness of amendments is determined for each matter to be amended and, therefore, such mixing of conditions is not regarded as troublesome in the examination practices.

On the other hand, by handling the matter as described in (1), one can avoid such duplicated procedures submitting both a written amendment and a written correction of mistranslation, thereby simplifying a response by the applicant, etc.

To the contrary, it is impermissible to make a correction of mistranslation by means of the amendment by the written amendment. The purpose of the written correction of mistranslation is to clarify the content of mistranslation and the reasons for correction to third parties or the examiner when there are mistranslations. Therefore, it is not proper to make an amendment through the written amendment, if it should be amended by the written correction of mistranslation. Moreover, where the amendment which should be amended by the written correction of mistranslation is made by the amendment by the written amendment, one should be careful that such an amendment would in many cases correspond to the addition of new matter beyond translation and, therefore, constitute the reason for refusal or the reason for dismissing the amendment.

(2) Where amendment matters which can be amended by the amendment by the written amendment (matters to be amended within the scope of the matters lawfully stated in the description, etc. before amendment) are stated in the written correction of mistranslation, it is unnecessary for the applicant to state the reasons for correction, etc. in the column of "[Reasons for Correction, etc.]".

However, in this case, the applicant shall explain in the column of "[Reasons for Correction, etc.]", by indicating the corresponding portions of the description, etc. before amendment where the matters to be amended are stated, etc., that the amendment is an amendment within the scope of the matters stated in the description, etc.

6.4 Points to note when the written amendment and the written correction of mistranslation both dated the same date are submitted separately

Where the written amendment and the written correction of mistranslation are separately submitted in response to a certain notice of reasons for refusal, the applicant shall pay attention so as to prevent substantial duplications in amendment units (amendment units stated in "[Unit to be Amended]" in the written amendment and those

Part VII Chapter 2 Examination of Foreign Language Written Application

stated in "[Unit to be Corrected]" in the written correction of mistranslation).

Written Correction of Mistranslation (Sample)

[Document name]	Written Correction of Mistranslation
[Submission date]	September 1, 1995
[Address]	To: The Commissioner of the Japan Patent Office
[Indication of the Case]	
[Application Number]	Heisei 7 (1995) Patent Application No. 100321
[Applicant]	
[Identification Number]	090004324
[Name]	Tokkyo Kabusiki Kaisha
[Administrator]	
[Identification Number]	190001231
[Patent Attorney]	
[Name]	Tokkyo Taro
[Correction of Mistranslation 1]	
[Title of Document to be Corrected]	Description
[Unit to be Corrected]	0003
[Method of Correction]	Change
[Content of Correction]	
	[0003] An apparatus for charging a cannon, which speedily charges a barrel with powder (hohshin ni kayaku wo sohtensuru) by lightening the weight (keiryoka) of the charging apparatus and by making the rotational response of the charging apparatus capable of following the elevation of the barrel.
[Reasons for Correction, etc.]	
(Reason for Correction 1-1)	<p>Concerning the phrase "hohshin ni kayaku wo sohtensuru (charges a barrel with powder)" in Paragraph [0003]</p> <p>The phrase of the foreign language document which corresponds to the above-mentioned phrase in the translation is "charge a barrel with powder" in line 3 on page 2 of the foreign language document, and such phrase was translated as "taru ni kona wo sohtensuru (charge a cask with flour)" before the correction of mistranslation. The translation before the correction of mistranslation is a general translation of the above-mentioned English phrase. However, this application relates to the apparatus for charging a cannon, and the word "barrel" means "hohshin (gun barrel)" rather than "taru (barrel/cask)" and the word "powder" means "kayaku (powder/gunpowder)" rather than "kona (powder/flour)". Accordingly, taking into consideration the technical meaning of this application, the mistranslations are hereby corrected to translate the above-mentioned phrase as "hohshin ni kayaku wo sohtensuru."</p> <p>(Material necessary for the explanation of the reason for correction 1-1: see "SHOGAKUKAN RANDOM HOUSE ENGLISH-JAPANESE DICTIONARY, pages 213 and 2020, published on January 20, 1988")</p>
(Reason for correction 1-2)	<p>Concerning the word "keiryo (lightening the weight)" in Paragraph [0003]</p> <p>It was translated as "keiryo (measuring)" before the correction of mistranslation. As it is apparent from other descriptions in the description (such as "to lighten the weight" in Paragraph [0002]) that such word "keiryo (measuring)" is an error of "keiryo (lightening the weight)." Therefore, it is a matter to be amended which can also be</p>

handled by an amendment by written amendment.

[Indication of Fee]

[Advance Payment Book Number] 012345

[Amount Paid] ¥19000

[List of Documents Filed]

[Title] Material necessary for the explanation of the reason for
correction: 1

[Material necessary for the explanation of the reason for correction 1-1]

barrel [bærəl] *n., v.* (-reled, -reling) — *n.* 1 (胴のふくれた)たる, ピヤだる. 2 バレル: 1 たるの量; 米国で液体は 31 $\frac{1}{2}$ ガロン, 果実や野菜は 105 乾量クート, 英国では 36 英ガロン. 3 (話)多量, たくさん, どっさり (large quantity): — *a barrel of monkeys* たくさんの中. — *have a barrel of fun* とてもおもしろく過ごす. 4 たるに似た形の容器(ケース), 円筒[形のものの胴部]. 5 【兵器類】砲身, 銃身: — *the dismantled barrel of the machine pistol* 自動ピストルの分解した銃身. 6 【機械】ポンプの筒. 7 シャフトの上で動く円筒. 8 【時計】香箱(?) : 時計のゼンマイを入れる歯車つきの箱. 9 【鳥類】(廃) 羽柄(calamus, quill). 10 (牛・馬などの)胴体(trunk). 11 【海事】車地(capstan)の胴部. — *capstan* (図). 12 バレル: 回転しながら製品をめっきまたは研磨する水平のシリンダー. 13 (一般に)筒形構造の丸天井, かまぼこ屋根, 半円筒ボルト.
over a barrel 〔俗〕窮地に陥って, お手上げ (in an embarrassing or uncomfortable position); 身動きできない, にっちもさっちもいかない (unable to act): — *They really had us over a barrel when they foreclosed the mortgage.* 抵当を流されたときは, 全く困り果ててしまった.
— *v.t.* 1 たるに入れる, たるに詰める. 2 (金属部品を) バレルで仕上げる, バレル研磨(めっき)する.
— *v.i.* 〔俗〕高速度で進む(運転する), 疾走する (travel or drive very fast): — *barrel along the speedway* 高速道路をぶとばす.
[ME barell < OF baril, ? = *barre* stave (→ BARREL) + -il < L -ile, neut. of -ilis -ILE]

powder [paʊdər] *n.* 1 粉, 粉末: — *be reduced to powder* 粉末になる, 粉々になる. — *grind ... into (or to) powder* …をひいて粉にする. 2 粉末剤; 火薬, 爆薬(gunpowder), 粉おしろい(face powder), 歯みがき粉(tooth powder)など: — *black powder* 黒色火薬. — *smokeless powder* 無煙火薬. — *food for powder* 弾丸のえじき. — *powder and shot* 弾薬, 軍需品. — *the smell of powder* 硝煙のにおい, 實戦の経験. — *smell powder* 實戦の経験をする. — *digestive powder* 粉末消化剤. — *curry powder* カレー粉. — *a lady in powder and paint* おしろいをしてつけぼくろをした婦人. — *with powder and paint* 厚化粧をして. 3 (また **powder snow**) 〔スキー〕粉雪: 通例ざらめ雪でない, さらさらした新雪.
keep one's powder dry 〔俗〕万一に備える, 用意を怠らない: — *Put your trust in God, and keep your powder dry.* 神を信頼し, 万一に備えなさい.
not worth powder and shot 骨折りがいがない.
— *v.t.* 1 粉にする, 製粉する, 粉末にする, 粉状にする (reduce to powder, pulverize): — *be powdered to dust* 粉末にされる, 粉々になる.
2 粉をふりかける, 粉でおおう (sprinkle or cover with powder): — *She powdered the cookies with confectioners' sugar.* クッキーに精製糖をまぶした. — *Her face was powdered with flour.* 彼女の顔は小麦粉にまみれていた.

Origin: "SHOGAKUKAN RANDOM HOUSE ENGLISH-JAPANESE DICTIONARY," SHOGAKUKAN Inc., pages 213 and 2020, published on January 20, 1988

<Relevant Provisions>

Patent Act

(Amendment of proceedings)

Article 17(1)

(Omitted)

(2) Notwithstanding the main clause of the preceding paragraph, an applicant of a foreign language written application as provided in Article 36bis(2) may not amend foreign language documents and as provided in Article 36bis(1).

(3) to (4) (omitted)

(Amendment of Description, Claim or Drawing attached to the application)

Article 17bis(1)

An applicant for a patent may amend the description, scope of claims, or drawings attached to the application, before the service of the certified copy of the examiner's decision notifying that a patent is to be granted; provided, however, that following the receipt of a notice provided under Article 50, an amendment may only be made in the following cases:

- (i) where the applicant has received the first notice (hereinafter referred to in this Article as the "notice of reasons for refusal") under Article 50 (including the cases where it is applied mutatis mutandis pursuant to Article 159(2) (including the cases where it is applied mutatis mutandis pursuant to Article 174(2)) and Article 163(2), hereinafter the same shall apply in this paragraph) and said amendment is made within the designated time limit under Article 50;
- (ii) where, following the receipt of the notice of reasons for refusal, the applicant has received a notice under Article 48septies and said amendment is made within the designated time limit under said Article;
- (iii) where, following the receipt of the notice of reasons for refusal, the applicant has received a further notice of reasons for refusal and said amendment is made within the designated time limit under Article 50 with regard to the final notice of reasons for refusal; and
- (iv) where the applicant files a request for a trial against an examiner's decision of refusal and said amendment is made at the same time of filing said request for said trial.

(2) Where an applicant of a foreign language written application as provided in Article 36bis(2) amends the description, scope of claims or drawings under the

preceding paragraph for the purpose of correcting an incorrect translation, the applicant shall submit the statement of correction of the incorrect translation, stating the grounds thereof.

(3) Except in the case where said amendment is made through the submission of a statement of correction of an incorrect translation, any amendment of the description, scope of claims or drawings under paragraph (1) shall be made within the scope of the matters described in the description, scope of claims or drawings originally attached to the application(in the case of a foreign language written application under Article 36bis(2), the translation of the foreign language documents as provided in Article 36bis(2) that is deemed to be the description, scope of claims and drawings under Article 36bis(6) (in the case where the amendment to the description, scope of claims or drawings has been made through the submission of the statement of correction of an incorrect translation, said translation or the amended description, scope of claims or drawings), the same shall apply in Articles 34bis(1) and 34ter(1).).

(4) to (6) (Omitted)

Article 36bis(1)

A person requesting the grant of a patent may, in lieu of the description, scope of claims, drawings (where required) and abstract as provided in paragraph (2) of the preceding Article, attach to the application a document in foreign language as provided by Ordinance of the Ministry of Economy, Trade and Industry, stating matters required to be stated in the description or the scope of claims under paragraphs (3) to (6) of said Article, and drawing(s) (where required) which contain any descriptive text in said foreign language (hereinafter referred to as "foreign language documents"), and a document in said foreign language stating matters required to be stated in the abstract under paragraph (7) of said Article (hereinafter referred to as "foreign language abstract").

(2) The applicant for a patent application in which the document and abstract in foreign language are attached to the application under the preceding paragraph (hereinafter referred to as "foreign language written application") shall submit to the Commissioner of the Patent Office Japanese translations of the document and the abstract in foreign language within one year and four months from the date of filing of the patent application(or in the case of a patent application containing a priority claim under Article 41(1), the filing date of the earlier application provided for in the said paragraph, in the

case of a patent application containing a priority claim under Article 43(1), 43-2(1) or 43-2(2), the filing date of the earliest application, a patent application that is deemed to be the earliest application under Article 4.C(4) of the Paris Convention (refers to the Paris Convention for the Protection of Industrial Property of March 20, 1883, as revised at Brussels on December 14, 1900, at Washington on June 2, 1911, at Hague on November 6, 1925, at London on June 2, 1934, at Lisbon on October 31, 1958, and at Stockholm on July 14, 1967, the same shall apply hereinafter) or a patent application that is recognized as the earliest application under Article 4.A(2) of the Paris Convention, and in the case of a patent application containing two or more priority claims under Article 41(1), 43(1), 43-2(1) or 43-2(2), the earliest day of the filing dates on which the said priority claims are based, the same shall apply to the main clause of Article 36-2(2) and Article 64(1)); provided, however, that where the written application in foreign language is a new patent application arising from the division of a patent application under Article 44(1), or a patent application arising from the conversion of an application under Article 46(1) or (2), or a patent application based on a utility model registration under Article 46bis(1), the applicant may submit Japanese translations of the document and the abstract in foreign language even after the lapse of the time limit prescribed in the main clause, but not later than two months following the division of a patent application, conversion of application or filing of patent application based on a utility model registration.

(3) Where the translation of foreign-language-documents and the foreign-language abstract as provided in the preceding paragraph have not been submitted within the time limit prescribed in the main clause of the said paragraph (the time limit prescribed in the proviso to the said paragraph where the translation of foreign-language-documents and the foreign-language abstract may be submitted under the proviso to the said paragraph; hereinafter the same shall apply in this Article), the Commissioner of the Patent Office shall notify the applicant of the foreign-language-written-application thereof.

(4) A person who has received the notice as provided in the preceding paragraph may submit the translation of foreign-languagedocuments and the foreign-language abstract as provided in paragraph (2) to the Commissioner of the Patent Office only within the time limit as provided in Ordinance of the Ministry of Economy, Trade and Industry.

(5) Where the translation of foreign-language-documents (excluding drawings) as provided in paragraph (2) has not been submitted within the time limit as provided in paragraph (4), the patent application shall be deemed to have been withdrawn upon

expiration of the time limit prescribed in the main clause of the said paragraph.

(6) An applicant of a patent application that was deemed to have been withdrawn pursuant to the provision of the preceding paragraph, where there are justifiable reasons for having not been able to submit the said translation within the time limit under paragraph(4), may submit to the Commissioner of the Patent Office translations of the foreign-language-documents and the foreign-language-abstract under paragraph (2), only within the time limit as provided in Ordinance of the Ministry of Economy, Trade and Industry.

(7) The translation submitted under paragraph (4) or the preceding paragraph shall be deemed to have been submitted to the Commissioner of the Patent Office at the time of expiration of the time limit under the main clause of paragraph (2).

(8) The translation of foreign language documents as provided in paragraph (2) shall be deemed to be the description, scope of claims and drawings submitted with the application under paragraph (2) of the preceding Article and the translation of foreign language abstract as provided in paragraph (2) shall be deemed to be the abstract submitted with the application under paragraph (2) of the preceding Article.

(Examiner's decision of refusal)

Article 49

The examiner shall render an examiner's decision to the effect that a patent application is to be refused where the patent application falls under any of the following:

- (i) an amendment made to the description, scope of claims or drawings attached to the application of a patent application does not comply with the requirements as provided in Article 17bis(3) or (4);
- (ii) to (v) (Omitted)
- (vi) where the patent application is a foreign language written application, matters stated in the description, scope of claims or drawings attached to the application of said patent application do not remain within the scope of matters stated in foreign language documents; and
- (vii) (Omitted)

Regulations under the Patent Act

(Language of the foreign language written application)

Article 25quarter

The foreign language as provided by Ordinance of the Ministry of Economy, Trade and Industry under Article 36bis(1) of the Patent Act shall be English and other foreign language.

(Format, etc., of the Translation)

Article 25septies

(Omitted)

(2), (3) (Omitted)

(4) The period prescribed by the Ordinance of the Ministry of Economy, Trade and Industry under Article 36bis (4) of the Patent Act shall be two months from the day on which notification under Article 36bis (3) was notified.

(5) to (8) (Omitted)

Part VIII

International Patent Application

Note: When any ambiguity of interpretation is found in this provisional translation, the Japanese text shall prevail.

Part VIII International Patent Application

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Part VIII International Patent Application

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<Relevant Provisions>

Part VIII International Patent Application

The "international patent application" in this part means an international patent application under the Patent Cooperation Treaty which is transferred into a national phase (relating to a patent application). In addition, a "patent application in Japanese language" means an international patent application made by Japanese, and a "patent application in foreign language" means an international patent application made by a foreign language.

1. Overview

The international patent application under the Patent Cooperation Treaty (PCT) has an effect as a formal internal patent application from the international filing date in each designated country when the international filing date is recognized, and the international filing date is deemed as a filing date in each designated country (Article 11(3) of PCT).

Therefore, the international patent application containing Japan as the designated country requesting the grant of a patent in Japan for which the international filing date is recognized will have an effect as a regular national patent application (which means a patent application provided by Article 36 or 36bis hereinafter in this Part).

In order to prescribe the handling for the international patent application containing Japan as the designated country which has such an effect, the provisions of Article 184ter to 184vicies are provided.

2. Documents relating to the international patent application

2.1 The request on the international filing date

The request on the international filing date of the international patent application is deemed as the request which is submitted under the provision of Article 36(1) (Article 184sexies(1)).

2.2 Description, claims, drawings and abstract on the international filing date

2.2.1 In case of the patent application in Japanese language

The description, the claims, the drawings on the international filing date (hereinafter, referred to as "description, etc. on the international filing date" in this part) and the abstract thereon are deemed to be the description, the claims, the drawings which are attached to the request to submit under the provision of Article 36(2) (hereinafter, referred to as "description, etc." in this part) and the abstract, respectively (Article 184sexies(2)).

2.2.2 In case of the patent application in foreign language

See 2.4 (2).

2.3 Document prescribed in Article 184quinquies(1)

(1) Regardless of the patent application in Japanese language and the patent application in foreign language, the application of the international patent application shall submit a document stating matters of an applicant, an inventor, an international patent application number and the like (hereinafter, in this Part, referred to as a "national document") within the time limit for the submission of national documents (Note) (Article 184quinquies(1)).

(Note) The time limit for the submission of national documents herein means a period of 2 year and 6 months from the priority date prescribed in Article 2(xi) of PCT (Article 184quater(1)).

(2) Where the national document is not submitted or where the procedures under Article 184quinquies(1) are violated, an order of amendment or a dismissal of the patent application will be subjected (Article 184quinquies(2)(i) to (iii) and (3)).

2.4 Translations

(1) An applicant of a patent application in foreign language shall submit Japanese translations of the description, claims, drawings (limited to the descriptive text in such drawings) (Note1), and the abstract as of the international application date within the Time Limit for the Submission of National Documents (Article 184quater(1)). However, the applicant of a patent application in foreign language who has submitted

the national documents during the period from two months before the expiration of the Time Limit for the Submission of National Documents to the expiry date thereof may submit said translations within two months from the date of submission of said national documents (the proviso to Article 184quater(1)). (Hereinafter, in this Part, time provided in the main clause and proviso of Article 184quater(1) is in general referred to as the "time limit for the submission of translations.")

Relating to a patent application in foreign language, in the case where the translation has not been submitted, see 3. .

(Note1) An applicant of a foreign language written application shall submit Japanese translation of the drawings, not limited to the description text in such drawings (Article 36bis(1) and (2)).

(2) The translations of the description, claims, and drawings (excluding the descriptive text in such drawings), and the translation of the descriptive text in such drawings of a patent application in foreign language as of the international application date shall be deemed to be the description etc. submitted with the application (Note2), and the translation of the abstract of a patent application in foreign language shall be deemed to be the abstract submitted with the application (Article 184sexies(2)).

(Note2) If the translation of a written amendment under PCT Article 19 has been submitted, said translation shall be deemed to be the claims submitted with the application under Article 36(2) (see 2.5.2).

2.5 Written amendment under PCT Article 19

2.5.1 Patent application in Japanese language

(1) If an applicant of a patent application in Japanese language has made an amendment under PCT Article 19(1) (hereinafter, in this Part, referred to as "amendment under Article 19"), such applicant shall submit a copy of the written amendment by the amendment under Article 19 on or before the date on which the National Processing Standard Time (Note) falls (Article 184septies(1)).

(Note) The National Processing Standard Time of a patent application in Japanese language means the earlier time of the following (i) and (ii) (Article 184quater(6)).

(i) the date on which the Time Limit for the Submission of National Documents expires

(ii) the time of requesting where the applicant requests the examination of the application within the Time Limit for the Submission of National Documents

(2) (i) If a copy of a written amendment by an amendment under Article 19 has been submitted, an amendment to the claims attached to the application shall be deemed to have been made under Article 17bis(1) by said copy of the written amendment, or (ii) if a written amendment has been served by the International Bureau under PCT Article 20 on or before the date on which the National Processing Standard Time falls, an amendment to the claims attached to the application shall be deemed to have been made under Article 17bis(1) by said written amendment (Article 184septies(2)).

(3) If (i) a copy of a written amendment by an amendment under Article 19 has not been submitted, and (ii) the written amendment of (2)(ii) above has not been served on or before the date on which the National Processing Standard Time falls, no amendment under Article 19 shall be deemed to have been made (Article 184septies(3)).

2.5.2 Patent application in foreign language

(1) If an applicant of a patent application in foreign language has made an amendment under Article 19, the applicant may, in lieu of the translation of the claims as of the international application date, submit a translation of the claims after the amendment under Article 19 (Article 184quater(2)).

Even if the applicant of the patent application in foreign language has submitted the translation of the claims as of the international application date, the applicant may submit a translation of the claims after the amendment under Article 19 on or before the date on which the National Processing Standard Time (Note) falls (Article 184quater(6)).

(Note) The National Processing Standard Time of a patent application in foreign language means the earlier time of the following (i) and (ii) (Article 184quater(3) and (6)).

- (i) the date on which the time limit for the submission of translations (see 2.4(1)) expires
- (ii) the time of requesting where the applicant requests the examination of the application within the time limit for the submission of translations

(2) If a translation of the claims after an amendment under Article 19 has been submitted, said translation of the claims after an amendment under Article 19 shall be

deemed to be the claims submitted with the application under Article 36(2) (Article 184sexies(3)).

(3) If the procedure of (1) above has not been taken, no amendment under Article 19 shall be deemed to have been made (Article 184quater(7)).

2.6 Written amendment under PCT Article 34

2.6.1 Patent application in Japanese language

(1) If an applicant of a patent application in Japanese language has made an amendment under PCT Article 34(2)(b) (hereinafter, in this Part, referred to as "amendment under Article 34"), such applicant shall submit a copy of the written amendment by the amendment under Article 34 on or before the date on which the National Processing Standard Time falls (Article 184octies(1)).

(2) (i) If a copy of a written amendment by an amendment under Article 34 has been submitted, an amendment to the description, etc. shall be deemed to have been made under Article 17bis(1) by said copy of the written amendment, or (ii) if a written amendment has been served by the International Bureau under PCT Article 36(3)(a) on or before the date which the National Processing Standard Time falls into, an amendment to the description, etc. shall be deemed to have been made under Article 17bis(1) by said written amendment (Article 184octies(2)).

(3) If (i) a copy of a written amendment by an amendment under Article 34 has not been submitted, and (ii) the written amendment of (2)(ii) above has not been served on or before the date on which the National Processing Standard Time falls into, no amendment under Article 34 shall be deemed to have been made (Article 184octies(3)).

2.6.2 Patent application in foreign language

(1) If an applicant of a patent application in foreign language has made an amendment under Article 34, the applicant shall submit a translation of the written amendment by the amendment under Article 34 on or before the date on which the National Processing Standard Time falls. (Article 184octies(1)).

(2) If a translation of the written amendment by the amendment under Article 34 has been submitted, an amendment to the description, etc. shall be deemed to have been made under Article 17bis(1) by the translation of the written amendment (Article 184octies(2)).

In this case, said amendment shall be deemed to have been made by submitting the statement of correction of the incorrect translation (Article 184octies(4)).

(3) If a translation of the written amendment by the amendment under Article 34 has not been submitted on or before the date which the National Processing Standard Time falls into, no amendment under Article 34 shall be deemed to have been made (Article 184octies(3)).

2.7 Statement of correction of an incorrect translation

(1) If an applicant of a patent application in foreign language amends the description, etc. for the purpose of correcting an incorrect translation, the applicant shall submit not the written amendment but the statement of correction of the incorrect translation, stating the grounds thereof (Article 17bis(2) replaced with Article 184duodecies(2)).

(2) If an applicant of a patent application in foreign language amends the description, etc. for the purpose of correcting an incorrect translation and the description, etc. excluding said purpose (hereinafter, in this Part, referred to as "regular amendment"), matters of amendment corresponding to said regular amendment may be included in the statement of correction of the incorrect translation.

3. Treatment in the case where a Translation relating to Patent Application in Foreign Language has not been submitted

3.1 In the case where translations of the description and claims have not been submitted

In a case where translations of the description and claims have not been submitted within the time limit for the submission of translations (see 2.4(1)), the patent application in foreign language shall be deemed to have been withdrawn (Article 184quater(3)).

3.2 In a case where a translation of the descriptive text in drawings has not been submitted

In a case where a translation of the descriptive text in drawings has not been submitted, the drawings as of the international application date excluding the descriptive text in the drawings shall be deemed to be the drawings submitted with the application, and the descriptive text in the drawings shall be treated as if the descriptive text does not exist (Article 184sexies(2)).

3.3 In a case where a translation of the abstract has not been submitted

Even if a translation of the abstract has not been submitted within the time limit for the submission of translations, the patent application shall not be deemed to have been withdrawn. However, if the translation of the abstract has not been submitted, the Commissioner of the Patent Office may order the amendment and dismiss the patent application (Article 184quinquies(2)(iv) and (3)).

4. Amendment of the Description, etc. of International Patent Application

4.1 Documents to be amended

4.1.1 Patent application in Japanese language

For patent applications in Japanese language, the description, etc. (see 2.2.1) are to be amended.

4.1.2 Patent application in foreign language

For patent applications in foreign language, the description, etc. (see 2.4(2)) are to be amended.

4.2 Timing at which description, etc. may be amended

4.2.1 Timing at which the description, etc. of a patent application in Japanese

language may be amended

It is basically the same as a regular national patent application, however an amendment (Note) may be made only after executing all of the following (i) and (ii) (Article 184duodecies(1)).

- (i) submission of national documents (see 2.3)
- (ii) payment of prescribed fee

(Note) Amendments under Article 184septies(2) (see 2.5.1(2)) and Article 184octies(2) (see 2.6.1(2)) are excluded.

4.2.2 Timing at which the description, etc. of a patent application in foreign language may be amended

It is basically the same as a regular national patent application however amendment (Note) may be made only after executing all of the following (i) to (iv) (Article 184duodecies(1)).

- (i) submission of translations
- (ii) submission of national documents (see "2.3 Documents under Article 184quinquies(1)")
- (iii) payment of prescribed fee
- (iv) after a lapse of the National Processing Standard Time

(Note) An amendment under Article 184octies(2) (see 2.6.2(2)) is excluded.

5. Examination of International Patent Application

5.1 Patent application in Japanese language

Examination of a patent application in Japanese language is the same as that of a regular national patent application.

However, if an amendment under Article 19 or Article 34 has been made, the examiner shall consider the following point.

If a copy of a written amendment by an amendment under Article 19 or Article 34 has been submitted, or if a written amendment has been served by the International Bureau, an amendment shall be deemed to have been made under 17bis(1) by said copy of the amendment or said amendment (see 2.5.1 and 2.6.1).

5.2 Patent application in foreign language

Examination of a patent application in foreign language is the same as that of a foreign language written application. The examiner shall examine a patent application in foreign language in accordance with "Part VII Chapter 2 Examination of Foreign Language Written Application". In this case, the examiner shall replace "foreign language documents" with "the description, claims or drawings as of the international application date under Article 184quater(1)".

However, if an amendment under Article 19 or Article 34 has been made, the examiner shall consider the following point.

If a translation of the claims after amendment under Article 19 has been submitted, the translation shall be deemed to be the claims submitted with the application under Article 36(2) (see 2.5.2). Therefore, the translation becomes the claims which is a standard for determination on new matters beyond a translation.

If a translation of a written amendment by an amendment under Article 34 has been submitted, an amendment to the description, etc. shall be deemed to have been made by the translation of the written amendment, and the amendment is deemed to have been made by submitting the statement of correction of an incorrect translation (see 2.6.2). Therefore, the provision of new matters beyond a translation shall not be applied to the amendment. The description, etc. in which the amendment has been made becomes the description, etc. which is a standard for determination on new matters beyond a translation.

6. Treatment of Various Patent Applications

An international patent application to which the international application date is accorded shall have effect as a regular patent application. Therefore, a divisional application, converted application and application claiming priority based on an international patent application are recognized in the same way as a regular patent application.

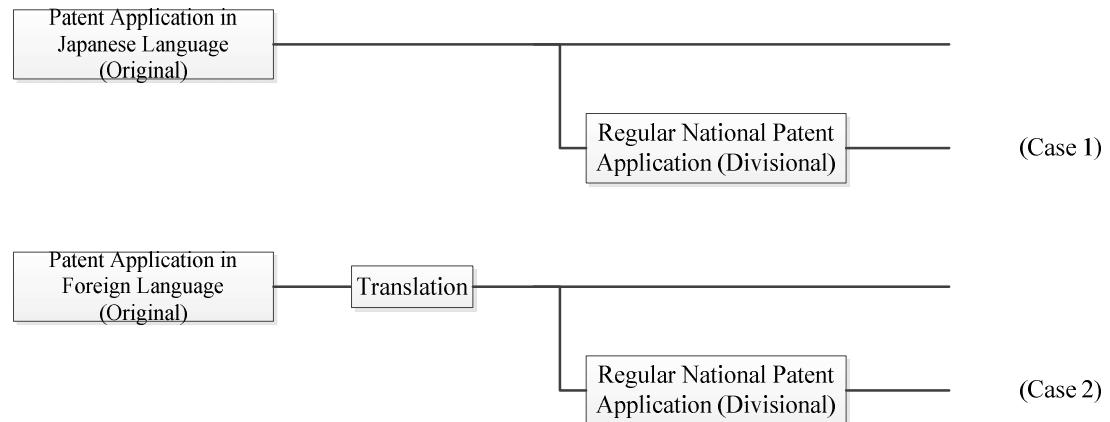
Conversion of an international application under the Patent Cooperation Treaty which is in a national phase and related to an application for utility model registration (hereinafter, in this Part, referred to as an "international utility model registration application") to a patent application, and conversion of an international application under Geneva Act of the Hague Agreement concerning the International Registration of Industrial Designs in which Japan is a designated Contracting Party and which is internationally published (hereinafter, in this Part, referred to as an "international design registration application") to a patent application are recognized.

A patent application based on utility model registration with regard to an international utility model registration application (hereinafter, in this Part, referred to as "international utility model registration") is also recognized.

6.1 Treatment of a divisional application in the case where the original application is an international patent application

6.1.1 Cases of divisional application

Possible cases of a divisional application in which the original application is an international patent application are as follows.



*"Regular National Patent Application" means a patent application provided by Article 36 or 36bis.

6.1.2 When a divisional application is allowed

In Cases of a patent application in Japanese language (Case 1) and a patent application in foreign language (Case 2), the period during which a divisional application can be filed is provided in Article 44(1) (see "Part VI Chapter 1 Section 1

Requirements for Division of Patent Application"). For the period during which an amendment can be made, see 4.2.

6.1.3 Points to note in examination

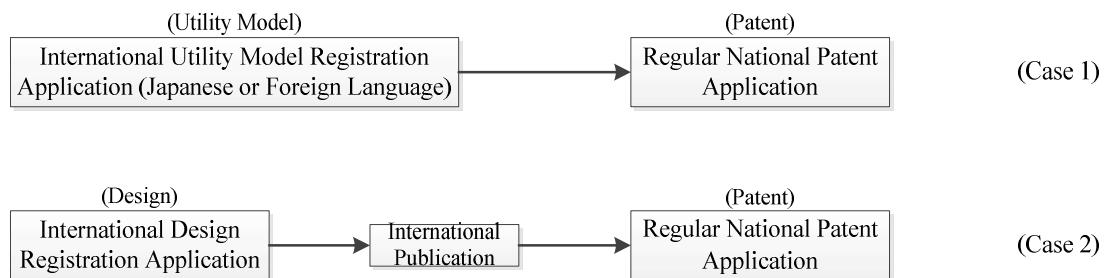
The examiner shall determine the substantive requirements of division of a patent application on the basis of the description, etc. as of the international application date of the original application and as they stand immediately prior to the division (for means for determining the substantive requirements of division of a patent application, see "Part VI Chapter 1 Section 1 Requirements for Division of Patent Application").

However, for the description, etc. as of the international application date if the original application is a patent application in foreign language, since it is highly possible that the content of said description, etc. coincides with that of the translation thereof, it is usually sufficient to determine based on the translation of the original application.

6.2 Treatment of a converted application in the case where the original application is an international utility model registration application, etc.

6.2.1 Cases of converted application

Possible cases of a converted application of an international utility model registration application or an international design registration application, to a patent application are as follows.



*"Regular National Patent Application" means a patent application provided by Article 36 or 36bis.

6.2.2 When a converted application is allowed

The period during which a converted application can be filed is as follows.

(1) The period during which a converted application can be filed, for an international utility model registration application in Japanese language (Case 1)

It is basically the same as a regular national patent application, however a converted application may be filed only after executing the following (i-1) and (i-2), or (ii) (Patent Act Article 184sedecies).

- (i-1) submission of documents under Utility Model Act Article 48quinquies(1)
- (i-2) payment of prescribed fee

- (ii) for an international application that is deemed to be a utility model application by decision under Utility Model Act Article 48sedecies(4), said decision

(2) The period during which a converted application can be filed, for an international utility model registration application in foreign language (Case 1)

It is basically the same as a regular national patent application, however a converted application may be filed only after executing all of the following (i-1) to (i-3), or (ii) (Patent Act Article 184sedecies).

- (i-1) submission of translations
- (i-2) submission of documents under Utility Model Act Article 48quinquies(1)
- (i-3) payment of prescribed fee

- (ii) for an international application that is deemed to be a utility model application by decision under Utility Model Act Article 48sedecies(4), said decision

(3) The period during which a converted application can be filed, for an international design registration application (Case 2)

It is basically the same as a regular national patent application, however a converted application may be filed only after the date of international publication (Design Act Article 60sexies).

6.2.3 Points to note in examination

(1) If an original application is an international utility model registration application (Case 1)

The examiner shall determine the substantive requirements of conversion of application on the basis of the description, etc. as of the international application date of the original application and as they stand immediately prior to the conversion (for means for determining the substantive requirements of conversion of an application, see "Part VI Chapter 2 Conversion of Application").

However, for the description, etc. as of the international application date if the original application is an international utility model registration application, since it is highly possible that the content of said description, etc. coincides with that of the translation thereof, it is usually sufficient to determine based on the translation of the original application if the translation has been submitted.

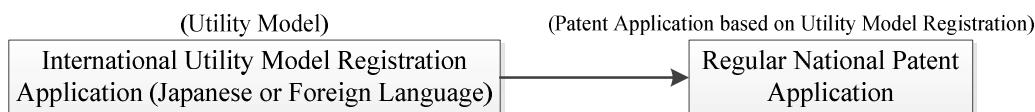
(2) If an original application is an international design registration application (Case 2)

The examiner shall determine the substantive requirements of conversion of application on the basis of the statement of the application or drawings, etc. attached to the application as of the dated of international registration of the original application and as they stand immediately prior to the conversion.

6.3 Treatment of a patent application based on international utility model registration

6.3.1 Cases of patent application based on international utility model registration

A possible case of a patent application based on international utility model registration is the following case.



*"Regular National Patent Application" means a patent application provided by Article 36 or 36bis.

6.3.2 When a patent application based on international utility model registration is allowed

The period during which a patent application based on international utility model registration can be filed is the same as the period during which a patent application based on regular utility model registration (see "Part VI Chapter 3 Patent Application Based on Utility Model Registration").

6.3.3 Points to note in examination

The examiner shall determine the substantive requirements of a patent application based on international utility model registration, on the basis of the following (i) and (ii) (for means for determining the substantive requirements of a patent application based on utility model registration, see "Part VI Chapter 3 Patent Application Based on Utility Model Registration").

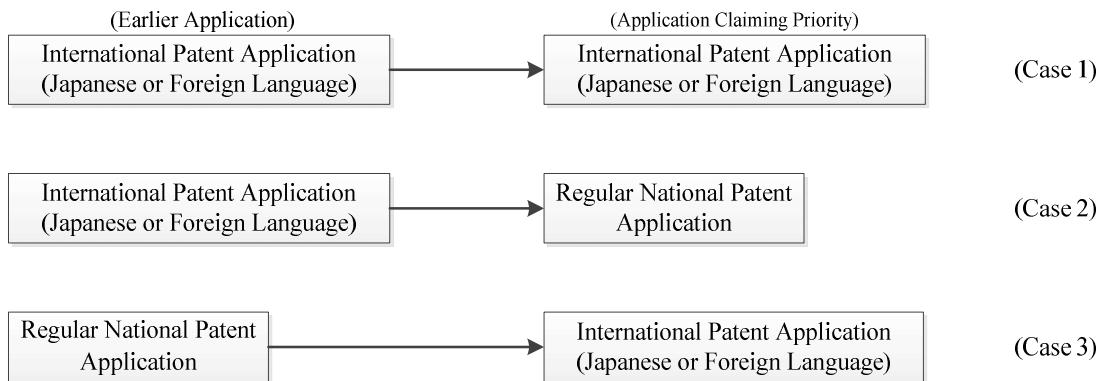
- (i) The description, etc. as of the international application date of international utility model registration application whose registration is a basis of the patent application
- (ii) The description, etc. as of the registration date of international utility model registration application whose registration is a basis of the patent application

However, for the description, etc. as of the international application date if the international utility model application is an international utility model registration application in foreign language, since it is highly possible that the content of said description, etc. coincides with that of the translation thereof, it is usually sufficient to determine based on the translation of the international utility model application.

6.4 Treatment of application claiming priority

6.4.1 Cases of application claiming priority

Possible cases of an application claiming priority to which an international patent application is related are as follows.



* "Regular National Patent Application" means a patent application provided by Article 36 or 36bis.

6.4.2 When an application claiming priority is allowed

In cases where an application claiming priority based on an international patent application is filed (Case 1 or Case 2) and in cases where an international patent application is filed as an application claiming priority (Cases 1 or Case 3), the period during which an application claiming priority can be filed is the same as the period during which an application claiming priority for a regular national patent application can be filed (see "Part V Priority").

6.4.3 Points to note in examination

(1) If an earlier application as a basis of claiming priority is an international patent application (Case 1 or Case 2)

If the claimed invention of an application claiming priority is within the scope of the matters stated in the description, etc. as of the international application date of the international patent application being an earlier application, the effect of claiming priority is recognized.

However, if the earlier application is a patent application in foreign language, since it is highly possible that the content of the description, etc. as of the international application date coincides with that of the translation thereof, it is usually sufficient to determine based on the translation of the earlier application if the translation has been submitted.

(2) If an application claiming priority is an international patent application (Case 1 or Case 3)

In a case of a patent application in Japanese language, whether the effect of claiming priority is recognized shall be determined by comparing the matters stated in the description, etc. of the earlier application and the patent application in Japanese language claiming priority.

In a case of a patent application in foreign language, it is determined by comparing the matters stated in the description, etc. of the earlier application and a translation deemed to be the description, etc. of the patent application in foreign language claiming priority, or the matters stated in an amended description, etc. if the amendment has been made.

In the translation deemed to be the description, etc. or the amended description, etc. if the amendment has been made, for the matters stated in the earlier application, the effect of claiming priority is recognized.

In any cases (1) and (2), determination on the effect of claiming priority, in the same way as a case of a regular patent application claiming priority, is usually sufficient to be executed only if prior art and the like which can be a basis of the reason for refusal is found between the filing date of the earlier application and the filing date of application claiming priority.

<Relevant Provisions>

Patent Act

(Amendment of proceedings)

Article 17

(Omitted)

(2) Notwithstanding the main clause of the preceding paragraph, an applicant of a foreign language written application as provided in Article 36bis(2) may not amend foreign language documents as provided in Article 36bis(1).

(3) to (4) (Omitted)

(Amendment of Description, Claim or Drawing attached to the application)

Article 17bis

(1) An applicant for a patent may amend the description, scope of claims, or drawings attached to the application, before the service of the certified copy of the examiner's decision notifying that a patent is to be granted; provided, however, that following the receipt of a notice provided under Article 50, an amendment may only be made in the following cases:

- (i) where the applicant has received the first notice (hereinafter referred to in this Article as the "notice of reasons for refusal") under Article 50 (including the cases where it is applied mutatis mutandis pursuant to Article 159(2) (including the cases where it is applied mutatis mutandis pursuant to Article 174(1) and Article 163(2), hereinafter the same shall apply in this paragraph) and said amendment is made within the designated time limit under Article 50;
 - (ii) where, following the receipt of the notice of reasons for refusal, the applicant has received a notice under Article 48septies and said amendment is made within the designated time limit under said Article;
 - (iii) where, following the receipt of the notice of reasons for refusal, the applicant has received a further notice of reasons for refusal and said amendment is made within the designated time limit under Article 50 with regard to the final notice of reasons for refusal; and
 - (iv) where the applicant files a request for a trial against an examiner's decision of refusal and said amendment is made at the same time as said request for said trial.
- (2) Where an applicant of a foreign language written application as provided in Article 36bis(2) amends the description, scope of claims or drawings under the preceding paragraph for the purpose of correcting an incorrect translation, the

applicant shall submit the statement of correction of the incorrect translation, stating the grounds thereof.

(3) to (6) (Omitted)

(Patent application based on international application)

Article 184ter

(1) An international application (a patent application only) to which the international application date is accorded under Article 11(1), 11(2)(b) or 14(2) of the Patent Cooperation Treaty signed in Washington on June 19, 1970 (hereinafter referred to as the "Treaty" in this Chapter) and which specifies Japan as a designated State under Article 4(1)(ii) of the Treaty shall be deemed to be a patent application filed on said international application date.

(2) Article 43 (including its mutatis mutandis application under Article 43bis(3)) shall not apply to the international application deemed to be a patent application under the preceding paragraph (hereinafter referred to as "international patent application").

(Translations of international patent application in foreign language)

Article 184quater

(1) An applicant of an international patent application in foreign language (hereinafter referred to as a "patent application in foreign language") shall submit to the Commissioner of the Patent Office Japanese translations of the description, scope of claims, drawings (limited to the descriptive text in such drawings, hereinafter the same shall apply in this article), and the abstract, as provided in Article 3(2) of the Treaty, as of the international application date as provided in paragraph (1) of the preceding Article (hereinafter referred to as the "international application date") within the period from the priority date under Article 2 (xi) of the Treaty (hereinafter referred to as the "priority date"), to two years and six months (hereinafter referred to as the "Time Limit for the Submission of National Documents") therefrom; provided, however, that the applicant of a patent application in foreign language who has submitted the document under paragraph (1) of the following Article during the period from two months before the expiration of the Time Limit for the Submission of National Documents to the expiry date thereof (excluding the case where said translations have been submitted prior to the submission of said documents) may submit said translations within two months from the date of submission of said document (hereinafter referred to as the "special time limit for the submission of translations").

- (2) In the case of the preceding paragraph, where the applicant of the patent application in foreign language has made an amendment under Article 19(1) of the Treaty, the applicant may, in lieu of the translation of the scope of claim(s) as provided in the preceding paragraph, submit a translation of the amended scope of claim(s).
- (3) Where the translation of the description as provided in paragraph (1) and the translation of the scope of claim(s) as provided in the preceding two paragraphs (hereinafter referred to as the "translations of the description, etc.") have not been submitted within the Time Limit for the Submission of National Documents (in the case of a patent application in foreign language under the proviso to paragraph (1), the Special Time Limit for the Submission of Translations, hereinafter the same shall apply in this article), the international patent application shall be deemed to have been withdrawn.
- (4) The applicant of the international patent application that was deemed to have been withdrawn pursuant to the preceding paragraph, where there are justifiable reasons for having not been able to submit said translation of the description, etc. within the Time Limit for the Submission of National Documents, may submit to the Commissioner of the Patent Office the translations of the description, etc. and the translations of the drawings and abstract under paragraph (1) within the time limit as provided in Ordinance of the Ministry of Economy, Trade and Industry.
- (5) The translations submitted under the preceding paragraph shall be deemed to have been submitted to the Commissioner of the Patent Office at the time of expiration of the Time Limit for the Submission of National Documents.
- (6) Where an amendment under Article 19(1) of the Treaty has been made, an applicant who has submitted the translation of the scope of claim(s) as provided in paragraph (1) may further submit a Japanese translation of said amended scope of claim(s) no later than the date on which the Time Limit for the Submission of National Documents expires (the time of requesting where the applicant requests the examination of the application within the Time Limit for the Submission of National Documents, hereinafter referred to as the "National Processing Standard Time").
- (7) The main clause of Article 184septies(3) shall apply mutatis mutandis to the case where the translation under paragraph (2) or the preceding paragraph has not been submitted.

(Submission of documents and order to amend procedures)

Article 184quinquies

(1) An applicant of an international patent application shall submit a document to the Commissioner of the Patent Office within the Time Limit for the Submission of National Documents stating the following:

- (i) the name, and the domicile or residence of the applicant;
- (ii) the name, and the domicile or residence of the inventor; and
- (iii) matters as provided by Ordinance of the Ministry of Economy, Trade and Industry, including the international application number.

(2) The Commissioner of the Patent Office may order the amendment of procedures for an applicant, designating an adequate time limit, in the following cases:

- (i) where the document to be submitted under the preceding paragraph is not submitted within the Time Limit for the Submission of National Documents;
- (ii) where the procedure as provided in the preceding paragraph does not comply with paragraphs (1) to (3) of Article 7 or Article 9;
- (iii) where the procedure as provided in the preceding paragraph does not comply with the formal requirements as provided by Ordinance of the Ministry of Economy, Trade and Industry;
- (iv) where a translation of the abstract to be submitted under paragraph (1) of the preceding Article is not submitted within the Time Limit for the Submission of National Documents (in the case of a patent application in foreign language under the proviso to paragraph (1) of the preceding Article, the Special Time Limit for the Submission of Translations); and
- (v) where the fees payable under Article 195(2) are not paid within the Time Limit for the Submission of National Documents.

(3) Where the person ordered to amend a procedure under the preceding paragraph does not make the amendment within the designated time limit under said paragraph, the Commissioner of the Patent Office may dismiss said international patent application.

(Effect, etc. of application, description, etc. of international application)

Article 184sexies

(1) The application of an international patent application as of the international application date shall be deemed to be an application submitted under Article 36(1).

(2) The description of an international patent application in the Japanese language (hereinafter referred to as a "patent application in Japanese language") as of the

international application date and translations of the description of a patent application in foreign language as of the international application date shall be deemed to be the description submitted with the application under Article 36(2); scope of claim(s) of a patent application in Japanese language as of the international application date and a translation of the scope of claim(s) of a patent application in foreign language as of the international application date shall be deemed to be the scope of claim(s) submitted with the application under said paragraph; drawing(s) of a patent application in Japanese language as of the international application date, drawing(s) of a patent application in foreign language as of the international application date (excluding the descriptive text in the drawing(s)) and a translation of the descriptive text in the drawing(s) shall be deemed to be the drawing(s) submitted with the application under said paragraph; and, the abstract of a patent application in Japanese language and a translation of the abstract of a patent application in foreign language shall be deemed to be the abstract submitted with the application under said paragraph.

(3) Where a translation of the amended scope of claim(s) under Article 19(1) of the Treaty is submitted as provided in Article 184quater(2) or (6), notwithstanding the preceding paragraph, a translation of said amended scope of claim(s) shall be deemed to be the scope of claim(s) submitted with the application under Article 36(2).

(Amendment under Article 19 of the Treaty with regard to patent application in Japanese language)

Article 184septies

(1) Where an applicant of a patent application in Japanese language has made an amendment under Article 19(1) of the Treaty, such applicant shall submit to the Commissioner of the Patent Office a copy of the written amendment submitted under Article 19(1) on or before the date which the National Processing Standard Time falls into.

(2) Where a copy of a written amendment has been submitted under the preceding paragraph, an amendment to the scope of claim(s) attached to the application shall be deemed to have been made under Article 17bis(1) by said copy of the written amendment; provided, however, that where the written amendment has been served to the Patent Office under Article 20 of the Treaty within the time limit under the preceding paragraph, the amendment is deemed to have been made by said written amendment.

(3) Where the procedure under paragraph (1) has not been taken by the applicant of a patent application in Japanese language within the time limit under paragraph (1), no amendment under Article 19(1) of the Treaty shall be deemed to have been made; provided, however, that this shall not apply to the case as provided in the proviso to the preceding paragraph.

(Amendment under Article 34 of the Treaty)

Article 184octies

(1) Where an applicant of an international patent application has made an amendment under Article 34(2)(b) of the Treaty, such applicant shall submit to the Commissioner of the Patent Office, in the case of amendment with regard to a patent application in Japanese language, a copy of the written amendment submitted under Article 34(2)(b) and, in the case of amendment with regard to a patent application in foreign language, a Japanese translation of said written amendment, on or before the date which the National Processing Standard Time falls into.

(2) Where a copy of the written amendment or a translation of the written amendment has been submitted under the preceding paragraph, an amendment to the description, scope of claim(s) or drawing(s) attached to the application shall be deemed to have been made under Article 17bis(1) by the copy of the written amendment or the translation of the written amendment; provided, however, that where the written amendment with regard to a patent application in Japanese language has been served to the Patent Office under Article 36(3)(a) of the Treaty within the time limit under the preceding paragraph, the amendment is deemed to have been made by said written amendment.

(3) Where the procedure under paragraph (1) has not been taken by the applicant of an international patent application within the time limit under paragraph (1), no amendment under Article 34(2)(b) of the Treaty shall be deemed to have been made; provided, however, that this shall not apply to the case as provided in the proviso to the preceding paragraph.

(4) Where, in accordance with paragraph (2), an amendment to the description, scope of claims or drawings attached to the application with regard to a patent application in foreign language has been deemed to have been made under Article 17bis(1), such amendment shall be deemed to have been made by submitting the written correction of incorrect translation as provided in Article 17bis(2).

(Special provisions concerning amendment)

Article 184duodecies

(1) Notwithstanding the main clause of Article 17(1), no amendment of the procedures shall be allowed (excluding those under Articles 184septies(2) and 184octies(2)) unless, in the case of a patent application in Japanese language, the procedure under Article 184quinquies(1) has been taken and the fee payable under Article 195(2) has been paid, and, in the case of a patent application in foreign language, the procedures under Articles 184quater(1) or (4) and 184quinquies(1) have been taken, the fee payable under Article 195(2) has been paid, and the National Processing Standard Time has lapsed.

(2) For the purpose of the allowable scope of amendment to the description, scope of claims or drawings with regard to a patent application in foreign language, the term "a foreign language written application as provided in Article 36bis(2)" in Article 17bis(2) shall be deemed to be replaced with "a patent application in foreign language as provided in Article 184quater(1)"; the term "the description, scope of claims or drawings originally attached to the application (in the case of a foreign language written application under Article 36bis(2), the translation of foreign language documents as provided in Article 36bis(2) that is deemed to be the description, scope of claims and drawings under Article 36bis(8) (in the case where the amendment to the description, scope of claims or drawing has been made through the submission of the statement of correction of incorrect translation, said translations or the amended description, scope of claim or drawings), the same shall apply to Articles 34bis(1) and 34ter(1)" in Article 17bis(3) shall be deemed to be replaced with "a translation as provided in Article 184quater(1) of the description or drawings (limited to the descriptive text in the drawings) of an international patent application as provided in Article 184ter(2) (hereinafter referred to as an "international patent application" in this paragraph) as of the international application date as provided in Article 184quater(1) (hereinafter referred to as the "international application date" in this paragraph), a translation as provided in Article 184quater(1) of the scope of claims of an international patent application as of the International Application Date (in the case where a translation of the scope of claim(s) amended under Article 19(1) of the Patent Cooperation Treaty signed in Washington on June 19, 1970 has been submitted under Article 184quater(2) or (6), said translation) or drawings (excluding the descriptive text in the drawings) of an international patent application as of the International Application Date (hereinafter referred to as the "translations, etc." in this paragraph)

(in the case where an amendment to the description, scope of claim(s) or drawing(s) has been made through the submission of the statement of correction of incorrect translation, the Translations, etc. or said amended description, scope of claims or drawings)".

(3) Notwithstanding Article 17ter, an applicant of an international patent application may amend the abstract attached to the application only within one year and three months from the priority date (in the case of a patent application in foreign language, a translation of which has been submitted under Article 184quater(1), where such application falls under an international patent application of which the applicant has requested an examination within the Time Limit for the Submission of National Documents and the international publication has been effected, excluding the time after the request for an examination of the application has been filed).

(Special provisions concerning priority claim based on a patent application, etc.)

Article 184quindecies

(1) The proviso to Article 41(1), Articles 41(4), and 42(2) shall not apply to an international patent application.

(2) For the purpose of application of Article 41(3) to a patent application in Japanese language, the term "or the laying open of the patent application" in said Article shall be deemed to be replaced with "or the international publication under Article 21 of the Patent Cooperation Treaty signed in Washington on June 19, 1970".

(3) For the purpose of the application of Article 41(3) for a patent application in foreign language, the term "the description, scope of claims or drawings originally attached to the application in a patent application" in said Article shall be deemed to be replaced with "the description, scope of claims or drawings of an international application as of the international application date under Article 184quater(1)," and the term "or the laying open of the application" shall be deemed to be replaced with "or the international publication under Article 21 of the Patent Cooperation Treaty signed in Washington on June 19, 1970".

(4) For the purpose of application of paragraphs (1) to (3) of Article 41 and 42(1), in the case where the earlier application under Article 41(1) of this Act is an international patent application or an international utility model registration application under Article 48ter(2) of the Utility Model Act, the term "the description, scope of claims for a patent or utility model registration and drawings originally attached to the application" in Articles 41(1) and 41(2) shall be deemed to be replaced

with "the description, scope of claims or drawings of an international application as of the international application date under Article 184quater(1) of this Act or Article 48quater(1) of the Utility Model Act,"; the term "the description, scope of claims for patent or utility model registration and drawings originally attached to the application in the earlier application " in Article 41(3) shall be deemed to be replaced with "the description, scope of claims or drawings of an international application of the earlier application as of the International Application Date under Article 184quater(1) of this Act or Article 48quater(1) of the Utility Model Act,"; the term "the laying open of the patent application relating to" in Article 41(3) shall be deemed to be replaced with "the international publication under Article 21 of the patent Cooperation Treaty signed in Washington on June 19, 1970 relating to,"; and the term "when one year and three months from the filing date has lapsed" in Article 42(1) shall be deemed to be replaced with "at the later of the time of the National Processing Standard Time under Article 184quater(6) of this Act or Article 48quater(6) of the Utility Model Act or the time when one year and three months has lapsed from the International Application Date under Article 184quater(1) of this Act or Article 48quater(1) of the Utility Model Act".

(Special provision concerning conversion of application)

Article 184sedecies

An international application that has been deemed to be an application for utility model registration under Article 48ter(1) or 48sedecies(4) of the Utility Model Act may be converted to a patent application, only after the fees payable under Article 54(2) of said Act have been paid (or, in the case of an international application that is deemed to be a Utility Model registration application under Article 48sedecies(4) of said Act, after the ruling as provided in Article 48sedecies (4) has been rendered), and, in the case of a Utility Model Registration Application in Japanese Language under Article 48quinquies(4) of said Act, the procedures under Article 48quinquies(1) of said Act has been completed, or, in the case of a Utility Model Registration Application in Foreign Language under Article 48quater(1) of said Act, the procedures under Article 48quater(1) or 48quater(4) and 48quinquies(1) of said Act have been completed.

(Provisions for reasons for refusal, etc.)

Article 184duodecimies

For the purpose of an examiner's decision of refusal and a trial for patent

invalidation, with respect to a patent application in foreign language, the term "foreign language written application" in Articles 49(vi), and 123(1)(i) and (v) shall be deemed to be replaced with "patent application in foreign language referred to in Article 184quater(1)," and the term "foreign language documents" in Articles 49(vi) and 123(1)(v) shall be deemed to be replaced with "the description, scope of claim(s) or drawing(s) of the international application as of the international application date referred to in Article 184quater(1)".

(International application deemed to be patent application by decision)

Article 184vicies

(Omitted)

(2) and (3) (Omitted)

(4) Where the Commissioner of the Patent Office has rendered a ruling under the preceding paragraph to the effect that the refusal, declaration or finding under said paragraph was not justified under the provisions of the Treaty and the Regulations under the Patent Cooperation Treaty, the international application for which the decision is rendered shall be deemed to be a patent application filed on the day which would have been accorded as the international application date if no such refusal, declaration or finding had been made for the international application.

(5) and (6) (Omitted)

Regulations under the Patent Act

(Matters to be stated in the documents)

Article 38ter

The matters specified by Ordinance of the Ministry of Economy, Trade and Industry set forth in Article 184quinquies(1)(iii) of the Patent Act are as follows.

(i) international application number

(ii) the name and the domicile or residence of the representative, if any

Patent Cooperation Treaty

Article 2 Definitions

For the purposes of this Treaty and the Regulations and unless expressly stated otherwise:

(i) to (viii) (Omitted)

(ix) references to a "patent" shall be construed as references to national patents and

regional patents;
(x) to (xx) (Omitted)

Article 19 Amendment of the claims before the International Bureau

(1) The applicant shall, after having received the international search report, be entitled to one opportunity to amend the claims of the international application by filing amendments with the International Bureau within the prescribed time limit. He may, at the same time, file a brief statement, as provided in the Regulations, explaining the amendments and indicating any impact that such amendments might have on the description and the drawings.

(2) and (3) (Omitted)

Article 20 Communication to designated Offices

(1) (Omitted)

(2) If the claims have been amended by virtue of Article 19(1), the communication shall either contain the full text of the claims both as filed and as amended or shall contain the full text of the claims as filed and specify the amendments, and shall include the statement, if any, referred to in Article 19(1).

(3) (Omitted)

Article 34 Procedure before the international preliminary examining authority

(1) (Omitted)

(2)(a) (Omitted)

(b) The applicant shall have a right to amend the claims, the description, and the drawings, in the prescribed manner and within the prescribed time limit, before the international preliminary examination report is established. The amendment shall not go beyond the disclosure in the international application as filed.

(c) and (d) (Omitted)

(3) and (4) (Omitted)

Article 36 Transmittal, translation, and communication, of the international preliminary examination report

(1) and (2) (Omitted)

(3)(a) The international preliminary examination report, together with its translation (as prescribed) and its annexes (in the original language), shall be communicated

by the International Bureau to each elected Office.

(b) (Omitted)

(4) (Omitted)

Part IX

Extension of Patent Term

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Part IX Extension of Patent Term

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<Relevant Provisions>

Part IX Extension of Patent Term

1. Overview

The objective of the Patent System is to protect and encourage an invention by granting, as a compensation for publishing a technology related to the invention, an inventor the exclusive right of the invention for a fixed period of time, and, by doing so, to contribute development of the industry.

However, in some fields of such as pharmaceutical products, etc., there is a problem that, because a considerably long time period is needed for required tests and examinations, etc. on occasions when obtaining permission etc. provided in laws that is aimed at securing safety, etc., a profit according to the exclusive right cannot be enjoyed during that period even if the patent right is continuing.

Such laws and regulations themselves are indispensable from their purposes. However, as a result of that, in a field of such as pharmaceutical products, a patent term that could be enjoyed essentially cannot be enjoyed for a time period corresponding to a regulation concerned in the field as a whole. Furthermore, there is a limit naturally in reducing a period of pharmaceutical screenings, etc. from a viewpoint of such as securing safety.

Such situation is a problem which undermines the fundamental principle of the Patent System, and, therefore, in order to solve this, measures for extending a patent term is required.

Therefore, on occasions when there has been a period during which the patented invention was not able to be worked because it is necessary to obtain a disposition designated in Cabinet Order, which is a disposition of permission or others provided in a law aiming at securing safety, etc. and which may take a considerable period to pursue said disposition in an appropriate manner in view of its objective and procedures etc., it has been made possible to extend the period of duration of patent right by an application for registration of extension concerned with limits of five years (Article 67(2)).

In this way, the objective of the system of patent term extension is to restore the period during which a patented invention was unable to be worked because it was necessary to obtain an disposition designated in Cabinet Order under Article 67(2) (hereinafter, simply referred to as "the disposition designated in Cabinet Order" or "the disposition" in this part.) (Determination of the First Petty Bench of the Supreme Court,

Apr. 28, 2011 (2009 (Gyo Hi) No. 326 and 65-3 Minshu 1654) and Determination of the Third Petty Bench of the Supreme Court, Nov. 17 2015 (2014 (Gyo Hi) No. 356).

The following two are designated in Cabinet Order as a disposition (Article 2 of the Patent Act Enforcement Order).

- (i) Registration related to agricultural chemicals based on the provisions of the Agricultural Chemicals Regulation Law
- (ii) Approval and certification based on the provisions of the Law for Ensuring the Quality, Efficacy, and Safety of Drugs and Medical Devices (hereinafter, referred to as "Pharmaceutical and Medical Device Law") concerning pharmaceutical products, in vitro diagnostics, products for regeneration medicine, etc. (hereinafter, pharmaceutical products, in vitro diagnostics and products for regeneration medicine, etc. are collectively referred to as "drug products" in this part) .

2. Application for Registration of Extension of Patent Term (an application for extension registration)

2.1 Applicant

An applicant of an application for registration of patent term extension (hereinafter, simply referred to as an "application for registration of extension" in this part) shall be limited to the patent holder (patentee) (Article 67ter (1) (ix)).

On occasions when a patent right is relating to joint ownership, each co-owner is unable to make an application for registration of extension unless the application is made jointly with all other co-owners (Article 67bis (4)). Meanwhile, the patentee or a person who has the exclusive license or non-exclusive license of that patent right shall need to obtain a disposition designated in Cabinet Order under Article 67(2) (article 67ter (1) (ii)).

2.2 Filing period for the application

An application for registration of extension must be filed within three months after the date (See Note) of obtaining the disposition designated in Cabinet Order under Article 67(2). However, an application may not be filed after the expiration of the original patent term (20 years from the filing date), (Article 67bis (3), and Article 3 of the Patent Act Enforcement Order). In addition, on occasions when a person to file an

application for registration of extension cannot file that application within three months after the date of obtaining the disposition designated in Cabinet Order for any reason not attributable to the applicant, said application must be filed within 14 days (within two months for a foreign resident) after the reason ceases to exist (or within nine months when the period in question exceeds nine months) (Article 3 of the Patent Act Enforcement Order).

When a disposition designated in Cabinet Order is unlikely to be obtained by six months prior to the expiration of the term of a patent right, a person who intends to file an application for registration of extension needs to submit a document providing the following matters on or before that date. (Article 67bis-bis (1) and Article 38quindecies f(2) of the Regulations under the Patent Act):

- (i) Surname or entity name and the domicile or residence of the person or entity seeking to make the application;
- (ii) Patent number; and
- (iii) Disposition designated in Cabinet Order under Article 67(2)

When the above-mentioned document is not submitted, an application for registration of extension is not able to be made after the day six months before the expiration of the patent term (Article 67bis-bis (2)).

(Note) "The date of obtaining the disposition designated in Cabinet Order" is a date on which notification of the approval or registration reached the applicant, that is, a date on which the applicant was put in a state where the applicant learned this or could have learned this. This does not necessarily mean the date of arrival of the "written approval" or "registration card", and, if the applicant knew about the approval or registration in advance of the arrival of the "written approval" or "registration card", it is the date on which the applicant knew this actually.

2.3 Patent right eligible for the application

A patent right, for which a patented invention was unable to be worked because it was needed to obtain the disposition designated in Cabinet Order under Article 67(2), becomes the subject of an application for registration of extension.

2.4 Information which should be included in a request of the application

A person or an entity to seek application for registration of extension must submit a request including the following matters to the JPO Commissioner (Article 67bis (1) and Article 38quindecies of the Regulations under the Patent Act):

- (i) Surname or entity name and domicile or residence of the applicant;
- (ii) Patent number;
- (iii) Period for which the extension is requested (not exceeding five years);
- (iv) Details of disposition designated in Cabinet Order under the Article 67(2); and
- (v) The date of obtaining a disposition designated in Cabinet Order under Article 67(2).

In the above-mentioned (iv) details of disposition designated in Cabinet Order under Article 67(2), there shall be stated: a disposition to be the reason of the registration of extension (for example, "approval based on Article 14(1) of the Pharmaceutical and Medical Device Law related to pharmaceutical product prescribed in the paragraph"); the number for identifying the disposition (the approval number, for example); a product that became the subject of the disposition (Note 1); and, in a case where a particular use in which the product is used is defined in the disposition, said particular use (Note 2).

Regarding (v) the date of obtaining a disposition designated in Cabinet Order under Article 67(2), see 2.2 (Note).

(Note 1) In principle, as "a product that became the subject of the disposition", the following

matters shall be stated:

- (i) In the case of a pharmaceutical product, the name (product name etc.) and the active ingredients stated in the written approval;
- (ii) In the case of a pharmaceutical product for in vitro diagnosis, the name (product name etc.) and ingredients involved in the reaction system stated in the written approval;
- (iii) In the case of a product of regeneration medicine etc., the name (product name etc.) and constituent cells or transgenes stated in the written approval; or
- (iv) In the case of an agricultural chemical, the names of the agricultural chemical and active ingredients stated in the registration card.

(Note 2) In principle, as a "use", the following matters shall be stated:

- (i) In the case of a pharmaceutical product, the efficacy and effect stated in the written approval;

- (ii) In the case of a pharmaceutical product for in vitro diagnosis, the use objective stated in the written approval;
- (iii) In the case of a product of regeneration medicine etc., the efficacy, effect and capability stated in the written approval; or
- (iv) In the case of an agricultural chemical, the names of crops, the names of applicable diseases and pests, the names of applicable weeds or the use objective stated in the registration card.

Where there are more than one disposition corresponding to an act of working of the patented invention pertaining to the application for registration of extension (see 3.1.1(1)(ii)) and where the difference between the dispositions needs to be clarified, such difference can be clarified by matters to be stated in the application. For example, in case of a pharmaceutical product, if an applicant intends to clarify the difference by stating dosage and administration, he/she can state them in a column of use in the application.

2.5 Information which should be included in materials stating a reason for extension

Materials stating the reason of extension must be attached to the request (Article 67bis (2)).

The materials stating the reason of extension, which must be attached to the request, are as follows (Article 38sedecies of the Regulations under the Patent Act).

- (i) Materials necessary for certifying that a disposition designated in Cabinet Order under Article 67(2) was necessary to obtain for the working of the patented invention concerning the application for registration of extension (the first item);
- (ii) Materials stating the period during which the patented invention concerning the application for registration of extension was unable to be worked because it was necessary to obtain the disposition of the previous item (the second item); and
- (iii) Materials necessary for certifying that a person who obtained the disposition of the first item is the exclusive licensee or the non-exclusive licensee of the patent right concerning the application for registration of extension, or the owner of said patent (the third item).

Each of the above-mentioned materials listed in (i)-(iii) includes the information listed in (1)-(3) below and also materials supporting such information (see (4) below).

(1) Materials necessary for certifying that a disposition designated in Cabinet Order was necessary to obtain for the working of the patented invention:

(i) The invention concerned is a patented invention;

In order to explain that the patent right to be the subject of the application for registration of extension is lasting, the date of registration of establishment of patent right, the expiration date of the patent term and a payment situation of patent fees etc. shall be stated.

(ii) A disposition designated in Cabinet Order has been obtained;

Matters necessary for identifying a disposition designated in Cabinet Order (a disposition to be a reason for registration of extension (Hereinafter, it may be called the "present disposition" in this chapter.), a number for identifying the disposition and the date of the disposition), a product that became the subject of the disposition, and, in the case where a particular use in which the product is used is defined in that disposition, said use shall be stated (see 2.4).

(iii) An act of manufacturing and distribution of drug products or an act of manufacturing and import of agricultural chemicals that was the subject of the present disposition corresponds to an act of working of the patented invention claimed in an application for registration of extension;

The applicant shall identify a claims that is thought to include the drug products or agricultural chemicals that became the subject of the present disposition, compare matters specifying the invention in the claim in question and matters stated in the written approval (see (4)(ii) below) of the drug products or in the registration card etc. of the agricultural chemicals (Note), and describe that the drug products or agricultural chemicals that became the subject of the present disposition have all of the matters specifying the invention of the claimed invention in question (see 3.1.1(2)(i)).

(Note) In a registration card for agricultural chemicals, there is no statement concerning a manufacturing method. Therefore, it shall be described using a material submitted on the occasion of the registration request that an agricultural chemical that became the subject of the present disposition is

provided with matters specifying the invention pertinent to a manufacturing method.

- (iv) Manufacturing and distribution of drug products or manufacturing and import of agricultural chemicals subject to the disposition regarding the prior drug products or the prior agricultural chemicals (the prior disposition) shall not include manufacturing and distribution of drug products or manufacturing and import of agricultural chemicals subject to the present disposition.

The applicant is required to compare the present disposition with any prior dispositions which he/she has known and explain that manufacturing and distribution of drug products or manufacturing and import of agricultural chemicals subject to the prior disposition(s) does not include those subject to the present disposition (see 3.1.1.(1)(ii)d).

- (2) Materials stating the period during which the patented invention was unable to be worked because it was necessary to obtain the disposition designated in Cabinet Order

- (i) History leading to the present disposition

The applicant is required to explain major facts and dates on which the facts occurred.

- (ii) The period during which the patented invention was unable to be worked

The applicant is required to explain the grounds for the period during which the patented invention was unable to be worked because it was necessary to obtain the present disposition (see 3.1.3).

- (3) Materials necessary for certifying that a person who obtained the disposition designated in Cabinet Order is the exclusive licensee or the non-exclusive licensee of the patent right, or the owner of a patent in question;

- (i) That the patent owner is a person who obtained the present disposition, or
(ii) That a person who has the exclusive license or non-exclusive license of the patent right is a person who obtained the present disposition

- (4) Materials supporting the contents of statements

- (i) Patent gazettes
(ii) In the case of drug products, a copy of the written approval (including the

approval request form part (the same shall apply below)).

As a material that indicates a period of the above-mentioned (2), a material that can show the commencement date of a test needed in order to obtain the present disposition, such as a copy of a submission form of a clinical trial plan, for example (see 3.1.3(2)). When the approval was unable to be learned on the approval date, a material that can show a date on which the approval was learned or a date on which the approval was placed in a state being able to be learned, whichever the earliest, objectively.

(iii) In the case of agricultural chemicals, a copy of the registration card.

As a material that indicates a period of the above-mentioned (2), a material that can show the commencement date of a test needed in order to obtain the present disposition, such as a copy of the request form of a commissioned field trial etc., for example (see 3.1.3(2)). When the registration was unable to be learned on the registration date, a material that can show a date on which the registration was learned or a date on which the registration was placed in a state being able to be learned, whichever the earliest, objectively.

Meanwhile, in the materials of (ii) and (iii) above, a part needed to support the contents is disclosed.

2.6 Effects of the application

When an application for registration of extension is filed, the duration is deemed to be extended until a decision of refusal is determined or a registration of extension is admitted (Article 67bis (5)).

2.7 Publication of patent gazette

When an application for registration of extension is filed, matters listed in Article 67bis (1) and the number and the year, month and date of the application are published in a patent gazette (Article 67bis(6)).

Moreover, a document as provided in Article 67bis-bis (1) is filed, matters listed in each item in Article 67bis-bis (1) are published in a patent gazette (Article 67bis-bis(3)).

3. Examination of Application for Registration of Extension**3.1 Determination on requirements pertaining to examination of an application for registration of extension**

In examining an application under registration of extension, an examiner determines whether the application applies to any of each item of Article 67ter (1) shown below as (1) to (5). The reason for refusal exists when the application applies to any of (1) to (5) below.

- (1) where the disposition designated by Cabinet Order under Article 67(2) is not deemed to have been necessary to obtain for the working of the patented invention (Article 67ter(1)(i)).
- (2) where the patentee, or the exclusive licensee(s) or registered non-exclusive licensee(s) of the patent have not obtained the disposition designated by Cabinet Order under Article 67(2) (Article 67ter(1)(ii)).
- (3) where the period for which the extension is requested exceeds the period during which the patented invention was unable to be worked (Article 67ter(1)(iii)).
- (4) where the person filing the application is not the patentee (Article 67ter(1)(iv)).
- (5) where the application does not meet the requirements under Article 67bis(4) (Article 67ter(1)(v)).

3.1.1 Where the disposition designated by Cabinet Order under Article 67(2) is not deemed to have been necessary to obtain for the working of the patented invention (Article 67ter(1))

- (1) Determination on whether or not the disposition designated by Cabinet Order has been necessary to obtain for the working of the patented invention

In case an application for registration of extension falls under any of (i) or (ii) in below, it is not deemed that the disposition designated by Cabinet Order has been necessary to obtain for the working of the patented invention, then a reason for refusal arises.

- (i) when an act of manufacturing and distribution of drug products or an act of

manufacturing and import of agricultural chemicals subject to the present disposition does not fall under an act of working of the patented invention pertaining to an application for registration of extension.

As a result of comparing the matters specifying the invention in the patented invention with the matters stated in the certificate of approval of drug products or a registration card of agricultural chemicals etc, the examiner notifies a reason for refusal when drug products or agricultural chemicals as a subject of the present disposition cannot be said as including all of the matters specifying the invention as to the patented invention related to any of the claims.

Example: Where the patented invention is "an insect killer including an active ingredient A and a surfactant B," the examiner notifies a reason for refusal unless the registered pesticides based on the matters stated in a registration card etc. of pesticides can be said as an insect killer including the active ingredient A or an active ingredient corresponding to a more specific concept thereof and the surfactant B or a surfactant corresponding to a more specific concept thereof.

- (ii) In case an act of manufacturing and distribution of drug products or an act of manufacturing and import of agricultural chemicals subject to both the present disposition and the prior disposition falls under an act of working of the patented invention pertaining to an application for registration of extension, when manufacturing and distribution of drug products or manufacturing and import of agricultural chemicals subject to the prior disposition include those subject to the present disposition.

When an act of manufacturing and distribution of drug products or an act of manufacturing and import of agricultural chemicals subject to both the present disposition and the prior disposition falls under an act of working of the patented invention pertaining to an application for registration of extension, it is considered as follows:

- (a) Basic idea

It is not deemed that the present disposition has been necessary to obtain for the working of the patented invention pertaining to the application for registration of extension, when manufacturing and distribution of drug products or manufacturing and import of agricultural chemicals subject to the prior disposition are found to include those subject to the present disposition as a result of comparing the two

dispositions with respect to the examination matters related directly to substantial identity as drug products or agricultural chemicals in the light of the type and subject of the patented invention pertaining to the application for registration of extension. Then, the examiner issues a notification of a reason for refusal.

It is based on the following idea.

Considering the system and purpose of the registration of extension of the patent term, it is not appropriate to compare the two dispositions concerning matters which are not related directly to substantial identity as drug products or agricultural chemicals in the light of the type and subject of the patent pertaining to the application for registration of extension, because the two dispositions are compared concerning the matters which are not likely to inhibit the working of the patented invention of said drug products or agricultural chemicals and the registration of extension of the patent term may be approved. Therefore, whether or not manufacturing and distribution of drug products or manufacturing and import of agricultural chemicals subject to the prior disposition include those subject to the present disposition should be determined not by merely comparing all matters with respect to the prior disposition and the present disposition but by comparing the two dispositions with respect to the examination matters which are related directly to substantial identity as drug products or agricultural chemicals in the light of the type and subject of the patented invention pertaining to the application for registration of extension.

(b) Inclusion

In cases where manufacturing and distribution of drug products or manufacturing and import of agricultural chemicals subject to the prior disposition are partially overlapped with those subject to the present disposition, it is also regarded as one of the aspects of inclusion (see 3.1.1(4)).

(c) Examination matters related directly to substantial identity

In a case where a prior disposition and a present disposition have been made, the two dispositions are compared with respect to the examination matters related directly to substantial identity as drug products or agricultural chemicals in the light of the type and subject of the patented invention pertaining to an application for registration of extension. For example, the followings are shown as “examination matters related directly to substantial identity”.

- where the disposition designated by Cabinet Order is an approval of manufacturing and distribution of pharmaceutical products and the patented invention claimed in an application for registration of extension is an invention of product, examination matters include “ingredient, dose, dosage, administration, efficacy and effect”.
- where the disposition designated by Cabinet Order is an approval of manufacturing and distribution of pharmaceutical products and the patented invention claimed in an application for registration of extension is an invention of manufacturing process, examination matters include “ingredient, dose, dosage, administration, efficacy and effect” as well as matters related to the manufacturing process if necessary.
- where the disposition designated by Cabinet Order is an approval of manufacturing and distribution of pharmaceutical products and the patented invention claimed in an application for registration of extension is an invention of drug formulation, examination matters include “ingredient, dose, dosage, administration, efficacy and effect” as well as matters related to drug formulation if necessary.
- where the disposition designated by Cabinet Order is an approval of manufacturing and distribution of in vitro diagnostics and the patented invention claimed in an application for registration of extension is an invention of product, examination matters include “ingredient, dose, structure, direction of use and capability”.
- where the disposition designated by Cabinet Order is an approval of manufacturing and distribution of products of regeneration medicine etc., and the patented invention claimed in an application for registration of extension is an invention of product, examination matters include “constituent cells, transgene, structure, dosage, administration, direction of use, efficacy, effect and capability”.
- where the disposition designated by Cabinet Order is a registration of agricultural chemicals and the patented invention claimed in an application for registration of extension is an invention of product, examination matters include “type of agricultural chemicals, physical and chemical property, types and contents of each component, a range of applicable diseases and insects pests (in the case of chemical agents used to promote or suppress the physiological functions of crops, etc., the range of applicable crops, etc. and the purpose of the application of the agricultural

chemicals.) and methods of use.

- (d) Where a patent right claimed in an application for registration of extension including more than one claim

Where a patent right claimed in an application for registration of extension includes more than one claim, it should be recognized that the disposition designated by Cabinet Order has been necessary to obtain for the working of the patented invention for at least any one of the claims.

Therefore, it is necessary to be recognized that any one of the claims pertaining to an application for registration of extension does not fall under both 3.1.1 (1)(i) and (ii). Namely, if any one of the claims is not deemed to be the following both (a) and (b), it is not recognized that the disposition designated by Cabinet Order has been necessary to obtain for the working of the patented invention, then a reason for refusal arises:

(a) an act of manufacturing and distribution of drug products or an act of manufacturing and import of agricultural chemicals subject to the present disposition falls under an act of working of the patented invention pertaining to an application for registration of extension.

(b) when an act of manufacturing and distribution of drug products or an act of manufacturing and import of agricultural chemicals subject to both the present disposition and the prior disposition falls under an act of working of the patented invention claimed in an application for registration of extension, manufacturing and distribution of drug products or manufacturing or import of agricultural chemicals subject to the prior disposition do not include those subject to the present disposition.

(e) The applicant is required to compare the present disposition with any prior dispositions that he/she has known and explain that manufacturing and distribution of drug products or manufacturing and import of agricultural chemicals subject to the prior disposition(s) do not include those subject to the present disposition (see 2.5(1)(iv)). When the applicant can explain that manufacturing and distribution of drug products or manufacturing and import of agricultural chemicals subject to the prior disposition do not include those subject to the present disposition by reason of the partial difference in examination matters related directly to substantial identity, he/she may explain only matters necessary for the examination.

(2) Where multiple patent rights correspond to a single disposition

Where multiple patent rights correspond to a single disposition, a patent term extension will be registered for each of the patent rights respectively, provided that the disposition is deemed to be required for those respective patent rights in order to carry out the patented invention.

For example, where such multiple patent rights are comprising: a patent for substance as an active ingredient of an approved pharmaceutical product, a patent for pharmaceuticals wherein the active agent is used for the approved pharmaceutical use, and a patent for manufacturing process of the active ingredient, the patent term extension will be registered for any of those patent rights respectively, provided that such approval is deemed to be required for those respective patent rights in order to carry out the patented invention.

(3) Where multiple dispositions correspond to a single patent right

Where multiple dispositions were issued for a single patent right, patent term extensions based on those different dispositions will be registered for the single patent right on a disposition-by-disposition basis, provided that those respective dispositions are deemed to be required for the working of the patented invention.

(4) Where manufacturing and distribution of drug products or manufacturing and import of agricultural chemicals subject to more than one disposition are partially overlapped each other

Where manufacturing and distribution of drug products or manufacturing and import of agricultural chemicals subject to the present disposition are partially overlapped with manufacturing and distribution of drug products or manufacturing and import of agricultural chemicals subject to the prior disposition (for example, where the efficacy and effect of a pharmaceutical product subject to the present disposition is a generic concept, while the efficacy and effect of a pharmaceutical product subject to the prior disposition is a more specific concept,) it is deemed that the present disposition has been necessary to obtain for the working of the patented invention except the part overlapped in the two dispositions.

For example, with respect to a patented invention for "Substance A," where the present disposition is obtained for a pharmaceutical product listed as having "active ingredient: Substance A, efficacy and effect: allergic rhinitis," even if the prior disposition has been obtained for a pharmaceutical product listed as having "active

ingredient: Substance A, efficacy and effect: chronic allergic rhinitis," it is deemed that the present disposition has been necessary to obtain for the working of the patented invention except the part overlapped in the two dispositions.

(5) Pharmaceutical-related patent right which is ineligible for patent term extension

Any patent right for intermediates, catalysts, or manufacturing equipment that are used in the manufacturing process of any drug product or agricultural chemical is ineligible for patent term extension.

Drug products or agricultural chemicals as a final product contain no intermediates, catalysts, nor manufacturing equipment. Pharmaceutical and Medical Device Act and Agricultural Chemicals Control Act which provide for regulations on manufacturing and distribution of drug products as final products, and manufacturing and import of agricultural chemicals as final products respectively, neither of which has intent to regulate mere use of intermediates, catalysts, nor manufacturing equipment. Thus, the above mentioned patent rights shall be ineligible for patent term extensions.

3.1.2 Where a patentee, an exclusive licensee or a non-exclusive licensee of the patent right has not obtained a disposition designated by Cabinet Order under Article 67(2) (Article 67ter(1)(ii))

Even if more than one person jointly obtained a disposition and only some of them hold an exclusive license or a non-exclusive license of the patent right, it does not change the fact that the patentee, the exclusive licensee, or the non-exclusive licensee of the patent right has obtained the disposition. As such, this would not fall under Article 67ter (1)(ii).

3.1.3 Where the period for which the extension is requested exceeds the period during which the patented invention was unable to be worked (Article 67ter(1)(iii))

(1) Interpretation of the phrase "the period during which the patented invention was unable to be worked"

The phrase "the period during which the patented invention was unable to be worked" means a period during which the patented invention was unable to be worked because it was necessary to obtain a disposition designated by Cabinet Order (Article 67(2)).

This period begins on the date on which a testing necessary for obtaining the disposition designated by Cabinet Order commences or on which the relevant patent is registered, whichever comes later; and ends on the day before the date on which the approval or registration takes effect by reaching the applicant, i. e. the date on which the applicant actually learns of the approval or registration or could have learned of it (Note) (see Judgment of the Second Petty Bench of the Supreme Court of October 22, 1999, 1998(Gyo-Hi) No. 43, Law Reports of Civil Judgments of the Supreme Court Vol. 53 No. 7 pp.1270, and Judgment of the Second Petty Bench of the Supreme Court of October 22, 1999, 1998(Gyo-Hi) No. 44).

(Note) "The date on which the approval or registration takes effect by reaching the applicant, i. e. the date on which the applicant actually learns of the approval or registration or could have learned of it" does not necessarily mean the date on which the applicant receives an "approval certificate" or a "registration card." If the applicant learns of the approval or registration before receiving such certificate or card, the abovementioned date is considered to be the date on which the applicant actually learns of such approval or registration.

Pharmaceutical and Medical Device Law and Agricultural Chemicals Regulation Law each provides that any person who seeks approval for a drug product or registration of an agricultural chemical must include materials on test results when filing for the disposition. As such, testing is necessary to obtain test results. Furthermore, since a patented invention means an invention for which a patent has been granted (Article 2(2)), "the period during which the patented invention was unable to be worked" must be the period which comes after the registration of the patent right. Therefore, the "period during which the patented invention was unable to be worked" means the period after the date of patent registration, out of the period of time spent conducting the testing necessary to obtain a disposition plus the period between the date on which the disposition was filed for and the date of the disposition.

No extension will be allowed for the period which is considered as not necessary for obtaining the disposition even if such period falls under the above period.

While various types of testing are conducted according to the purpose, intent, and regulatory requirements of regulatory laws, the period during which a testing is conducted cannot be regarded as "the period during which the patented invention was unable to be worked" unless the testing satisfies all of the requirements listed in (i) to

(iii) below:

- (i) The testing is indispensable for obtaining a disposition;
- (ii) Enterprises have little discretion in conducting the testing because the testing needs to be conducted in line with the standards for testing methods, description, etc. of testing set forth by administrative agencies; and
- (iii) The testing is closely related to obtaining a disposition.

(Note) The period during which a preclinical testing was conducted is much characterized as a research and development period to study the utility of the chemical substance which is the active ingredient of a pharmaceutical product, and is considered as being more like a product development period in general fields of industry. Such period is not necessarily regarded as a testing period that is closely related to obtaining approval. Accordingly, the period during which the preclinical testing was conducted shall not be included in the period during which the patented invention was unable to be worked.

(2) The commencement date of "the period during which the patented invention was unable to be worked"

The date on which the testing necessary for obtaining the disposition commenced means, in the case of a drug product, the commencement date of the clinical testing (such as the date on which a notification of the clinical trial plan is submitted) or, in the case of an agricultural chemical, the commencement date of commissioned field trials conducted for the relevant chemical substance by specifying the name of the substance (such as the date on which a request for the commissioned field trial is submitted).

(3) The end date of "the period during which the patented invention was unable to be worked".

The period during which the patented invention was unable to be worked is considered to end on the day before the date on which the applicant is notified of the approval or registration, or in other words, on the day before the date on which the applicant actually learns of, or could have learned of, the approval or registration. This is because "the prohibition" under regulatory laws is removed on the date on which the applicant is notified of the approval or registration.

(4) Points to note

In determining "the period during which the patented invention was unable to be worked" according to Article 67ter(1)(iii), not only the materials submitted by the applicant but also the conventional process by which the disposition designated by Cabinet Order is delivered are considered. Based on the consideration of the materials submitted by the applicant and the conventional process by which the disposition designated by Cabinet Order is delivered, if it is found that the extension period sought by the applicant exceeds the period during which the patented invention was unable to be worked because of the need to obtain the disposition designated by Cabinet Order, the application will be refused under Article 67ter(1)(iii).

The extension period sought by the applicant will be acceptable unless the period is longer than the period during which the patented invention was unable to be worked because of the need to obtain the disposition designated by Cabinet Order. The two periods do not have to be the same in length.

If the date on which the applicant is notified of the approval or registration is prior to the registration date of the patent right, the application will be refused under Article 67ter(1)(iii), because there was no period during which the patented invention was unable to be worked.

3.1.4 Where the person filing the application is not the patentee (Article 67ter(1)(iv))

If a person other than the patentee files an application for registration of extension, it falls under Article 67ter(1)(iv), and the application will be refused.

3.1.5 Where the application does not meet the requirements under Article 67bis(4) (Article 67ter(1)(v))

In the case of a jointly owned patent, if only some of the joint patentees file an application to register a patent term extension, it falls under Article 67ter(1)(v), and the application will be refused.

3.2 Procedures of examination for the application for registration of extension

3.2.1 Notice of a reason for refusal

If an application for registration of extension falls under any of the items of Article 67ter(1), the examiner shall notify the applicant of the reasons therefore and give

said applicant an opportunity to submit a written opinion, designating an adequate time limit for such purpose (Article 50 which is applied mutatis mutandis in Article 67quater).

3.2.2 Response by the applicant

(1) Term allowable for amendment

A person undertaking a procedure before the Patent Office may make amendments only while the case is pending (Article 17(1)). As such, a person filing an application for registration of extension may amend the same from time to time as long as the application is pending at the Patent Office.

(2) Scope allowable for amendment

The most significant part of the examination of an application for registration of extension is in determining which patent right shall be the subject of extension and which disposition shall provide the basis for extension. Accordingly, if the matters for specifying the patent right and disposition (such as the patent number and the description of the disposition) are stated on the application form or in the materials stating the reasons for extension, at the time of filing the application, the amendment to correct the application form or the materials stating the reasons for extension will be allowed within the scope thereof.

3.2.3 Decision of refusal

If the application for registration of extension still falls under any of the items of Article 67ter(1) even when the written opinion, etc. are taken into consideration, the examiner shall render his/her decision to the effect that the application is to be refused (Article 67ter(1)).

3.2.4 Decision of registration

If no reasons for refusal are found in the application for registration of extension, the examiner shall render his/her decision to the effect that the extension is to be registered (Article 67ter(2)).

In case the extension of the duration of a patent right is registered, the

following matters shall be published in a patent gazette (Article 67ter(4)):

- (i) Name and domicile or residence of the patentee;
- (ii) Patent number;
- (iii) Application number and filing date of the application for registration of extension;
- (iv) Date of registration of extension;
- (v) Extension period; and
- (vi) Details of the disposition designated by Cabinet Order under Article 67(2).

<Relevant provisions>

Patent Act

(Registration of extension of duration)

Article 67bis

(1) A person(s) filing an application for the registration of extension of the duration of a patent right shall submit a written application to the Commissioner of the Patent Office stating the following:

(i) the name, and the domicile or residence of the applicant;

(ii) the patent number;

(iii) the period for which the extension is requested (not exceeding 5 years); and

(iv) the description of the disposition designated by Cabinet Order as provided in Article 67(2).

(2) The written application under the preceding paragraph shall be accompanied by materials specifying the reason(s) for the extension, as provided by Ordinance of the Ministry of Economy, Trade and Industry.

(3) The application requesting the registration of extension of the duration of a patent right shall be filed within the time limit prescribed by Cabinet Order after the disposition prescribed by Cabinet Order under Article 67(2) is obtained; provided, however, that said written application may not be filed after the expiration of the duration of a patent right as provided in Article 67(1).

(4) Where a patent right is jointly owned, none of the joint owners may file an application for the registration of extension of the duration of a patent right unless jointly with all the other joint owners.

(5) Where an application for the registration of extension of the duration of a patent right is filed, the duration shall be deemed to have been extended; provided, however, that this shall not apply where the examiner's decision to the effect that the application is to be refused has become final and binding or where the extension of the duration of a patent right has been registered.

(6) Where an application for the registration of extension of the duration of a patent right is filed, matters stated in paragraph (1) and the number and the filing date of the application shall be published in the patent gazette.

Article 67bis-bis

(1) Where the disposition designated by Cabinet Order under Article 67(2) is unlikely to be obtained prior to 6 months before the expiration of the duration of a patent right

under Article 67(1), a person filing an application for the registration of extension of the duration of a patent right shall submit to the Commissioner of the Patent Office, on or before the time limit, a document stating the following:

- (i) the name, and domicile or residence of the person filing the application;
- (ii) the patent number; and
- (iii) the disposition designated by Cabinet Order under Article 67(2).

(2) Unless the document required to be submitted under the preceding paragraph is submitted, an application for the registration of extension of the duration of a patent right may not be filed after 6 months before the expiration of the duration of the patent right under Article 67(1).

(3) Where the document as provided in paragraph (1) is submitted, the matters prescribed in said paragraph shall be published in the patent gazette.

Article 67ter

(1) Where an application for the registration of extension of the duration of a patent right falls under any of the following items, the examiner shall render the examiner's decision to the effect that the application is to be refused:

- (i) where the disposition designated by Cabinet Order under Article 67(2) is not deemed to have been necessary to obtain for the working of the patented invention;
- (ii) where the patentee, or the exclusive licensee(s) or registered non-exclusive licensee(s) of the patent have not obtained the disposition designated by Cabinet Order under Article 67(2);
- (iii) where the period for which the extension is requested exceeds the period during which the patented invention was unable to be worked;
- (iv) where the person filing the application is not the patentee; and
- (v) where the application does not meet the requirements under Article 67bis(4).

(2) Where no reasons for refusal are found for the application for the registration of extension of the duration of a patent right, the examiner shall render an examiner's decision to the effect that the extension is to be registered.

(3) Where the examiner's decision or trial decision to the effect that the extension of the duration of the patent right is to be registered is rendered, the extension of the duration of the patent right shall be registered.

(4) Where the registration under the preceding paragraph is made, the following matters shall be published in the patent gazette:

- (i) the name and domicile or residence of the patentee;

- (ii) the patent number;
- (iii) the number and filing date of the application for the registration of extension of the duration of the patent right;
- (iv) the date of the registration of extension;
- (v) the period of extension; and
- (vi) the description of the disposition designated by Cabinet Order under Article 67(2).

(Effect of patent right in the case of duration extension)

Article 68bis

Where the duration of a patent right is extended (including the case where the duration is deemed to have been extended under Article 67bis(5)), such patent right shall not be effective against any act other than the working of the patented invention for the product which was the subject of the disposition designated by Cabinet Order under Article 67(2) which constituted the reason for the registration of extension (where the specific usage of the product is prescribed by the disposition, the product used for that usage).

Order for Enforcement of the Patent Act

(Dispositions which constitute reasons for registration of extension)

Article 2

The dispositions designated by Cabinet Order under Article 67(2) of the Patent Act shall be as follows.

1. Registration under Article 2(1) of the Agricultural Chemicals Regulation Law (Act No. 82 of 1948) (excluding the reregistration under paragraph (5) of the same Article), registration of change under Article 6bis(1) of the same Act (including the case of mutatis mutandis application in Article 15bis(6) of the same Act), and registration under Article 15bis(1) of the same Act (excluding the reregistration under Article 2 (5) of the same Act as applied mutatis mutandis in paragraph 6 of the same Article).

2. Dispositions listed below:

- (i) The approval under Article 14(1) of the Law on Ensuring Quality, Efficacy and Safety of Pharmaceuticals and Medical Devices, etc." (Law No. 145 of 1960; hereinafter referred to as the " Pharmaceutical Products and Medical Devices Law ") for the drug product set forth in the same paragraph, the approval under

paragraph (9) of the same Article (including the case of mutatis mutandis application in Article 19bis(5) of the Pharmaceutical Products and Medical Devices Law), and the approval under Article 19bis(1) of the Pharmaceutical Products and Medical Devices Law;

(ii) The approval under Article 23bis(5)(i) of the Pharmaceutical Products and Medical Devices Law for the in-vitro diagnostics set forth in the same paragraph, the approval under paragraph (11) of the same Article (including the case of mutatis mutandis application in Article 23bis-septies decies (v) of the Pharmaceutical Products and Medical Devices Law), and the approval under Article 23bis-septies decies (1) of the Pharmaceutical Products and Medical Devices Law;

(iii) The authentication under Article 23bis-vicies ter(1) of the Pharmaceutical Products and Medical Devices Law for the in-vitro diagnostics set forth in the same paragraph and the authentication under paragraph (6) of the same Article;

(iv) The approval under Article 23vicies quinquies (1) of the Pharmaceutical Products and Medical Devices Law (excluding the approval under Article 23vicies quinquies (1) of the Pharmaceutical Products and Medical Devices Law pursuant to the application under Article 23vicies sexies (5) of the Pharmaceutical Products and Medical Devices Law), the approval under Article 23vicies quinquies (9) of the Pharmaceutical Products and Medical Devices Law (including the case of mutatis mutandis application in Article 23tricies septies (5) of the Pharmaceutical Products and Medical Devices Law), and the approval under Article 23tricies septies (1) of the Pharmaceutical Products and Medical Devices Law (excluding the approval under Article 23tricies septies (1) of the Pharmaceutical Products and Medical Devices Law pursuant to the application under Article 23vicies sexies (5) of the Pharmaceutical Products and Medical Devices Law which is applied mutatis mutandis in paragraph 5 of the same Article).

(Period for filing application for registration of extension)

Article 3

The period designated by Cabinet Order according to Article 67bis(3) of the Patent Act shall be three months; provided, however, that if the person filing an application for the registration of extension of the duration of a patent right is unable to file the application within the time limit due to reasons beyond its control, the applicant may

file a patent application within 14 days (if the applicant is an overseas resident, within two months) from the date on which the reasons ceased to be applicable (if said period exceeds nine months, nine months).

Regulations under the Patent Act

(Form of the written application for application for registration of extension)

Article 38quindecies

The written application for application requesting the registration of extension of the duration of a patent right must be prepared with the Form No. 56.

(Document form)

Article 38quindecies-bis

The document according to Article 67bis(2)(i) of the Patent Act must be prepared with the Form No. 56-2.

(Document stating the reasons of extension)

Article 38sedecies

Pursuant to the provisions of Article 67bis(2) of the Patent Act, the materials which state the reasons for extension and which must be attached to the written application shall be as follows:

- (i) The materials required to demonstrate that it was necessary to obtain the disposition designated by Cabinet Order under Article 67(2) of the Patent Act in order to carry out the patented invention for the application of registration of extension;
- (ii) The materials indicating the period during which the patented invention, which pertains to the application for registration of extension, was unable to be worked because it was necessary to obtain the disposition according to the preceding item; and
- (iii) The materials necessary to demonstrate that the person who obtains the disposition of item (i) is an exclusive licensee or non-exclusive licensee of the patent right for the application for registration of extension, or the holder of said patent right.

(Description of the decision concerning application for registration of extension)

Article 38septies decies

With regard to the decision of an application requesting the registration of

extension of the duration of a patent right, the following matters must be stated, with the examiner who rendered the decision placing his or her name and seal thereon; provided, however, that in the event of rendering the decision of refusal, the matters listed in items (iii) and (iv) do not have to be stated:

- (i) Number of the application for registration of extension;
- (ii) Patent number;
- (iii) Period of extension;
- (iv) Description of the disposition designated by Cabinet Order in Article 67(2) of the Patent Act;
- (v) Name of the applicant for registration of extension or of the agent for the applicant;
- (vi) Conclusion and reasons for the decision; and
- (vii) Date of the decision.

Part X

Utility Model

Note: When any ambiguity of interpretation is found in this provisional translation, the Japanese text shall prevail.

Part X Utility Model

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Part X Utility Model

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Chapter 1 Basic Requirements for Utility Model Registration

1. Overview

In the interest of early protection of rights on devices, the Utility Model Act provides that registration establishing a utility model right be effected without substantive examination if certain requirements are met by the application (Utility Model Act, Article 14(2) (references in this Part to articles and paragraphs without reference to the name of a law should be taken as references to articles and paragraphs of the Utility Model Act)). Article 6bis specifies these certain requirements (other than formal requirements) (the requirements for Article 6bis are referred to as the "basic requirements" hereafter in this Part).

The Utility Model Act prescribes that a utility model right be granted without substantive examination of the utility model registration application, but such granting is conditional upon the establishment of such right being registered. Therefore, utility model registration applications must meet not only the formal requirements specified in Article 2bis(4), but also certain requirements for the registration of a utility model right. This is why Article 6bis was introduced.

The imposition of these basic requirements works to prevent a utility model right being granted for devices that are not protectable under the Utility Model Act, and the automatic registration of applications which substantially do not qualify as filing documents.

Specifically, applications are judged not to satisfy the basic requirements in any of the cases (i) to (v) below.

- (i) They are not protectable (Articles 6bis(i) and 14ter(i)).
- (ii) They are against public order and morality (Articles 6bis(ii), 14-3(ii) and 4).
- (iii) They do not meet the Ministerial Ordinance requirements pertaining to statements in the claims of the utility model (Articles 6bis(iii), 14-3(iii) and 5(6)(iv), and Regulations under the Utility Model Act, Article 4).
- (iv) The claimed device does not meet the requirement of unity (Articles 6bis(iii), 14-3(iii) and 6).
- (v) The specifications, claims of the utility model, or drawings (referred to as "specifications, etc." hereafter in this Chapter) have a significant material inadequacy (Articles 6bis(iv) and 14ter(iv)).

Even after the establishment of a utility model right is registered, the basic requirements test will be conducted when a written correction is submitted under Article 14bis(1) (Article 14ter).

2. Judgment on the Basic Requirements

Utility model registration applications are judged to meet the basic requirements if they do not come under any of the clauses 2.1 to 2.5 below. On the contrary, they are judged not to satisfy the basic requirements if they fall under any of the clauses 2.1 to 2.5 below.

2.1 Not protectable (Articles 6bis(i) and 14ter(i))

A protectability test covers the claimed device. If what is described in the claims is not a "device" defined in 2.1.1(1), then it is not protectable. Also unprotectable is a claimed device which does not pertain to the "shape or structure of an article or combination of articles."

2.1.1 Definition of "device," "article," "shape", "structure," and "combination"

(1) Device

"Device" means the creation of a technical idea utilizing the laws of nature (Article 2(1)).

(2) Article

"Article" means a product which possesses a certain spatial shape and is generally the subject of commercial transactions, freely portable and clearly intended for a certain purpose.

A part of machinery, equipment, etc., that is traded separately from the whole machinery, equipment, etc. is treated as an "article" if it fits the definition above.

(3) Shape

"Shape" means an external shape expressed with lines or surfaces. Examples include the shape of a cam or gear or the blade of a tool.

(4) Structure

"Structure" means a spatial, three-dimensional structure. It refers not only to the appearance of an article, but also to a structure expressed with plane and elevation views, and, in some cases, side and cross-sectional views. The structure of a road, building, etc., is also treated as the structure of an article.

(5) Combination

"Combination" of articles means that which comes under both (i) and (ii) below.

- (i) Two or more of the articles which constitute such combination are spatially separated at least either at the time when they are used or at the time they are not used.
- (ii) They each possess certain structures or shapes independently, and when in use, functionally relate to each other to produce a use value.

Examples include a fastener composed of a bolt and a nut.

2.1.2 Some of the unprotectable cases

The following is a list of unprotectable cases, though not exhaustive.

(1) What is claimed does not constitute a "device".

Specific examples are the same as given in Clause 2.1 of "Part III Chapter 1 Eligibility for Patent and Industrial Applicability."

(2) What is claimed does not constitute the "shape or structure of an article, or combination of articles."

- (i) Device that falls in the category of process
- (ii) Device pertaining to a composition
- (iii) Device pertaining to a chemical compound
- (iv) Article that does not possess a certain shape (e.g., liquid ballast, non-slip grains for roads)
- (v) Animal breed or plant variety
- (vi) Computer program itself

2.2 Offense against public order morality, etc. (Articles 4, 6bis(ii) and 14ter(ii))

A test of public order, morality, etc. covers the claimed device. An offense is judged

to exist if the claimed device is obviously detrimental to public order, morality, or health. A decision as to whether a claimed device is offensive against public order, morality, etc. is made substantially in accordance with 2 of "Part III Chapter 5 Category of Unpatentable Invention."

2.3 Failure to meet the Ministerial Ordinance requirements pertaining to the scope of claims of utility model (Articles 6bis(iii), 14ter(iii) and 5(6)(iv), and Regulations under the Utility Model Act, Article 4)

The claims of a utility model are judged not to meet the relevant Ministerial Ordinance requirements if they come under any of the items (i) to (iv) below.

- (i) Each claim is not stated on a different line and given a different number.
- (ii) The claims are not serially numbered in the order of appearance.
- (iii) A citation of one claim in another is not made by the number assigned to it.
- (iv) Where a claim is cited in another, that other claim appears before the cited one.

2.4 Failure to meet the requirement of unity (Articles 6, 6bis(iii) and 14ter(iii))

A decision as to whether the requirement of unity is satisfied is made substantially in accordance with "Part II Chapter 3 Unity of Invention."

In "Part II, Chapter 3 Unity of Invention," special technical features are examined by comparison with prior art invention that comes under the Patent Act, Article 29(1). However, the examination of utility model registration applications in terms of the basic requirements does not involve prior art search. Therefore, special technical features of a device that define its contribution over prior art are recognized on the basis of the description, scope of claims and drawings, and common general knowledge as of the filing. The same applies to a basic requirements test conducted when a written correction is submitted under Article 14bis(1).

2.5 Material inadequacy in the description, etc. (Articles 6-bis(iv) and 14ter(iv))

The description, etc., are judged to have a material inadequacy if they come under either (i) or (ii) below.

- (i) A necessary matter is missing from the description, etc. (see 2.5.1(1)(i) and (ii)).
- (ii) The description, etc., are materially ambiguous (see 2.5.1(2)(i) to (iii)).

A material ambiguity is judged to exist if the description, etc., are ambiguous at first glance (e.g., they are judged to be ambiguous before looking into their relationship with other statements).

2.5.1 Claims of the utility model

- (1) Some of the cases where a necessary matter is judged to be missing from the claims of the utility model (2.5(i))
 - (i) The claims contain only non-technical matters, such as sales regions and purchasers.
 - (ii) The claims contain only the purpose, operation, or effect of the device.
- (2) Some of the cases where the claims of the utility model are judged to be materially ambiguous (2.5(ii))
 - (i) The claims are technically incomprehensible.
 - (ii) The contents of the claims are not sufficiently clear because they are substituted by a detailed description or drawings.
 - (iii) One claim contains two or more sentences separated by a punctuation mark, each of which describes a different device.

2.5.2 Statements other than the claims of the utility model

If description (for example, the title of the device, a brief description of drawings) or statements in drawings are judged to be ambiguous at first glance, this also comes under the category of material inadequacy in the description or drawings.

3. Treatment of Non-conformity with the Basic Requirements

If an application does not meet the basic requirements, the JPO Commissioner may order the applicants to make amendments (Article 6bis). And if the applicants fail to do so within the period specified in the amendment orders, the JPO Commissioner may dismiss the application (Article 2ter).

Chapter 2 Utility Model Technical Opinion

1. Overview

Article 12(1) of the Utility Model Act stipulates that any person may file with the JPO Commissioner a petition requesting a technical opinion about a device claimed in a utility model registration application or a registered utility model in the light of certain provisions. It also stipulates that such a petition may be filed on a claim-by-claim basis.

Under the utility model system which provides for early establishment and registration of a utility model right without substantive examination, judgment as to whether a registered right satisfies substantive requirements is left to parties concerned, in principle. However, judgment on the validity of a utility model right that has been established and registered requires technical expertise, and this may present a difficulty to parties concerned in making a decision or may bring about an unexpected confusion. Given this, a utility model technical opinion system was introduced to provide, at request, utility model technical opinion reports (referred to as "technical opinion reports" hereafter in this Part) as objective information to assist parties concerned in assessing novelty, inventive step, etc., which is hard for parties concerned, in relation to prior art documents (Articles 12, 29bis and 29ter).

2. Utility Model Technical Opinion

To form a utility model technical opinion, the examiner shall only evaluate whether the claimed device satisfies the substantive requirements set forth in (i) to (iv) below (Article 12).

- (i) Novelty in the light of devices published in documents (Article 3(1)(iii))
- (ii) Inventive step in the light of devices published in documents ((Article 3(2)
(limited to devices set forth in Article 3(1)(iii)))
- (iii) Enlarged earlier applications (Article 3bis)
- (iv) Earlier applications (Articles 7(1) to 7(3) and 6)

The requirements (i) to (iv) are referred to as "novelty, inventive step etc." hereafter in this Chapter.

When evaluating the novelty, inventive step, etc., of a claimed device, the examiner shall substantially follow patent application Examination Guidelines pertaining to each of the substantive requirements ("Part III Chapter 2 Novelty and

Inventive step" to "Part III Chapter 4 Prior Application" (Note)).

(Note) "Novelty in the light of devices published in documents" and "inventive step in the light of devices published in documents" are evaluated on the basis of publicly known devices published in documents, so 3.1.3 and 3.1.4 in "Part III Chapter 2 Section 3 Procedure of Determining Novelty and Inventive Step" are excluded.

3. Procedure for Forming a Utility Model Technical Opinion

3.1 Determination of the subject of evaluation

The examiner shall evaluate claimed devices for which petitions for utility model technical opinions have been filed. If any amendment or correction is made (whether lawfully or not) prior to the preparation of a technical opinion report, then the examiner shall evaluate the claimed device as amended or corrected.

For the avoidance of doubt, it is not necessary to evaluate (i) any device pertaining to a claim that was invalidated in a trial for invalidation prior to the preparation of a technical opinion report, (ii) any device pertaining to a claim that was deleted as part of a correction prior to the preparation of a technical opinion report, and (iii) any device claimed in a utility model registration application that was withdrawn or abandoned prior to registration thereof and the preparation of a technical opinion report.

(Explanation) Article 12(2) stipulates that no petition for a utility model technical opinion may be filed after the relevant utility model right is invalidated in a trial for invalidation. In the meantime, the Act is silent as to what happens if, after the filing of a petition for a utility model technical opinion, the relevant utility model right is invalidated in a trial for invalidation before a technical opinion report is prepared (3.1(i)).

However, invalid registration implies the absence of the subject of evaluation, so evaluation need not be done where the relevant utility model right is invalidated in a trial for invalidation at any time between the filing of a petition and the preparation of a technical opinion report.

The same applies to any device pertaining to a claim that was deleted as part of a correction(3.1(ii))and any device claimed in a utility model registration application that was withdrawn or abandoned prior to registration thereof(3.1(iii)).

3.2 Finding of the device as claimed in the application concerned

The examiner shall recognize the claimed device, based on the statement of the claims. The claimed device is recognized substantially in accordance with Clause 2 of "Part III Chapter 2 Section 3 Procedure of Determining Novelty and Inventive Step."

3.3 Determination of the subject of prior art search

The examiner shall conduct prior art search for the claimed devices that have been found to be the subject of evaluation under 3.1.

The examiner shall perform prior art search for all the claimed devices that have been found to be the subject of evaluation, regardless of whether they meet the unity requirement or not. When conducting prior art search, the examiner shall also give consideration to the embodiments of the claimed devices (limited to those which embody the matters specifying those claims).

3.4 Prior art search

When conducting prior art search, the examiner shall employ the same techniques as he or she uses in prior art search for patent application examination (see "Part I Chapter 2 Section 2 Prior Art Search and Determination of Novelty, Inventive Step, etc."), in principle.

However, the examiner shall not include unpublished applications in the scope of prior art search. The examiner might find an unpublished application which qualifies as "another application for utility model registration or for a patent" as set forth in Article 3bis; however, in terms of promptness required of this system, delaying the preparation of a technical opinion report until after the publication of such application is inappropriate.

If the claims are ambiguous, the examiner shall conduct the broadest thinkable prior art search, taking all possible interpretations into consideration.

3.5 Evaluation of novelty, inventive step, etc.

The examiner shall evaluate the subject of evaluation in terms of novelty, inventive step, etc., in accordance with 2.

3.5.1 Points to consider when evaluating novelty, inventive step, etc.

(1) Technical opinion reports are intended to provide parties concerned with objective information to assist them in determining the novelty, inventive step, etc., of the subject of evaluation in relation to prior art documents. The examiner shall, therefore, endeavor to be as fair and objective as possible in making an evaluation. Neither the applicant nor the utility model right holder is given an opportunity to argue against the technical opinion reports; thus, the examiner shall bear it in mind that he or she must base his or her technical opinion report on reliable evidence, just as he or she does in examining and making a decision on a patent application.

(2) If any written statement has been sent which contains some argument about the evaluation of novelty, inventive step, etc., the examiner shall give it full consideration in forming a technical opinion.

(3) If a decision rendered in a trial for invalidation of any of the claims subject to evaluation already became final and binding, the examiner shall take such decision into consideration.

(4) For applications which claim internal priority, priority under the Paris Convention, or a right of priority governed by the Paris Convention, the examiner shall take the filing date as the base date when conducting prior art search. And, in principle, only in the case where the examiner finds any such device published in documents or enlarged earlier application or earlier application filed between the date of filing of the earlier or first application and the filing date as may disallow novelty, inventive step, etc., the examiner needs to judge whether the effect of claim of priority should be recognized for the claimed device subject to evaluation, substantially in accordance with "Part V Priority." If no effect of claim of priority is recognized, the examiner shall judge that novelty, inventive step, etc., is disallowed because of the device published in documents, enlarged earlier application, or earlier application mentioned above. If the effect of claim of priority is recognized, the examiner shall judge that novelty, inventive step, etc., is not disallowed accordingly.

(5) In the case of a divisional or converted application, the examiner shall take the actual date of filing of the new utility model registration application as the base date when conducting prior art search. And, in principle, only in the case where the examiner finds any such device published in documents or enlarged earlier application or earlier application filed between the date of filing of the original application and the actual date

of filing of the new utility model registration application as may disallow novelty, inventive step, etc., the examiner needs to judge whether the application concerned meets the division or conversion requirements, substantially in accordance with "Part VI Chapter 1 Division of Patent Application" or "Part VI Chapter 2 Conversion of Application." If the examiner finds that such requirements are not satisfied, he or she shall judge that novelty, inventive step, etc., is disallowed because of the device published in documents, enlarged earlier application, or earlier application mentioned above. If the examiner finds that such requirements are met, he or she shall judge that novelty, inventive step, etc., is not disallowed accordingly.

3.6 If it is difficult to conduct prior art search and evaluate novelty, inventive step, etc.

(1) The examiner shall conduct prior art search to the extent possible for the claim which he or she has identified as the subject of evaluation.

(2) There may be cases in which the examiner finds difficulty in evaluating the novelty, inventive step, etc., of the claim thoroughly as the claimed device is not clearly defined or the detailed description of the device is not so clear and sufficient as to enable persons ordinarily skilled in the art to which the device pertains to work the device. Even in this case, if the examiner can hypothetically make reasonable assumptions about the subject of evaluation in the light of the description, the scope of claim of the utility model and drawings, and common general knowledge as of the filing, then the examiner shall base his or her evaluation of novelty, inventive step, etc., on the most reasonable assumptions (simply referred to as "assumptions" hereafter in this Part).

In this case, the technical opinion report shall also contain the inadequacies found in the description, scope of claim of the utility model or drawings, and the assumptions mentioned above.

However, given the fact that inadequacies in the description, scope of claim of the utility model or drawings are not the subject of a utility model technical opinion and that neither the applicant nor the utility model right holder is given an opportunity to argue against the opinion, the examiner shall take these actions only when he or she is convinced of such inadequacies.

Presented below are ways of making assumptions for evaluation purposes (note, however, that the basic and other requirements are not taken into account).

Example 1:

[Claims]

Comfortable chair as shown in Figure 1.

[Outline of the description or drawings]

Figure 1 shows a chair whose backrest has a human-back-shaped concave.

(Assumption for evaluation)

The examiner shall perform an evaluation on the assumption that "comfortable ... as shown in Figure 1" means "whose backrest has a human-back-shaped concave."

Example 2:

[Claims]

A toy dog comprising an emotion quantification means that quantifies human emotions, an emotion assessment means that detects a feeling of joy in a human based on signals from the emotion quantification means, and a control means that wags the tail based on signals from the emotion assessment means.

[Outline of the description or drawings]

The detailed description of the device only describes a toy dog which has a means of wagging the tail when such volume of sound that exceeds a certain level is detected.

(Assumption for evaluation)

"Emotion quantification means that quantifies human emotions" and "emotion assessment means that detects a feeling of joy in a human based on signals from the emotion quantification means," if taken literally, do not evoke an image of a concrete article and thus cannot be evaluated fully in terms of novelty, inventive step, etc. And the detailed description of the device cannot be interpreted to suggest something other than a means of detecting such volume of sound that exceeds a certain level. Therefore, the examiner shall perform an evaluation on the assumption that the "emotion quantification means that quantifies human emotions" and the "emotion assessment means that detects a feeling of joy in a human based on signals from the emotion quantification means" are means of detecting such volume of sound that exceeds a certain level.

(3) There may be cases in which the examiner cannot conduct effective prior art search for the claimed device as the claims are not so clearly stated that the claimed device cannot be specified even when the description or drawings are taken into consideration or the claims contain a matter that does not constitute a device. In this case, the examiner shall include in the technical opinion report a statement to the effect that he or she was not able to conduct effective prior art search, as well as the reasons.

4. Preparation of a Technical Opinion Report

The examiner shall include the scope of search (scope of documents covered by the prior art search), his or her evaluation, cited documents, etc., and an explanation about his or her evaluation in a technical opinion report.

4.1 Presentation of the evaluation

The examiner shall present his or her evaluation of the novelty, inventive step, etc., of each claim; provided, however, that it is acceptable to group and present together two or more claims to which the same evaluation and explanation apply.

The examiner shall structure and word an explanation about his or her evaluation in such a manner that it can be understood by the requester (see (1) to (5) below for the details).

(1) If novelty, inventive step, etc., is disallowed, the examiner shall give reasons for such evaluation in the provided space in such a manner that they can be understood by a person who request the report. As a general rule, the examiner shall identify and reproduce the statements in the cited documents which support his or her evaluation. In the case of a negative evaluation with respect to 2.(i), (iii), or (iv), the examiner shall describe how he or she can recognize a device, etc., which disallows the novelty, inventive step, etc. of the claimed device, from the identified statements.

In the case of a negative evaluation with respect to 2.(ii), the examiner shall describe what kind of logic underlies his or her determination of lacking inventive step based on the devices identified from the cited documents.

If the examiner was not able to find any prior art documents, etc., (prior art documents, earlier applications, or co-pending applications filed on the same day) which would disallow the novelty, inventive step, etc., of the claimed device, he or she shall include a statement to the effect that such prior art documents were not found, as well as documents showing the general state of the art in the technical field to which such device pertains.

(2) If the examiner finds it difficult to evaluate the novelty, inventive step, etc., of the claimed device thoroughly for some reason, including, but not limited to, the device not being clearly defined, then he or she shall include a statement to that effect and describe what kind of deficiency has been found in the description, etc., and upon what kind of

assumption his or her evaluation of novelty, inventive step, etc., is based.

(3) If the examiner was unable to conduct effective search pursuant to 3.6(3), he or she shall also include a statement to that effect and the reasons.

(4) If the examiner judges that the division or conversion requirements are not met or no effect of claim of priority is recognized, then he or she shall include the reasons and a statement to the effect that he or she took the actual filing date as the base date in his or her evaluation.

(5) The technical opinion report shall not contain any matters not relevant to the evaluation of novelty, inventive step, etc., (such as the existence of any new matter (Article 2bis(2)) and matters pertaining to correction requirements (Article 14bis)), even if they are obvious.

<Relevant Provisions>

Utility Model Act

(Order to amend)

Article 6-2

The Commissioner of the Patent Office may order the applicant to amend the description, scope of claims or drawing(s) attached to the request, designating an adequate time limit, in any of the following cases:

- (i) where the device claimed in the application for utility model registration does not pertain to the shape or structure of an article or combination of articles;
- (ii) where the device claimed in the application for utility model registration is not registrable under Article 4;
- (iii) where the application for utility model registration does not satisfy the requirement prescribed in Article 5(6)(iv) or in the preceding Article; or
- (iv) where the description, scope of claims or drawing(s) attached to the request does not state all of the necessary matters or is extremely unclear.

(Request for Utility Model Technical Opinion)

Article 12

With regard to an application for a utility model registration or a utility model registration, any person may file with the Commissioner of the Patent Office a petition requesting a technical opinion as to the registrability of the device claimed in the application or of the registered utility model in the light of the provisions of Article 3(1)(iii) and (2) (limited to its application based on a device falling under Article 3(1)(iii)), Article 3-2, and Articles 7(1) to (3) and (6) (such opinion is hereinafter referred to as "Utility Model Technical Opinion"). In this case, in respect of an application or registered utility model that contains two or more claims, such a petition may be filed on a claim-by-claim basis.

- (2) A petition under the preceding paragraph may be filed even after the lapse of the utility model right; provided, however, that this shall not apply after the utility model right is invalidated in a trial for invalidation of utility model registration.
- (3) Notwithstanding the provisions of the preceding two paragraphs, a petition under paragraph 1 shall not be allowed after a patent application based on the utility model registration is filed under Article 46-2(1) of the Patent Act.
- (4) Where a petition under paragraph 1 is filed, the Commissioner of the Patent Office shall direct an examiner to prepare a written report containing a Utility Model Technical Opinion (hereinafter referred to as "Report of Utility Model Technical Opinion").
- (5) The provision of Article 47(2) of the Patent Act shall apply *mutatis mutandis* to the preparation of Reports of Utility Model Technical Opinion.
- (6) A petition under paragraph 1 may not be withdrawn.
- (7) Where a petition under paragraph 1 was filed by a person who is neither the applicant of the application for a utility model registration nor the holder of utility

model right, and then, a patent application under Article 46-2(1) of the Patent Act is filed based on the utility model registration with regard to which the petition under paragraph 1 was filed (including the utility model registration which has been granted based on the application for a utility model registration with regard to which the petition under paragraph 1 was filed), the petition shall be deemed not to have been filed. In this case, the Commissioner of the Patent Office shall notify thereof to the person who filed the petition.

(Order to amend relating to correction)

Article 14-3

Where matters stated in the corrected description, scope of claims or drawings attached to a statement of correction (limited to correction under paragraph (1) of the preceding Article) fall under any of the following, the Commissioner of the Patent Office may order the amendment of the corrected description, scope of claims or drawings attached to the statement of correction, designating an adequate time limit:

- (i) where the device identified by the matters stated in the corrected scope of claims attached to the statement of correction is not pertaining to the shape or structure of an article or combination of articles;
- (ii) where the device identified by the matters stated in the corrected scope of claims attached to the statement of correction is not registrable under Article 4;
- (iii) where the matters stated in the corrected description, scope of claims or drawings attached to the statement of correction do not satisfy the requirement prescribed in Article 5(6)(iv) or Article 6; or
- (iv) where the corrected description, scope of claims or drawings attached to the statement of correction does not state all the necessary matters or is extremely unclear.